



Local division Mannheim
UPC_CFI_210/2023

Order
of the Court of First Instance of the Unified Patent Court,
Mannheim Local Division
issued on 3 February 2025

ACT_545551/2023
CC_596561/2023
CC_596895/2023

Plaintiff:

Panasonic Holdings Corporation - 1006, Oaza Kadoma, Kadoma-shi - 571-8501 - Osaka - JP
represented by Christopher Weber

defendant:

1)

Guangdong OPPO Mobile Telecommunications Corp. Ltd - NO.18 Haibin Road, Wusha, Chang'an Town, Guangdong Province - 523860 - Dongguan - CN
represented by RA Andreas Kramer

2)

OROPE Germany GmbH - Graf-Adolf-Platz 15 - 40213 - Düsseldorf - DE
represented by RA Andreas Kramer

STREITPATENT:

EUROPEAN PATENT NO. EP 2 568 724

PANEL/CHAMBER:

Mannheim local division, Court of First Instance

PARTICIPATING JUDGES:

This decision was issued by the presiding judge and judge-rapporteur Prof. Dr Toch- termann.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: R. 265.1 p. 2 RoP - Withdrawal of the action for infringement and for annulment

FACTS OF THE CASE

Following a settlement, the parties withdrew the infringement action and the action for annulment brought jointly by the defendants after the final decision of 22 November 2024 was issued.

REASONS FOR THE DECISION

The decision follows the unanimously expressed will of the parties according to the concurring application documents dated 20 December 2024.

Insofar as R. 265.2 (c) RoP requires a decision on costs pursuant to Part 1 Chapter 5 RoP, the agreement reached by the parties in this regard was to be confirmed.

The decision on the reimbursement of court costs is based on R. 370.11 RoP in conjunction with R. 370.11 RoP. R.

370.9 (b) RoP. The application for withdrawal was made after the final decision concluding the oral proceedings was announced. There is therefore no grounds for reimbursement in the present case.

TENOR OF THE DECISION

1. Withdrawal of the action for infringement and the action for annulment is permitted on application by the parties.
2. The proceedings are declared closed in their entirety.
3. This decision is to included in the register.
4. Each party shall bear its own costs and there shall be no reimbursement of costs between the parties.
5. is no refund of fees.

Prof Dr Tochtermann Chairman
and judge-rapporteur



Local division Mannheim
UPC_CFI_219/2023

Order
of the Court of First Instance of the Unified Patent Court,
Mannheim Local Division
issued on 3 February 2025

ACT_545615/2023
CC_591342/2023 CC_594299/2023, CC_594307/2023, CC_594305/2023, CC_594594/2023
CC_594595/2023

Plaintiff:

Panasonic Holdings Corporation - 1006, Oaza Kadoma, Kadoma-shi - 571-8501 - Osaka - JP
represented by Christopher Weber

defendant:

Xiaomi Represented by Dr Corin Gittinger
Technology
Germany GmbH
(party to the main
proceedings - Not
provided) -
Niederlasser
Lohweg 175 -
40547 -
Düsseldorf - DE

Xiaomi Represented by Dr Corin Gittinger
Technology
France S.A.S
(Party to the main proceedings - Not provided) - 93 rue Nationale
Immeuble
Australia - 92100 -
Boulogne-
Billancourt - FR

Xiaomi Represented by Dr Corin Gittinger
Technology Italy
S.R.L
(Party to the main proceedings - Not provided) - Viale Edoardo Jenner
53 - 20158
- Milan - IT

Xiaomi Represented by Dr Corin Gittinger
Technology
Netherlands B.V.
(Party to the main proceedings - Not provided) -
Prinses
Beatrixlaan 582 -
2595BM - Den
The Hague - NL

Odiporo GmbH Represented by Dr Corin Gittinger
(party to the main proceedings - Not provided) -
Formerweg 9 -
47877 - Willich -
EN

Shamrock Mobile Represented by Dr Corin Gittinger
Ltd.

(Party to the main
proceedings - Not
provided) -
Siemensring 44H -
47877 - Willich -
DE

PANEL/CHAMBER:

Mannheim local division JUDGES:

This Order was issued by the Chairman and judge-rapporteur Prof Dr Tochtermann.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: R. 265.1 p. 2 RoP - Withdrawal of the action for infringement and for annulment

FACTS OF THE CASE

The parties have withdrawn the action for infringement and the action for annulment brought jointly by the defendants on the basis of a settlement.

REASONS FOR THE DECISION

The decision follows the unanimously expressed will of the parties, which the defendants have assured for the plaintiff's side.

Insofar as R. 265.2 (c) RoP requires a decision on costs pursuant to Part 1 Chapter 5 RoP, the agreement reached by the parties in this regard was to be confirmed.

The decision on the reimbursement of court costs is based on R. 370.11 RoP in conjunction with R. 370.11 RoP. R.

370.9 (b) (iii) RoP. In the present proceedings, the parties did participate in the oral hearing and requested the suspension of the proceedings on the record and thus carried out a procedural act. However, the application for withdrawal was made before the final decision concluding the oral proceedings was issued. There are no special reasons in the present case to refrain from a refund in accordance with Rule 370.9(e) RoP - such as the request withdrawal or cancellation shortly before the scheduled announcement of the decision, which has already been completed.

However, due to the increase in the amount in dispute from € 4 million to € 8 million, the fees for the infringement action will not be reimbursed in the present case, even if the reduction is applied. Instead, the plaintiff is required to pay € 13,400 (paid to date):
37,000 €, court costs at 8 million: 63,000€ x 20% reduction= 50,400 less 37,paid = 13.400 €).

The fees for the defendant's (uniform) action for annulment are to be reduced to 16,000€ . Due to the capping of the fee for the revocation counterclaim at 20,000 € is not sufficient to increase the value in dispute. Otherwise, a party seeking the cancellation of the patent in suit by way of an action for revocation would also be in a worse position than a party attacking the legal validity with an isolated action for revocation. This is because a contested value-independent fixed fee of 20,000€ . There are no apparent justifiable reasons for a different treatment.

The determination of the amount in dispute is clarifying, after the amount in dispute was already determined accordingly in the Order in the interim proceedings.

TENOR OF THE DECISION

1. Withdrawal of the action for infringement and the action for annulment is permitted on application by the parties.
2. The proceedings are declared closed in their entirety.
3. This decision is to included in the register.
4. Each party shall bear its own costs and there shall be no reimbursement of costs between the parties.
5. There is no reimbursement of fees with regard to the infringement action brought by the plaintiff. The plaintiff still has to pay € 13,400 in court costs.
6. The Registrar is ordered to reimburse the defendants as soon as possible 20 % of the court fees paid by them in these proceedings for their joint action for annulment and thus a one-off amount of EUR 4 000.
7. The amount in dispute is set at EUR 8,000,000.

Prof Dr Tochtermann Chairman
and judge-rapporteur



Local division Mannheim
UPC_CFI_218/2023

Order
of the Court of First Instance of the Unified Patent Court,
Mannheim local division
issued on 4 February 2025

ACT_545606/2023
CC_594296/2023 CC_594472/2023, CC_594470/2023, CC_594471/2023, CC_594473/2023
CC_594474/2023

Plaintiff:

Panasonic Holdings Corporation - 1006, Oaza Kadoma, Kadoma-shi - 571-8501 - Osaka - JP
represented by Christopher Weber

defendant:

Xiaomi Represented by Dr Corin Gittinger
Technology
Germany GmbH
(party to the main
proceedings - Not
provided) -
Niederlasser
Lohweg 175 -
40547 -
Düsseldorf - DE

Xiaomi
Technology
France S.A.S
(Party to the main proceedings - Not provided) - 93 rue Nationale
Immeuble
Australia - 92100 -
Boulogne-
Billancourt - FR

Represented by Dr Corin Gittinger

Xiaomi
Technology Italy
S.R.L
(Party to the main proceedings - Not provided) - Viale Edoardo Jenner
53 - 20158
- Milan - IT

Represented by Dr Corin Gittinger

Xiaomi
Technology
Netherlands B.V.
(Party to the main proceedings - Not provided) -
Prinses
Beatrixlaan 582 -
2595BM - Den
The Hague - NL

Represented by Dr Corin Gittinger

Odiporo GmbH
(party to the main proceedings - Not provided) -
Formerweg 9 -
47877 - Willich -
DE

Represented by Dr Corin Gittinger

Shamrock Mobile Represented by Dr Corin Gittinger
Ltd.

(Party to the main
proceedings - Not
provided) -
Siemensring 44H -
47877 - Willich -
DE

PANEL/CHAMBER:

Local division Mannheim

PARTICIPATING JUDGES:

This Order was issued by the Chairman and judge-rapporteur Prof Dr Tochtermann.

PATENT IN SUIT: EP 3069315

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: R. 265.1 p. 2 RoP - Withdrawal of the action for infringement and for annulment

FACTS OF THE CASE

The parties have withdrawn the action for infringement and the action for annulment brought jointly by the defendants on the basis of a settlement.

REASONS FOR THE DECISION

The decision follows the unanimously expressed will of the parties according to the concurring application documents.

Insofar as R. 265.2 (c) RoP requires a decision on costs pursuant to Part 1 Chapter 5 RoP, the agreement reached by the parties in this regard was to be confirmed.

The decision on the reimbursement of court costs is based on R. 370.11 RoP in conjunction with R. 370.11 RoP. R.

370.9 (b) (ii) RoP. The application for withdrawal was filed before the interim proceedings were concluded. Therefore, in principle, 40% of the court fees are to be reimbursed. The fact that the written procedure was first suspended on 4 December 2024 and then, subsequently, on 9 December 2024, the written procedure was formally concluded in the CMS by simply clicking the button provided for this purpose does not change this. This is because the written procedure had already been completed and advertised in all workflows since the end of August 2024 - all that was missing was the final "click" in the CMS. A reimbursement of more than 40% also does not appear appropriate against the background of the character of the present proceedings, which are at the extreme edge of the conceivable complexity of a patent infringement dispute and are characterised by an almost unmanageable number of reciprocal requests for secrecy protection and submission. Therefore, the requested repayment of

60% instead of 40% under Rule 370.9(e) RoP. This is an "exceptional case" in every within the meaning of the rule, which would have no scope of application if the present case were not covered.

Therefore, due to the increase in the amount in dispute from € 4 million to € 6.4 million, the fees for the infringement action will be reimbursed in the present case if the reduction is recognised. The plaintiff is to be reimbursed 2,800€ (paid to date: € 37,000, court costs at € 8 million: € 57,000).

€ x 40% reduction = 34,200 less 37,000 paid = -2,800 €).

The value in dispute is determined in accordance with the determination in the parallel proceedings between the parties and takes into account the determination of the value in dispute in the proceedings separated due to service pursuant to the HZÜ (there: € 1.6 million, 1.6+ 6.4= totalling € 8 million for the formerly unified proceedings).

The fees for the defendant's (uniform) action for annulment are to be reduced to 12,000€ . Due to the capping of the fee for the action for annulment to 20,000

€ is not sufficient to increase the value in dispute. Otherwise, a party seeking the destruction of the patent in suit by way of an action for revocation would also be in a worse position than a party attacking the legal validity with an isolated action for revocation. This is because a contested

value-independent fixed fee of 20,000€ . There are no apparent justifiable reasons for a different treatment.

TENOR OF THE DECISION

1. Withdrawal of the action for infringement and the action for annulment is permitted on application by the parties.
 2. The proceedings are declared closed in their entirety.
 3. This decision is to be included in the register.
 4. Each party shall bear its own costs and there shall be no reimbursement of costs between the parties.
 5. The Chancellor is instructed,
 - to reimburse the plaintiff as soon as possible 40 % of the court fees paid by them in these court proceedings and thus a one-off amount of EUR 2,800.
 - to reimburse the defendants as soon as possible 40 % of the court fees paid by them in these court proceedings for their joint action for annulment, i.e. an amount of EUR 8,000.
- Any further applications for reimbursement will be rejected.
6. The amount in dispute is set at EUR 6,400,000.

Prof Dr Tochtermann Chairman
and judge-rapporteur



Local division Mannheim
UPC_CFI_210/2023

Order

of the Court of First Instance of the Unified Patent Court,

Mannheim Local Division

issued on 6 February 2025

concerning EP 2 568 724

Plaintiff:

Panasonic Holdings Corporation - 1006, Oaza Kadoma, Kadoma-shi - 571-8501 - Osaka - JP
represented by attorney Christopher Weber

defendant:

1)

Guangdong OPPO Mobile Telecommunications Corp Ltd - NO.18 Haibin Road, Wusha,
Chang'an Town, Guangdong Province - 523860 - Dongguan - CN

represented by RA Andreas Kramer

2)

OROPE Germany GmbH - Graf-Adolf-Platz 15 - 40213 - Düsseldorf - DE

represented by RA Andreas Kramer

STREITPATENT:

EUROPEAN PATENT NO. EP 2 568 724

PANEL/CHAMBER:

Mannheim local division, Court of First Instance

CONTRIBUTING JUDGES:

This decision was issued by the presiding judge and judge-rapporteur Prof Dr Tochtermann.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: Action for infringement and action for annulment as well as FRAND counterclaim, here drafting of the decision pursuant to R. 262A RoP

After the parties had the opportunity to comment on a drafting proposal by the court regarding the decision of 22 November 2024 with regard to confidential information and the parties' submissions were fully taken into account and the relevant passages were deleted using the court anonymisation software, the final edited version of the final decision will be published on the court's website. This version was also sent to the parties in advance for confirmation. The parties have declared their consent to the redacted version.

Presiding judge and judge-rapporteur Prof. Dr Tochtermann



Local division Mannheim
UPC_CFI_210/2023

Decision

of the Court of First Instance of the Unified Patent Court,

Mannheim Local Division

announced on 22 November 2024

concerning EP 2 568 724

Plaintiff:

Panasonic Holdings Corporation - 1006, Oaza Kadoma, Kadoma-shi - 571-8501 - Osaka - JP
represented by attorney Christopher Weber

defendant:

1)

Guangdong OPPO Mobile Telecommunications Corp Ltd - NO.18 Haibin Road, Wusha,
Chang'an Town, Guangdong Province - 523860 - Dongguan - CN

represented by RA Andreas Kramer

2)

OROPE Germany GmbH - Graf-Adolf-Platz 15 - 40213 - Düsseldorf - DE

represented by RA Andreas Kramer

STREITPATENT:

EUROPEAN PATENT NO. EP 2 568 724

PANEL/CHAMBER:

Mannheim local division, Court of First Instance

CONTRIBUTING JUDGES:

This decision was issued by the presiding judge and judge-rapporteur Prof. Dr Tochtermann, the legally qualified judge Böttcher, the legally qualified judge Brinkman and the technically qualified judge Loibner.

LANGUAGE OF THE PROCEEDINGS: German

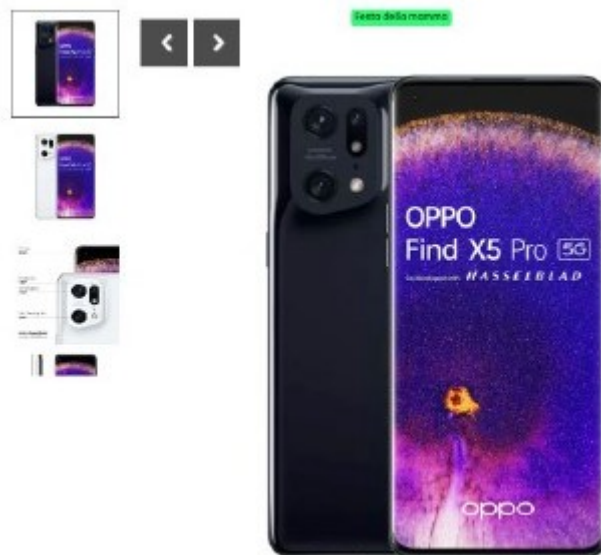
SUBJECT MATTER: Action for infringement and action for cancellation as well as FRAND counterclaim

ORAL NEGOTIATION: 7 and 8 October 2024

BRIEF PRESENTATION OF THE FACTS

1. The plaintiff is the defendants for an alleged infringement of the European patent EP 2 568 724 B1 ("patent-in-suit") relating to a radio communication device and a radio communication method. The patent-in-suit was filed on 13 August 2008 and claims the priority of JP 2007211548 of 14 August 2007 and the priority of JP 2008025535 of 5 February 2008. The notice of grant of the patent-in-suit was published on 17 December 2014. The patent in suit is in , inter alia, in the Federal Republic of Germany, the French Republic, the Italian Republic, the Kingdom of the Netherlands and the Kingdom of Sweden. For these contracting states of the UPCA, the plaintiff is asserting claims for injunctive relief, recall, removal from the distribution channels and destruction, information/rendering of accounts, publication of judgement as well as determination of liability for damages and provisional damages.

2. The plaintiff considers the patent in suit (see below) to be essential for the 4G standard. Therefore, all of the defendant's 4G-capable mobile devices infringe the patent in suit, in particular the 4G-capable smartphones such as the OPPO Find X5 Pro



and the 4G-capable smartwatch

OPPO Watch 46 mm LTE - Smartwatch (AMOLED Display, GPS, Bluetooth 4.2, Wear OS by Google, VOOC Schnellladefunktion, 5 ATM), Schwarz

Besuche den OPPO-Store

4.1 ★★★★★ 86 Sternbewertungen

411 €

Voraussetzung der Importgebühren angewendet

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Größe: 46mm

Farbe: Schwarz

Marke: OPPO

Modellname: Watch 46 mm (LTE)

Sitz: 45H

Farbe: Schwarz

Besonderes Merkmal: GPS

Form: Quadratisch

✓ Mehr anzeigen

Info zu diesem Artikel

- Das Dual-Burne-Display ist so konzipiert, dass Sie Ihre Inhalte aus jedem Blickwinkel bequem anzeigen können.
- Die Oppo Watch mit 46 mm kann rechtzeitig Regen oder Wasser

3. The plaintiff is the parent company of the Panasonic Group, which was founded in 1918. On 1 April 2022, the plaintiff changed its name from Panasonic Corporation to Panasonic Holdings Corporation.
4. Defendant 1. belongs to the OPPO Group and is headquartered in the People's Republic of China. Within the group, it is the company responsible for the mobile phone division. It distributes mobile phone products of the OPPO Group and maintains its European headquarters in Düsseldorf in Germany.
5. Defendant 2. is also part of the OPPO Group. It was founded on 6 June 2019, is entered in the commercial register of the Düsseldorf Local Court under HRB 87507 and has its registered office at the same address as the defendant 1. It has its European headquarters. It operates these OPPO European headquarters together with the defendant 1.
6. The plaintiff contacted the OPPO Group in July 2019 and has since been negotiating unsuccessfully with the first defendant on the conclusion of a FRAND licence agreement for the plaintiff's 4G patents. In the present case, the defendants are bringing a FRAND counterclaim against the plaintiff with the aim of concluding a FRAND licence agreement on the terms they consider to be FRAND on the basis of the court's decision.

APPLICATIONS BY THE PARTIES

7. The **plaintiff** is pursuing the following applications with its **action for infringement:**

- I. It is established that the defendant has infringed European Patent No. 2 568 724 B1.

- II. The defendants are ordered to

cease and desist,

1. Radio communication devices

which can be configured to transmit a reference signal with a transmission bandwidth in a given system bandwidth, with control channels assigned to both ends of the same [system bandwidth] and the transmission bandwidth between the control channels, or to transmit reference signals with a low bandwidth with frequency hopping, and the radio communication devices comprise: an allocation unit configured to allocate the reference signals to frequency resources; a transmission unit configured to transmit the allocated reference signals,

in the Federal Republic of Germany, the French Republic, the Italian Republic, the Netherlands and the Kingdom of Sweden, or to place them on the market or use them, or to import or possess them for these purposes,

where

the transmission bandwidth varies in the given system bandwidth, and the allocation unit allocates the reference signals such that the reference signals are allocated frequency resources each having the small bandwidth which is invariable regardless of changes in the transmission bandwidth, the frequency resources being uniformly distributed in a frequency band of the transmission bandwidth in accordance with the change in the transmission bandwidth.

(direct infringement of device claim 1)

especially if

a large number of different transmission bandwidths can be configured in one system bandwidth.

(direct infringement of device claim 2)

and/or in particular if

the assigning unit assigns the reference signals to the frequency resources, wherein one of the frequency resources having the low bandwidth is a transmitting unit. (direct infringement device claim 3)

and/or in particular if

the allocation unit allocates the reference signals to frequency resources into which a frequency band having the transmission bandwidth is evenly divided, wherein one of the frequency resources having the narrow bandwidth is a transmission unit. (direct infringement device claim 4)

and/or in particular if

the allocation unit allocates the reference signals to frequency resources, the number of which is different depending on the changes in the transmission bandwidth, wherein one of the frequency resources with the low bandwidth is a transmission unit. (direct infringement device claim 5)

and/or in particular if

the allocation unit allocates the reference signals to frequency resources, each of which has a different frequency band, one of the frequency resources with the low bandwidth being a transmitting unit.

(direct infringement of device claim 6)

and/or in particular if

the allocation unit allocates the reference signals to frequency resources that cover the entire frequency band of the transmission bandwidth, one of the frequency resources with the low bandwidth being a transmission unit.

(direct infringement of device claim 7)

and/or in particular if

the allocation unit allocates the reference signals to frequency resources by means of frequency hopping, whereby one of the frequency resources with the low bandwidth is a transmission unit.

(direct infringement of device claim 8)

and/or in particular if

the allocation unit allocates the reference signals to frequency resources that cover the entire frequency band of the transmission bandwidth by means of frequency hopping, whereby one of the frequency resources with the low bandwidth is a transmission unit.

(direct infringement of device claim 9)

and/or in particular if

the allocation unit allocates the reference signals to a plurality of resources which are frequency resources and which are different time resources, wherein one of the frequency resources having the low bandwidth is a transmitting unit. (direct

infringement device claim 10)

and/or in particular if

the allocation unit allocates the reference signals to a plurality of resources which are frequency resources and which are time resources differing by a certain time interval, wherein one of the frequency resources with the low bandwidth is a transmission unit.

(direct infringement of device claim 11)

and/or in particular if

which further comprises a receiving unit configured to receive control information associated with an assignment of the reference signals, wherein the assignment unit assigns the reference signals based on the control information.

(direct infringement of device claim 12)

2. Apparatuses suitable for performing a radio communication method which can be configured to transmit a reference signal with a transmission bandwidth in a given system bandwidth, both ends of the same control channels being assigned and the transmission bandwidth being between the control channels, or to transmit reference signals with a low bandwidth with frequency hopping

in the Federal Republic of Germany, the Federal Republic of Germany, the French Republic, the Italian Republic, the Netherlands and the Kingdom of Sweden,

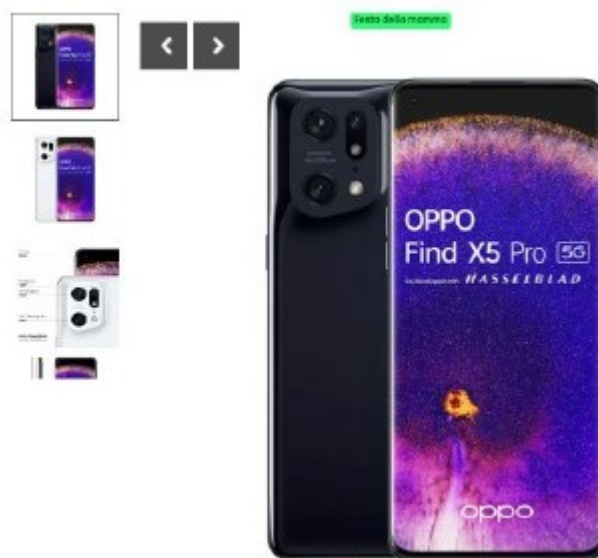
wherein the radio communication method : the following steps:

assigning the reference signals to frequency resources; and transmitting the assigned reference signals, the transmission bandwidth varies in the given system bandwidth, and the reference signals are assigned to frequency resources each having the small bandwidth which is invariable regardless of changes in the transmission bandwidth, wherein the frequency resources are uniformly distributed in a frequency band of the transmission bandwidth according to the change in the transmission bandwidth.

(indirect infringement of procedural claim 13)

The defendants have infringed the patent by distributing 4G-enabled products in the territory of the Federal Republic of Germany, the French Republic, the Italian Republic, the Netherlands and/or the Kingdom of Sweden.

The 4G-capable products include, in particular, 4G-capable smartphones such as the OPPO Find X5 Pro



and 4G-enabled smartwatches, such as the 4G-enabled smartwatch



OPPO Watch 46 mm LTE - Smartwatch (AMOLED Display, GPS, Bluetooth 4.2, Wear OS by Google, VOOC Schnellladefunktion, 5 ATM), Schwarz

Besuche den OPPO-Store

4.1 ★★★★★ 86 Sternbewertungen

411 €

Vorauszahlung der Importgebühren ausgewiesen -
Preisangaben inkl. USt. Abhängig von der Lieferadresse kann die USt. an der Kasse variieren. Weitere Informationen.

Nutzen Sie die Monatsrechnung und bezahlen Sie erst im nächsten Monat [Mehr erfahren](#)

Größe: 46mm
Farbe: Schwarz

Marke	OPPO
Modellname	Watch 46 mm (LTE)
Set	es ist
Farbe	Schwarz
Besonderes Merkmal	GPS
Form	Quadratisch

▼ Mehr anzeigen

Info zu diesem Artikel

- Das Dual-Kurve-Display ist so konzipiert, dass Sie Ihre Inhalte aus jedem 90-Grad-Winkel bequem anzeigen können.
- Die Oppo Watch mit 46 mm kann rechtzeitig Regen oder Wasser

III. The defendants are ordered to pay, at their own expense

1. to recall the products mentioned under No. II. from the distribution channels;
2. to permanently remove the products mentioned under No. II. from the distribution channels;
3. to destroy the products mentioned under No. II;

IV. The defendants are condemned,

1. to provide the plaintiff, in a list structured for each month of a calendar year and according to infringing products in electronic form, which can be analysed with the aid of a computer, from 17 December 2014, with information on the products mentioned under No. II, on

- a) the origin and distribution channels of the products mentioned under No. II;
- b) the quantities delivered, received or ordered and the prices paid for the products mentioned under No. II;
- c) the identity of all third parties involved in the distribution of the products mentioned under No. II;

2. to to the plaintiff its accounts to prove the information provided pursuant to No. IV.1. plus the information on the profit realised by providing the following documents for each month of a calendar year and for each infringing product in electronic form which can be analysed with the aid of a computer:

- a) Invoices - or, if these are not available, delivery notes - for the individual deliveries, whereby the respective deliveries according to offer quantities,

The offer must include a breakdown of the offer times, prices of the goods offered and type designations as well as the names and addresses of the commercial recipients of the sales offers for all products sold or otherwise disposed of;

b) Evidence of the advertising carried out, including evidence of these advertising activities, breaking down the advertising carried out by advertising medium, its distribution, the distribution period and the distribution area;

c) Proof of costs, with a breakdown of costs by individual cost factors and the profits realised;

d) Invoices - or, if these are not available, delivery notes - and corresponding statements of all costs incurred, on which the defendants rely in calculating their profits;

the accuracy of which is audited and confirmed by a sworn auditor appointed by the plaintiff at the defendant's expense, whereby the auditor is obliged to maintain confidentiality vis-à-vis the plaintiff beyond the above-mentioned information;

V. The applicant is authorised, at the defendant's expense, to announce and publish the decision in whole or in part in the following public media: Frankfurter Allgemeine Zeitung, Handelsblatt newspaper, Le Monde newspaper, Les Échos newspaper, Corriere della Sera newspaper, De Telegraaf newspaper and Dagens Nyheter newspaper.

VI. It is established that the defendants are jointly and severally liable to compensate the plaintiff for all damages incurred by Panasonic Intellectual Property Corporation of America as a result of actions pursuant to No. II. since 17 December 2014 and which the plaintiff has incurred since 29 July 2016 and will incur in the future.

VII. The defendants are ordered jointly and severally to pay the plaintiff an amount of EUR 250,000.00 as provisional damages;

VIII. The defendants are ordered to pay the costs and expenses of the proceedings.

IX. The decision can be enforced as follows:

1. The orders mentioned under No. II.1 and II.2 are directly enforceable.

In the event of any violation of this order, the defendants shall pay a penalty payment of EUR 5,000 each.

2. The Orders referred to in No. III, No. IV, No. VII, No. VIII are enforceable after the plaintiff has

a) has notified the court which part of the Orders it intends to enforce and after the notification has been served on the defendant; and/or

b) the plaintiff has submitted a certified translation of the Orders into the official language of the Contracting Member State in which enforcement is sought and after the notice and, where applicable, the certified translation have been served on the defendant;

3. After the expiry of a period of 45 days after service pursuant to No. IX.2, the defendants shall pay to the Court a penalty payment of EUR 2,000 per day of delay in the event of any breach of any of the Orders referred to in No. III, No. IV, No. VII and/or No. VIII;

8. The **defendants** request that the applications in the **infringement action be dismissed**, that the defendants be provisionally awarded reimbursement of the costs of the infringement action and that the plaintiff be ordered to pay the costs,

In the alternative

make the enforcement of the decision subject to the prior provision of security by the applicant in an appropriate amount (R. 352.1, 354.2 RoP), which may be provided by a written, irrevocable, unconditional and unlimited guarantee from a credit institution authorised to do business in the territory of a Member State of the UPC Agreement, the amount of which is left to the discretion of the court,

allow the defendants to avert enforcement of the decision by providing security, which may be provided by a written, irrevocable, unconditional and unlimited guarantee from a credit institution authorised to do business in the territory of a UPC Agreement Member State, without regard to any security provided by the applicant (R. 9.1 RoP).

9. In the context of the **action for annulment**, the **defendants** request:

declare the European patent EP 2 568 724 B1 invalid in its entirety with effect for the contracting states of the UPCA in which the patent is validated [Federal Republic of Germany, France, Italy, the Netherlands and Sweden] (R. 25 RoP);

provisionally award the defendants the reimbursement of costs for the action for annulment (R. 150.2 RoP) and order the applicant to pay the costs in this respect as well.

10. The plaintiff requests that the counterclaim **for a declaration of invalidity be dismissed**, alternatively that the patent be maintained in amended form with regard to claim 1 and claim 13 and that the counterclaim for invalidity of the patent be dismissed as unfounded in all other respects and that the defendants be ordered to pay the costs of the counterclaim. With regard to the wording of the request for amendment, reference is made to the document dated 21 March 2024 together with the annexes.

11. In the context of their **FRAND counterclaim**, the defendants last request:

Main application version according to Reply counterclaim FRAND of 19 August 2024 (filed pursuant to Rule 9 RoP in workflow App_47681/2024):

It is requested,

I.1 Order Panasonic to accept Oppo's licence agreement offer dated 17 July 2024, as shown in Annex VB-FC14 (confidential),

I.2 in the alternative, to order Panasonic to submit a licence agreement offer to Oppo with the content as shown in Annex VB-FC14 (confidentiality required),

I.3 in the further alternative, to order Panasonic to submit a licence agreement offer to Oppo with the content as shown in Annex VB-FC16 (confidentiality required),

whereby, in the alternative, an amount to be determined by the court between in the green space in point (2), an amount to be determined by the court and the lump sum to be entered there in the blue position is as follows:

In the alternative, a different amount, determined by the court to be fair, reasonable and non-discriminatory, is to be set at the yellow and green positions in points (1) and (2) respectively of Annex VB-FC16 and the lump sum provided for there in blue is calculated in accordance with the calculation method specified in the above paragraph;

II.1 in the alternative to the applications in point I. and in the event that none of the applications therein is granted, declare that Oppo is entitled to a licence to Panasonic's patents essential to the 3G and 4G standards on fair, reasonable and non-discriminatory (FRAND) terms,

and to determine the licence rate to be paid by Oppo for the use of these patents in the territory of the EPC Contracting States (the EP Territory), such FRAND licence rate for the EP Territory being

- ██████████ per 4G multimode device and ██████████ per 5G multimode device,
- or alternatively between ██████████ and ██████████ per 4G multimode device and between ██████████ and ██████████ per 5G multimode device,
- or, in the further alternative, such other rate as the court deems fair, reasonable and non-discriminatory;

II.2 subject to the existence of a FRAND licence agreement, to require Oppo to pay to Panasonic, from the date of the judgment, as a lump sum, this royalty rate multiplied by the number of units sold by ██████████ to ██████████ units sold from ██████████ to Panasonic, whereby the lump sum

or, in the alternative, between ██████████ and ██████████ or, in the alternative, a lump sum determined by the court to be fair, reasonable and non-discriminatory;

II.3 To require Panasonic to cooperate fully to obtain a FRAND licence on the terms set by your court;

III.1 further in the alternative in the event that neither the applications under I. nor II. should be granted,

(a) declare that Oppo is entitled to a licence to Panasonic's patents essential to the 3G and 4G standard on fair, reasonable and non-discriminatory terms (FRAND);

(b) declare that the licence conditions, alternatively the licence fees, contained in Panasonic's offer of 22 December 2023 for a licence from Oppo to Panasonic's patents essential for the 3G and 4G standard (Annex VB-FC15) are not FRAND;

(c) that Panasonic has abused a dominant market position;

(d) declare that the terms of a licence, or alternatively the licence fees, as contained in Oppo's counter-offer of 17 July 2024 for a licence from Oppo to Panasonic's patents essential to the 3G and 4G standard (Exhibit VB-FC14) are FRAND;

(e) order Panasonic to submit a FRAND counter-offer to Oppo, which would not follow the following FRAND licence rate for the EP territory: ██████████ per 4G-multimode device and ██████████ per 5G multimode device, alternatively between ██████████ and ██████████ per 4G multimode device and between ██████████ and ██████████ per 5G multimode device, or in the alternative, the amount that the court considers to be FRAND in the circumstances of this case;

IV. Order Panasonic to pay Oppo the reasonable and proportionate legal costs and other expenses incurred by Oppo by way of an interim order pursuant to Rule 150(2) RoP, with the amount to be determined at a later date.

The version of the application filed with the "Counterclaim for determination of a FRAND fee for the EPC area" dated 22 December 2023, which is being pursued further in the alternative, reads as follows:

It is requested,

(i) declare that Oppo is entitled to a licence to Panasonic's standard-essential patents for the 3G and 4G standards on fair, reasonable and non-discriminatory (FRAND) terms; and

(ii) explain what the essential terms of such FRAND licence are, including at least the rate Oppo has to pay for the use of such patents in the territory of the EPC Contracting States (the EP Territory); and

(iii) declare that the FRAND licence rate for the EP area is ██████████ per 4G multimode device and ██████████ per 5G multimode device, or alternatively between ██████████ per 4G multimode device and between ██████████ per 5G multimode device, or in the alternative, the amounts which the Court considers to be FRAND in the circumstances of the present case;

(iv) subject to the existence of a FRAND licence agreement, Oppo,

a. as of the date of the judgement as a lump sum this licence rate multiplied by the number of the licence ██████████ to ██████████ units sold Panasonic, with the lump sum being ██████████ in the alternative, between ██████████ or in the alternative a lump sum by the court;

b. to pay this licence rate to Panasonic for each device sold since the date of the decision;

(v) To require Panasonic to cooperate fully to obtain a FRAND licence on the terms set by your court;

in the alternative,

(vi) declare that Oppo is entitled to a licence for Panasonic's standard-essential patents for the 3G and 4G standards on fair, reasonable and non-discriminatory terms (FRAND);

(vii) find that the licence terms for Panasonic's patents essential to the 3G and 4G standards, as contained in Panasonic's offer described in the body of this document, are not FRAND;

(viii) that Panasonic has abused a dominant market position;

(ix) declare that the terms of a licence for Panasonic's patents essential to the 3G and 4G standards, as contained in Oppo's counter-offer described in the body of this document, are FRAND;

(x) order Panasonic to submit a FRAND counter-offer to Oppo showing the following FRAND licence rate for the EP Territory: [REDACTED] per 4G multimode device and [REDACTED] per 5G multimode device, or in the alternative [REDACTED] per 4G multimode device and between [REDACTED] [REDACTED] per 5G multimode device, or in the alternative, the amount that the court considers to be FRAND in the circumstances of this case;

and in any case

(xi) Order Panasonic to pay Oppo's reasonable and proportionate legal costs and other expenses incurred by way of an interim Order under Rule 150(2), the amount to be determined at a later date.

The plaintiff considers the amendment in the Reply to the FRAND counterclaim to be late, the amendment is not admissible, the defendant's changes to the plaintiff's draft contract of 22 December 2023 are not FRAND-compliant.

The plaintiff

"recognises that a willing license seeker entitled to a licence for the standard-essential patents for the 3G and 4G standards on fair, reasonable and non-discriminatory (FRAND) terms" (document dated 22 March 2024)

and applied for,

I. otherwise dismiss the counterclaim as the defendants are unwilling to licence;

II. order the defendants to pay the costs,

1. to pay the costs and expenses of the proceedings;
2. provisionally reimburse the costs.

In the alternative,

In the event that the counterclaim is admissible and the court - contrary to the plaintiff's view - is of the opinion that the defendants acted as willing contracting parties in the negotiations at issue with the plaintiff, the plaintiff requests the court to rule on the counterclaim,

III. declare that a licence justifying the defendant's infringing acts of use of EP 2 568 724 is a worldwide licence to the plaintiff's 3G and 4G (multi-mode) portfolio and that a royalty rate for such a licence of [REDACTED] per 3G/4G (multi-mode) device is fair, reasonable and non-discriminatory [REDACTED]

IV. further, in the alternative to the application under III., declare which licence justifies the defendant's infringing acts of use of EP 2 568 724 and which licence rate per 3G/4G (multi-mode) device is fair, reasonable and non-discriminatory (FRAND);

V. order the defendants to pay the costs,

1. to the plaintiff for 3G/4G (multi-mode) devices sold and not licensed by the defendants, alternatively for sold and not licensed 3G/4G (multi-mode) multi-mode devices in the "EP", "JP" and "US" territories, a licence in the amount per [REDACTED] 3G/4G multi-mode device for the past and the future pay.

2. in the alternative under V.1. to pay to the plaintiff for 3G/4G (multi-mode) devices sold and not licensed by the defendants, in the alternative for 3G/4G (multi-mode) devices sold and not licensed in the "EP", "JP" and "US" territory, a licence in the amount corresponding to the application under IV. for past and future acts of use.

VI. also dismiss the further counterclaim; in

the alternative to VI.

VII. to oblige the counterclaimant 1),

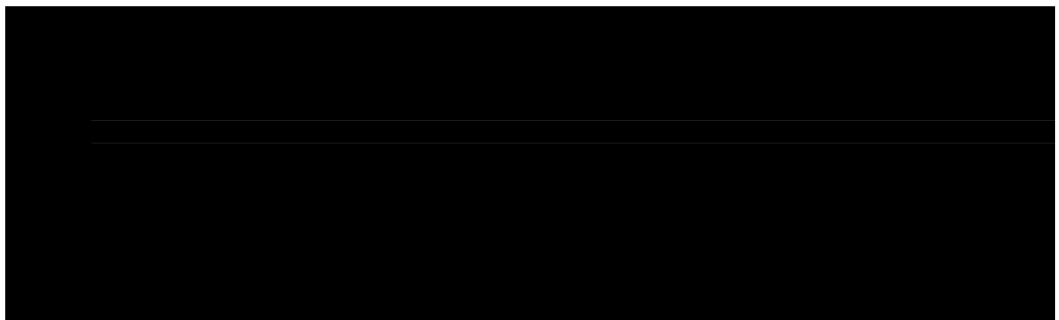
1. to accept the licence agreement offer of the counter-defendant dated 22.12.2023 in the version of Annex KAP FRAND WK 19 - Strictly Confidential;

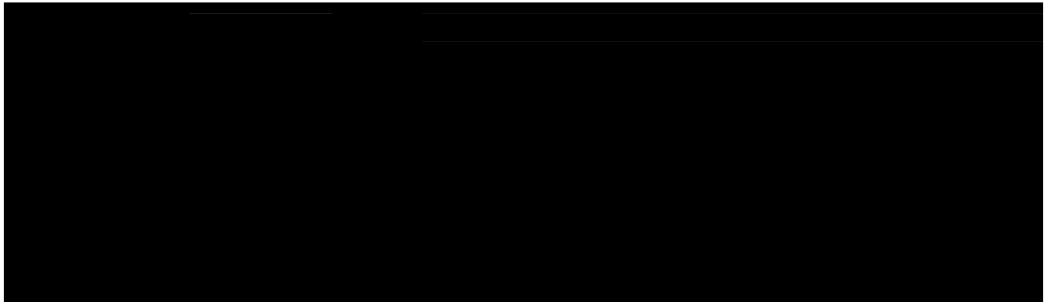
In the alternative to item VII.1,

2. to submit a licence agreement offer to the counter-defendant in the version of Annex KAP FRAND WK 19 - Strictly Confidential;

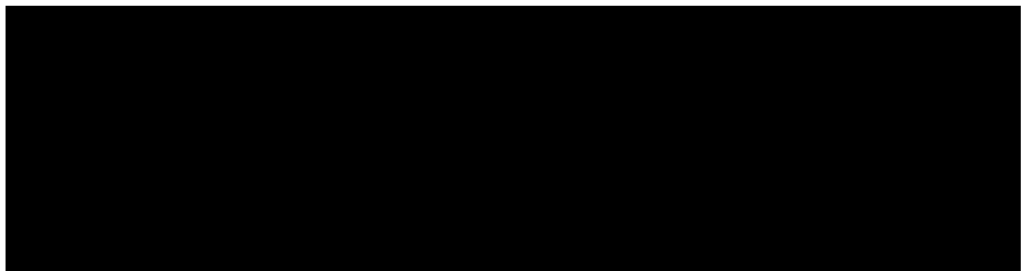
Further in the alternative to item VII.2,

to submit a licence agreement offer to the counter-defendant in the version of Annex KAP FRAND WK 19 - Strictly Confidential, with the proviso that clauses 4.1 and 4.2 are replaced as such as set out below:





whereby further in the alternative to item VII.3:



VIII. in the alternative to the applications in points VII.1 to VII.4 and in the event that none of the applications therein should be granted,

1. declare that a willing licence seeker entitled to a licence to the defendant's patents essential to the 3G and 4G standards on fair, reasonable and non-discriminatory (FRAND) terms and determine the royalty rate that a willing licence seeker is entitled to.

willing licence seeker, who is comparable to the counterclaimants - with the exception of willingness to licence - in all other respects, must pay for the use of these patents worldwide, whereby this FRAND licence rate is [REDACTED] per LTE Compliant Mobile Product(s),
- or, in the alternative, such other rate as the court deems fair, reasonable and non-discriminatory

2. subject to the existence of a FRAND licence agreement, to oblige the counterclaimants to pay the licence rate from VIII.1, multiplied by the number of sales, as a lump sum from the date of the judgment,

[REDACTED]
reasonable and non-discriminatory;

IX. further in the alternative in the event that neither the applications under VII. nor VIII. should be granted,

1. declare that the counterclaimants have not behaved in a FRAND-compliant manner;

2. declare that the licence conditions, or alternatively the licence fees, as contained in the offer from the defendant dated 22 December 2023 in the version of Annex KAP FRAND WK 19 - Strictly Confidential - for a licence to the defendant's patents essential for the 3G and 4G standard are FRAND;

3. declare that the conditions of a licence, alternatively the licence fees, as contained in the counter-offer of the counterclaimant 1) dated 17 July 2024 in the version of Annex VB-FC 14 - Strictly Confidential for a licence from counterclaimants to the counter-defendants' patents essential for the 3G and 4G standard are not FRAND;

X. condemn the counterclaimants,

1. also to bear the further costs and expenses of the proceedings incurred as a result of the extension of the action;

2. also provisionally reimburse the further costs.

12. The defendants consider these applications to be inadmissible and request that they be dismissed.

FACTUAL AND LEGAL POINTS OF CONTENTION

Injury discussion

13. According to the plaintiff, the defendants directly infringe claim 1 of the patent in suit and indirectly infringe claim 13 by offering, placing on the market, using or importing or possessing for these purposes 4G-capable products, in particular 4G-capable mobile phones and smartwatches (attacked embodiments) in the Federal Republic of Germany, the French Republic, the Italian Republic, the Kingdom of the Netherlands and the Kingdom of Sweden. In the applicant's view, the attacked embodiments fulfil all the features of claim 1 when used in the 4G network and apply a method according to claim 13.

14. The defendants, on the other hand, are of the opinion that the contested embodiments do not realise features 1.1, 1.3.1, 1.3.2 and 1.3.2 in particular. The plaintiff misunderstands the term "transmission bandwidth". Contrary to the applicant's view, the transmission bandwidth is to be understood as the bandwidth within a given system bandwidth which is located between the control channels and which is therefore available for the transmission of reference signals and user data. The broadband SRS signal referred to in the claim extends over this transmission bandwidth, which is therefore defined by the system bandwidth minus the bandwidth required for the PUCCH. The same applies to the narrowband SRS, which is distributed by means of frequency hopping. Contrary to the applicant's opinion, the transmission bandwidth is not defined by the beginning of the first SRS signal transmitted in the bandwidth to the end of the last SRS signal transmitted in the bandwidth, i.e. the area actually covered by the SRS signals. This variance of the transmission bandwidth is then also addressed in feature 1.3.1.

The plaintiff has not been able to show on the basis of the standard that the reference signals are allocated in accordance with feature 1.3.2 in such a way that the reference signals are allocated to frequency resources, each of which has the small bandwidth that is invariable irrespective of changes in the transmission bandwidth. This is denied by the defendants by arguing that in the standard a change in C_{SRS} can cause a change in m_{SRS} and thus a change in the bandwidth of the reference signal and thus the bandwidth of the reference signal is not fixed regardless of C_{SRS} .

In particular, the SRS signals could not be distributed evenly in the transmission bandwidth according to the standard in the sense of feature 1.3.3. After implementation by the standard, the gaps between the control channels and the frequency ranges actually covered by the SRS signals, which are known from the state of the art and addressed as disadvantageous, remain. The defendants have also pointed out that the parameters m_{SRS} and C_{SRS} addressed by the plaintiff are only assigned semi-statically and that the adjustment is only possible in 80ms intervals at the shortest (Duplik Technik para. 83 et seq.). On the other hand, the PUCCH changes every millisecond and the data assigned to the PUCCH in each subframe is calculated by the terminal device from data that it received from the base station in the downlink only 4 milliseconds before the respective subframe, which is why the LTE standard relied on excludes an adaptation of the (semi-) static SRS configuration to the rapidly and dynamically varying PUCCHs.

15. The defendants also criticise the plaintiff's submission on the acts of infringement of which the defendants are accused as being too unsubstantiated. In particular, the defendants had already withdrawn from the German market some time ago.

16. The legal consequences sought by the plaintiff are too far-reaching. In particular, a cease and desist order was disproportionate and, moreover, there were antitrust reasons for the award (see below). The threat of a penalty payment raises concerns. It was already too high and therefore disproportionate and too vague with regard to actions other than sales. The recall,

The applications for removal from the distribution channels and destruction are already too vague and also disproportionate. The information requested was too broad, in particular because it was only to be directed at the information for a calculation of damages by way of licence analogy, because the claim for damages was limited to this for reasons of antitrust law. A claim for disclosure of the books does not exist anyway and is the subject of separate proceedings under the Rules of Procedure. There was no sufficiently substantiated interest in publishing the judgement. There is a lack of explanations for the award of provisional damages.

FRAND objection

17. The defendants argue that the assertion of the claim for injunctive relief and the other forward-looking claims under the patent are excluded because they are precluded by antitrust law.
18. Contrary to the plaintiff's view, the FRAND objection should not only be on the individual patent in suit, but also on a comprehensive licence. Article 6 (1) sentence 1 of the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR) already requires that the defendant be able to defend itself comprehensively, and it also follows from European law that the comprehensive FRAND defence must be admitted.
19. The infringement notice required by the case law of the ECJ is already lacking, as shown by the European Commission's amicus curiae submission in the proceedings before the Munich Higher Regional Court 6 U 3824/22 Kart (Annex VB-F 45). It is necessary that the infringement notice formally indicates the nature and type of infringement in the cover letter itself - an allocation to external documents is not sufficient.
20. The declaration of readiness to licence was to be understood solely as a formal step towards the start of negotiations, as the European Commission rightly pointed out

that this step should not be mixed up with the counter-offer, which will only be examined later. The willingness should also not be assessed depending on the later offers and counter-offers. The Commission makes it clear in its submission that the plaintiff's offer must first be examined to determine whether it is FRAND. This is also in line with the view of the Düsseldorf Regional Court in its order for reference to the ECJ, which was previously finalised due to the termination of the proceedings.

21. The plaintiff's behaviour was an abuse of rights, as there was no written FRAND offer from the plaintiff until the statement of defence. An offer by the plaintiff was first contained in the e-mail of 22 December 2023 (Annex VB-F 20 and 21). There was therefore a lack of a concrete written licence offer before the action was brought, which, according to the correct view of the European Commission, could not be made up for in the ongoing infringement proceedings. Until the orders for reference were issued in the present proceedings, no settlement licences had been made available to the defendants that would have made it possible to verify possible discrimination against the defendants. The plaintiff had a burden of proof in this respect, which it did not fulfil. It had initially approached the defendants with excessive licence claims without disclosing the basis of calculation or making a comparison with other licensees. The extent of the plaintiff's concession in the negotiations alone proves that its initial demands were contrary to FRAND. The economic expert of the defendant proves the FRAND-infringement of the

plaintiff's claims.

[REDACTED]

[REDACTED] of law. The defendants were willing to take a licence, as evidenced by their participation in a large number of discussions on technical and economic circumstances, although the plaintiff had not initially submitted a complete licence agreement. It was therefore the plaintiff

which broke off the negotiations before the action was filed. This is evidenced by the chronological sequence of the talks held between the parties since July 2019, as listed by the defendants in a summary table in the statement of defence (statement of defence para. 333, p. 100 - 107 with the supplementary statements in their rejoinder).

22. From the outset, the plaintiff also had to choose between "major markets" (US, EP, JP) and "Other Markets" (CN and others) and offered two different licence rates, a rate linked to price incentives and a standard rate. The plaintiff never explained the basis for its fee determination. Compared to its initial offers, the plaintiff then conceded in October 2021 as far as the standard rate was concerned, but increased the Incentivised Compromised Rate (ICR) and presented this as a concession. The plaintiff shifted these parameters again in April 2022 without sufficient explanation. The applicant also built up time pressure by reserving the right to no longer offer the ICR if no agreement was reached. Furthermore, the calculatory basis was not explained and no comparative licences were disclosed, although the plaintiff referred to alleged licence agreements with two competitors of the defendant that it did not name. The product groups also remained unclear. The time periods covered in the plaintiff's and defendant's proposals were also different and therefore not comparable.

23. With regard to the economic assessment of the plaintiff's licence amount claims, the defendants refer to the expert opinion of their economic expert and explain it (Annex VB-F 18). In it, the expert comes to the conclusion that the plaintiff's claims are contrary to FRAND. The expert converts the indicators for a worldwide FRAND licence into indicators for the EP territory and adjusts the licence rates by taking into account the relative strength of the plaintiff's European patents compared to the worldwide portfolio and the relatively higher overall licence rate in the EP territory compared to other global markets such as China. The top-down approach applied by the expert opinion calculates

First, a percentage total licence fee rate is calculated, which may be dependent on certain global regions and/or weighted according to whether the devices can operate in different standard modes (multimode weighting). The SEP holder's percentage share of the total licence fee is then calculated by calculating its share of the standard. Finally, the average sales price of the implementer's devices should be taken into account. The expert thus follows an established calculation methodology. The total royalty rate should be assumed to be 6%, but this should be weighted with regard to China, where the vast majority of manufacturing and sales by the defendant's group of companies take place. It follows from court decisions that the customary total licence rate in China is approximately 65.5% of the rate in other markets, i.e. 65.5% of 6%. The applicant wrongly fails to make this regional adjustment. In addition, the overall rate should also be weighted with regard to the 4G and 5G devices, depending on the importance of the standard for the device (cf. KE para. 392). The expert then determines the share of the SEP holder in the total number of patent families relevant to the standard and uses the patent families declared by the SEP holder on the basis of data from IPlytics. According to this, the plaintiff holds approx.

of all registered 4G SEPs and [REDACTED] of all registered 3G SEPs, whereby the [REDACTED] plaintiff in China, the defendant's largest market, has a portfolio that is approximately [REDACTED] smaller than that of Japan and the USA, for example. The defendant's average wholesale sales price is then multiplied by the ad valorem licence rates thus obtained. In contrast, the retail price is not relevant. The corresponding data used by the expert is based on standard commercial data from the market research company International Data Corporation (IDC data). The resulting global licence rate of the party expert deviates from the plaintiff's rates by a factor of [REDACTED], and the rate weighted for the EP territory is also significantly lower than the plaintiff's rates.

24. This disparity is also supported by a comparison with two of the defendant's licence agreements and indicators from published UK High Court decisions (InterDigital v Lenovo ([2023] EWHC 539 (Pat)) and Optis v Apple ([2023]

EWHC 1095 (Ch)). Also with a view to the data collected using these

Based on the global licence rates derived from the benchmarks, the rates demanded by the applicant for 4G [REDACTED] are higher than the FRAND value and for 5G MM [REDACTED] higher than the FRAND price. This disproportion not change significantly even if the weighting were applied to the EP territory. The same applies with regard to the flat-rate licence amount [REDACTED] as a FRAND corridor for a global lump sum and of [REDACTED] for the EP territory, calculated on the [REDACTED]

25. The initial expert opinion was then confirmed in a supplementary expert opinion following the submission of settlement licence agreements by the plaintiff in the meantime. In this respect, reference is made to the presentation of the FRAND counterclaim and the FRAND duplicate.
26. In addition to these economically derived arguments, the defendants argue in legal terms that the plaintiff is abusing its dominant position on the licensing market contrary to Art. 102 TFEU. The use of the 4G standard is essential in order to survive on the market. The telecommunications providers had switched off 2G and 3G networks in Europe and 4G backward compatibility was also indispensable for 5G end devices due to the still insufficient network coverage of the 5G network.
27. The entitlement to a licence also follows from the plaintiff's ETSI-FRAND declaration for the patent families of the patent in suit.
28. The plaintiff was obliged to equalise the existing information gap with the defendants and therefore to explain the content of its offer so that the implementer could examine it. The plaintiff did not fulfil this obligation.
29. The perceptibility of the impairment, which the plaintiff describes as significant with reference to the MEO decision of the ECJ, is irrelevant.

30. The defendant's counter-offer of 17 July 2024 (VB-F 38), which is referred to in more detail in connection with the submission on the FRAND counterclaim (see there), is FRAND. A lump sum is offered for a worldwide licence and this amount is deposited with security in the form of a bank guarantee (Annex VB-F 43). It was wrongly rejected by the plaintiff on 2 August 2024 (Annex VB-F 40).
31. The **plaintiff, on the other hand, argues** that the defendants cannot invoke the defence of compulsory licensing under antitrust law because they are not willing to take a licence. They had never clearly declared their willingness to take a licence, nor had they information or security. The defendants' group of companies had also never sufficiently dealt with the content of the plaintiff's contractual offers and technical information and had deliberately delayed the technical exchange and always requested new claim charts without then dealing with them appropriately.
32. With reference to the case law of the Court of Justice of The Hague (judgment of 24 December 2019, 200.233.178/01 - Philips/Wiko), the plaintiff believes that it is not required under European law for the SEP holder to justify why it considers its offer to meet FRAND criteria - in particular, no confidential settlement licence agreements should be made available at this stage. Furthermore, it is not necessary to a fully formulated offer that is ready to be signed; rather, it is sufficient if the key commercial points are included and it can form the starting point for negotiations on further details. If the user does not agree, he is in any case obliged to react and object and must submit a counter-offer. Information must be provided and security must be provided as soon as the SEP holder has rejected the counter-offer of the infringer who is already using the invention. According to the case law of the ECJ, a third-party determination can only be considered by mutual agreement; in particular, the determination of content by a state court is not a third-party determination within the meaning of ECJ case law.

33. A sufficient infringement notice covering the patent in suit had already been issued two years before the action was filed (Annex KAP FRAND 1 and 2). In addition, claim charts had in any case been sent for family members of the patents in suit, specifically also for the patent in suit on 31 August 2020. The defendants had then only declared their intention to enter into negotiations, which was insufficient.
34. The plaintiff's first offer of 4 August 2020 had already been explained and FRAND.
35. The plaintiff had rejected a lump-sum counter-offer made by the defendants on 27 August 2021 on 26 October 2021, submitting a new offer (VB-F4), without any information having been provided thereafter or security having been provided - at least once in the amount of the lump sum that the defendants themselves considered to be FRAND. Moreover, the counteroffer was delayed after the plaintiff's first offer was dated 4 August 2020. For the first time - insufficiently in the expert opinion of the defendant's expert - information was provided in the statement of defence and counterclaim for determination of a FRAND licence fee of 21 December 2023. The fact that the defendant did not even provide its own expert with its own figures, but had him give his opinion solely on the basis of the IDC data, proves that the figures could not be regarded as information. The IDC data is also not easily verifiable for the plaintiff because this requires the registration of a user account and the payment of considerable fees.
36. In their calculations, the defendants had assumed an inaccurate and unrealised share of the plaintiff in the LTE standard. Conversely, the plaintiff had shown, on the basis of information from three different independent sources, that the defendants' alleged sales figures were inaccurate.

37. The defendants had not approached out-of-court dispute resolution attempts by insisting on their own positions, but had abused the discussions solely for the purpose of delay.

38. The defendants were wrong to take the view that the plaintiff's offers did not fall within the FRAND corridor. The fact that a fully formulated and written contractual offer was initially lacking was legally irrelevant - such an offer was never requested during the negotiations. Comparative licences were also never requested, and submission was also not possible due to the confidentiality clauses in the contracts.

39. All of the plaintiff's offers are FRAND, including the blanket licence offer of 22 April 2022, which covers all markets. In this regard, the plaintiff also showed that there were two blanket licence holders who paid significantly higher prices than those offered by the defendants. In the absence of figures provided by the defendants, the plaintiff used the average of three independent data providers for the past use and estimated future sales over the envisaged term on the basis of the sales of the defendants. [REDACTED]

[REDACTED] predicted. The defendants had deliberately misinterpreted this offer in order to delay the talks. Although certified shipments for [REDACTED] and were submitted, [REDACTED] the figures for the same year were not presented. [REDACTED] objective year [REDACTED]

40. The applicant had submitted its [REDACTED] [REDACTED] reduced again and based on newly available information [REDACTED] reduced again significantly. In order to reach an agreement, she then reduced the lump sum again. [REDACTED] [REDACTED] reduced. Conversely had it no significant concessions on the part of the defendant.

41. The fact that the plaintiff's offers are FRAND-compliant is also proven by the comparison with the plaintiff's third-party licences submitted in response to the order to produce (cf. the

as "Supplement Reply Part II - Non-Technical Part" in App_32606/2024 filed by the plaintiff on 31 May 2024, which now no longer contains the total redactions contained in the original version of the document and concerns the statements made there sub. II. "Settlement licence agreements" in para. 340 et seq.) The amounts there were to be "unpacked" because the licence agreements took into account factors that were not applicable in the present case. It had been pointed out to the defendants early on in the negotiations - albeit without naming the settlement licence partners - that their counter-offers were very significantly below the lump sums of the comparative licences.

[REDACTED]

[REDACTED] The sales figures of the third-party licence partners is taken from the [REDACTED]

[REDACTED]

[REDACTED] In

addition, the applicant must determine the weighted share the 4G licence fees.

Furthermore, the strength of the portfolio of the licence agreement partners in relation to that of the applicant regarding 4G and the value of the 4G standard in 5G products must be taken into account. The lump sum licence amount is then set in relation to the sales figures discounted in this way in order to obtain the unit licence. The result obtained in this way should be further adjusted in order to serve as a basis for comparison. First of all, the unit licence rate determined in this way should be increased by [REDACTED] % because the agreement with the defendants only has one licensor - the plaintiff - whereas the third-party licence [REDACTED] to the plaintiff also have one licensor. [REDACTED] The rate would

therefore have to be increased because the contractual partners would have to pay lower prices as they would saved transaction costs by obtaining two licences at the same time as a result of one negotiation. If, on the other hand, the third-party [REDACTED] licensees had had to negotiate two separate licences, their unit licence rate would have correspondingly more expensive. Furthermore, the defendant's licence rate would have to be further increased compared to the third-party licensees because they had purposefully participated in the negotiations and thus saved transaction costs. In this case, an early bird discount is customary in the industry, to which the defendants unwilling to take a licence are not entitled.

In addition, it had to be taken into account that the rates for the comparative licences lower in part because the contractual partners were particularly large and therefore important market development. This could be taken into account with up to a [REDACTED] surcharge. It should also be taken into account that the defendants had insisted on a blanket licence. This meant that there was a risk of undercompensation for the licensor or overpayment for the licensee for both parties to the contract. associated with the licence. In comparison with third-party licensees, a surcharge on the derived unit licence of [REDACTED] is therefore justified.

42. In addition, there are other special features to consider when unpacking. [REDACTED]

[REDACTED]

[REDACTED] Furthermore, high sales volumes which, in comparison, justified a reduction in the licence rate of the third-party licence partner. With regard to the further details of the submission on the plaintiff's third-party licence agreements, reference is made to the documents supplementing the Reply Part II - Non-technical part.

43. Moreover, the defendants had not argued that the acceptance of the plaintiff's allegedly FRAND-infringing licence offers was appreciable.

44. The defendant's counter-offers were clearly not FRAND. The multi-mode weighting of the defendant's private expert is already inaccurate because it underestimates the importance of the 4G standard. This is because 5G was only introduced in 2019 and even in developed regions, 5G-capable phones did not come onto the market until 2021; in other regions, 5G would not play an economic role until the end of the licence term. Therefore, the assumption that 4G will only play the role indicated in percentage points in the tables of the expert opinion in times of 5G is incorrect.

45. The regional adjustment for the plaintiff's portfolio made by the expert is also untenable. Moreover, it was not shown to what extent discrimination against the defendants could be inferred from this without objective reason, as they were only entitled to non-discriminatory treatment, but not to a specific licence fee. However, the defendants could not impose their desired licence structure on the plaintiff as long as the plaintiff treated them equally with its other licensees. The private expert's approach also contradicts leading court decisions by forming separate territorial licence rates for the USA, the EPC territory, Japan and China, including the rest of the world, for his FRAND rate. Moreover, according to the expert's own assumptions, the plaintiff's SEP portfolio is not weaker in China than in the rest of the world.

world, the rate is even higher than in the EP region. The reduction made for China by almost [REDACTED] is not justifiable. In addition, this approach contradicts the fact that the expert was not satisfied with the sales prices achieved by the defendant.

and its multi-mode weighting, while only taking into account the territorial markets in the plaintiff's patent strength and the defendant's alleged sales figures. The determination of the value of SEP for the standard on the basis of the price difference between products with and without mobile technology is also wrongly criticised by the defendant's expert.

46. The top-down method used by the defendant's expert already has weaknesses in itself, but the expert also bases his corresponding calculation steps on outdated data sets or data sets that are not sufficiently validated and are therefore rightly criticised in the industry because they neither sufficiently check the essentiality of the patents relevant to the overall standard nor sufficiently take into account the change in the overall patent portfolio over time. Therefore, the methodology could at best be used to check the plausibility of a FRAND result derived on the basis of comparative licences. The defendant's expert, on the other hand, deviates from the principles established to date within the top-down methodology without sufficient justification. For example, the defendant's expert discounts the number of the plaintiff's LTE patent families in the numerator of his share calculation, but not

the number of total LTE patent families in the denominator (Schedule 10.2 of the expert opinion) and thereby dilutes the strength of the plaintiff's portfolio. Moreover, it does not examine the essentiality of the patent families, but works solely with the number of declared patents and assumes incorrect acts of use, because it also only subjects sales in countries other than China to the licence rate applicable to China due to production in China and does not take into account that sales in other countries also require a licence for these countries.

47. The defendant's previous counter-offers were also not FRAND.

FRAND counterclaim

48. By separate document dated 21 December 2023, in addition to their statement of defence and counterclaim for a declaration of invalidity of the patent in suit, the defendants filed a

"Counterclaim for determination of a FRAND licence fee for the EP area".

49. The defendants argue that the UPC Agreement has jurisdiction under Article 32(1)(a) UPC Agreement for this counterclaim concerning a licence. The aim of the counterclaim is a FRAND licence between the parties in relation to the plaintiff's portfolio of standard-essential European patents for 3G and 4G-capable mobile devices and the determination of the licence rate to be paid for this. The licence rate thus determined for the EP territory should then also apply to the USA and Japan. For the rest of the world, the defendants decided to have the FRAND rate determined by a Chinese court, where the majority of manufacturing and sales take place. This regional division is also reflected in the parties' previous negotiation history. The request to set a FRAND rate is also justified by the timing of the proceedings, in particular with regard to the parallel proceedings pending in the UK to set a FRAND rate with Xiaomi.

50. The defendants would have been entitled to claim the patent on the basis of the plaintiff's ETSI declaration pursuant to Art. 6.1 ETSI IPR Policy, which also covers the patent in suit, and the applicable

French law, the beneficiary has an enforceable claim to the conclusion of a FRAND licence.

51. The licence rate offered by the plaintiff does not comply with FRAND conditions, as the expert opinion of the defendants' private expert shows in detail. After the establishment of the confidentiality regime in the present proceedings, the defendants submitted settlement licence agreements (Annexes VB-F 19 and 20) used in the private expert opinion (App_15307/2024) in a document dated 21 March 2024, without the need for an initially requested submission order to substantiate their submission.
52. Among other things, the judge-rapporteur issued guidance on the FRAND counterclaim in the Orders of 31 January 2024 (ORD_5505/2024) and 27 June 2024 (ORD_38680/2024).
53. The defendants have made further submissions - in addition to their submissions in the counterclaim and in response to the questions raised by the judge-rapporteur in his orders of 31 January 2024 and 27 June 2024. In particular, the defendants make it clear that they wish to be bound by a FRAND provision of the PANEL. For this reason, the defendants expressly formulated applications aimed at performance and pursued applications aimed at a declaratory judgement in the alternative. This is expressed in particular in the main motion under I., which seeks to oblige the plaintiff to accept the defendant's counteroffer of 17 July 2024 (VB-FC 14), which is set out in detail in the document and which the plaintiff rejected on 2 August 2024 (VB-FC 18). A bank guarantee was provided to cover the amounts owed (VB-FC 19), which is now being served. Information on acts of use was provided on the basis of the IDC data already available to the plaintiff, which was analysed in the expert opinions (VB-FC 11 and 13). This counter-offer was essentially based on the contractual terms and conditions from the plaintiff's draft contract; only three points had been modified, which is why, in the defendant's view, the remaining contractual terms and conditions not in dispute between the parties. The modifications consisted of the following



[REDACTED]

[REDACTED] The defendants would be entitled to Acceptance of this offer, which is pursued with the main claim I.1 directed at performance. This is intended to oblige the plaintiff to accept the defendant's offer. The plaintiff cannot counter this by arguing that FRAND is a corridor and that there can therefore be no claim to the conclusion of precisely one specific contractual offer.

54. Conversely, the defendants also made a binding commitment to accept an offer from the plaintiff (VB-FC 20) if a decision is made in accordance with applications I.2 or .3. In particular, application I.3 takes into account the fact that the defendants have brought another proceeding for the determination of the FRAND rate for the rest of the world (in addition to the determinations asserted here for the EP states, the USA and Japan) before the Beijing Intellectual Property Court in China. The defendants also undertook to accept the further (partial) licence rate set there.

55. Such a division of the licence amount provisions is also appropriate. It is a worldwide licence, in which only the determination of the amount is left to the respective courts closest to the subject matter - once to the UPC Agreement for the UPC Agreement territory, Japan and the USA, once to the court in Beijing for the rest of the world. In the negotiations between the parties, a distinction was also made by mutual agreement between prices region 1 and 2.

56. According to the defendant, the FRAND counterclaim was brought independently of the infringement action. It is not dependent on the fact that the patent in suit infringed and legally valid. Moreover, the subject matter of the counterclaim goes far beyond the subject matter of the patent infringement action because the counterclaim directed to a global portfolio licence. There is no dispute between the parties that the UPC Agreement has jurisdiction for the FRAND counterclaim; moreover, the plaintiff has not raised an objection under Rule 19 RoP.

The plaintiff wrongly accuses the defendants of unwillingness to license, inadequately analyses the defendants' expert report and does not make the manner of "unpacking" the submitted settlement licence agreements sufficiently transparent. Conversely, the defendant's further expert report, which now analyses the submitted settlement licence agreements, confirms that the plaintiff's offer is outside the FRAND corridor.

57. The conclusions drawn by the defendant's private expert are also supported by the plaintiff's submission of the three comparative licence agreements. The plaintiff wrongly considers the contract with [REDACTED] not to be a suitable comparative figure; this applies rather to the plaintiff's contract with [REDACTED] because the defendants sell considerably higher quantities than [REDACTED]. The unit licence fee of the defendant's private expert is FRAND, as is the flat-rate licence fee presented by him, which, as usual, covers a past period of [REDACTED] years [REDACTED] [REDACTED] assume. The defendant's expert unpacks the [REDACTED]. The plaintiff's settlement licences are appropriate.

58. the licence [REDACTED] unpack the expert correctly [REDACTED] with [REDACTED]

The distribution of the plaintiff [REDACTED] on the other hand, is economically with [REDACTED] cannot be justified. The IDC data would be used to calculate the unit licence rate and constant sales figures would be assumed by way of an ex-ante projection. A [REDACTED] % discount for future payments and a [REDACTED] % discount for lump sum payments would then be applied. An ad valorem rate would then be derived taking into account the weighted sales of [REDACTED] and a reference to the average selling price (ASP) of the defendant's devices would be established.

59. The unpacking of [REDACTED] is carried out according to the same principles whereby no account is taken of the fact th [REDACTED]

[REDACTED]

60. The applicant's unpacking, on the other hand, was not justified. The lump sums of the [REDACTED] and [REDACTED] licences were based on incomprehensible factors. [REDACTED] reduced. The share of the WIFI portion of the [REDACTED] licence and [REDACTED] [REDACTED] and the discount of % [REDACTED] due to the significance of the licence because of its scope is not explained. Without itemised sales figures and sales forecasts, the plaintiff's figures are not comprehensible; they also deviate significantly from the assumptions of the defendant's private expert, without the deviation being explainable so far.

61. However, to the extent that the unpacking by the applicant is comprehensible at all, it suffers from errors. For example, the applicant did not derive a value for 4G-MM devices and 5G-MM devices, although the value of 4G in the devices is different. In addition, the extent to which the different 4G functionalities are implemented in the devices is not taken into account - the defendant's ad valorem approach is preferable here. In addition, the plaintiff inflates the unit licence by not including the value of the past management, which is significant in the respective licence rate, into account. Furthermore, it is incorrect that the [REDACTED] licence holders are granted discounts from which the defendants were not entitled to benefit. In particular, it is not explained that and why the settlement licence agreement partners actually entitled to these discounts such as early bird discount, lump sum or dual licensing or because of the leverage and quantities. It is disproportionate to compensate for transaction costs saved due to the conclusion of two

Licence [REDACTED] a discount of [REDACTED] to accept. [REDACTED]

[REDACTED] The approach of the [REDACTED] early-bird discounts [REDACTED] be [REDACTED] unjustified, the consideration of the fact that [REDACTED] licence holder also does not justify a discount. The risk discount in the amount of [REDACTED] % for the lump sum was also not justified, at least in terms of the amount; moreover, it was not justified [REDACTED] licence fee [REDACTED] licence taken into account in the licence. The

Granting a volume discount to [REDACTED] is in any case contrary to FRAND and, moreover, in the Disproportionate to the contract with [REDACTED] in view of the figures there. A leverage discount of [REDACTED] to [REDACTED] is also not justified.

62. The plaintiff's legal views on the ETSI FRAND declaration are misguided, as this gives rise to an enforceable claim to a FRAND licence and direct performance. The defendants are also favoured as parties willing to obtain a licence.

63. The applicant's applications in its defence to the FRAND counterclaim are inadmissible.

64. The judge-rapporteur has received a letter from the UK High Court, Just. Richard Meade, which has reached the local division and informs about the planned procedures before the High Court (ORD_44583/2024).

65. Finally, the defendants pursued the counterclaim for determination of a FRAND fee, which was filed together with the statement of defence and the action for annulment, with the amended applications referred to above. The amended version of the application was admitted by the judge-rapporteur. They have stated that they will also continue to pursue the originally filed version of the application if the amended applications cannot be granted. These are therefore reproduced as a further group of auxiliary motions.

66. The applicant acknowledges that a licence seeker willing to obtain a licence is in principle entitled to a FRAND licence relating to the 3G and 4G standard. This can be derived from Art. 102 TFEU or from the ETSI declaration. However, the defendants are not willing to grant a licence. Therefore, there was already no need for legal protection for the FRAND counterclaim. It was primarily incumbent on the defendants to take all necessary steps out of court to acquire a licence - recourse to the courts was not permissible beforehand. It follows from the ETSI IPR Policy that there is an obligation to enter into bona fide negotiations on the conclusion of a FRAND licence. This was not the case for the defendants. Also from Art. 102 TFEU

nothing else followed. Their unwillingness to take a licence was already evident from the fact that they had neither provided information nor security.

67. The licence justifying the unlawful acts of use is solely a worldwide portfolio licence and the defendant's argumentation in this regard is inherently contradictory. The UPC Agreement is not only competent with regard to counterclaims for licences that already exist, but also for counterclaims directed at licences yet to be granted. The counterclaim could only be directed to a licence to the respective patent in suit, but insofar as the counterclaim licences to the portfolio for the entire territory of the EPC, the counterclaim was in any case partially inadmissible.
68. The defendants were neither entitled to the determination of a complete licence agreement by the court, nor to a specific FRAND fee, because FRAND is a corridor - therefore the ETSI declaration does not give rise to such a concretely determinable claim to a specific form. In any case, the ETSI declaration is not a binding offer, but only a contractual promise - the contract, however, is a separate legal transaction. The UPC Agreement is also not a third party appointed to determine the licence fees within the meaning of the case law of the ECJ in *Huawei v. ZTE* (para. 68).
69. The applications initially made in the counterclaim were also too vague, unlike the applications made by the plaintiff under III - V in the present counterclaim.
70. In its reply to the FRAND counterclaim, the plaintiff also complains that the defendants did not introduce their submission on their private expert opinions in the documents in the proceedings, but referred to the party expert opinion in an insufficient manner, which was inadequate.
71. The present proceedings for the determination of a FRAND licence are now in conflict with a FRAND determination procedure initiated in Milan, Italy, before the national court by a distribution partner of the defendant exclusively responsible for Italy.

72. The defendant's licence offer of 17 July 2024 is not FRAND for the simple reason it proposes the allocation of the FRAND provision between different courts, which is not FRAND-compliant. The determination of a worldwide FRAND rate is appropriate.

73. The defendant's further offers are not FRAND-compliant because they do not [REDACTED] into account the plaintiff's settlement licence and thus incorrectly determine the FRAND corridor.

74. The defendant's provision of security was not appropriate and was made approximately three years too late, after the plaintiff had already received the counteroffer from the defendant 1. on 27 August 2021 had been rejected. The amount of security offered was also too low and linked to conditions that would be unreasonable in the event of insolvency, because an administrator would neither be able to conclude a licence agreement with certainty nor would a legally binding court-ordered FRAND rate be guaranteed in the event of insolvency.

75. Information is still not provided, the IDC data is insufficient.

76. The defendant's expert opinion was methodologically flawed and the unit licence instead of an ad valorem licence demanded by the plaintiff was FRAND-compliant. In the parallel proceedings in the UK, the defendants themselves had preferred a unit licence. The party expert's allegation that the defendants would have to pay more for less LTE implementation in their devices than the parties to the settlement licence agreement is incorrect - there is also no causal relationship between the LTE UE category and the final price. Therefore, this does not play a price-setting role in free negotiations on the market. Insofar as the party expert refers to the decline in average sales prices for the defendant's 4G phones, it has not been argued that this results in an unreasonable licence burden for the defendant's products. It is also inaccurate that the defendant's party expert estimated sales of the plaintiff's settlement licence agreement partners up to [REDACTED] years before the expiry of the licence.

conclusion of the contract, but the defendants refused to grant licences for

comparable past period. This would unfairly favour the defendants. It is also unfair if the licence fees to be paid by the defendants do not take into account - if one were to follow their party expert - that in the past years, when 5G was not yet available, the payments for the utility value of 4G technology would have been higher. Therefore, by looking back, the defendants were unjustifiably rewarding themselves for having delayed taking the licence. When considering past sales, the duration of the negotiations may also be taken into account in accordance with antitrust law. The defendant's expert's renewed criticism of the plaintiff's unpacking was unfounded.

77. The criticism of the allocation and weighting of the portfolios

[REDACTED] unjustified. It is incorrect to say that the [REDACTED] subsidiary of the plaintiff. Rather, it is a matter of [REDACTED]

[REDACTED]

[REDACTED] In addition, the defendants were guilty of double licensing. [REDACTED] with [REDACTED] which they rejected.

78. The defendant's expert does not derive the licence rates he uses globally, but applies them globally in violation of FRAND. In addition, the defendant's expert takes into account the allegedly lower value of 3G/4G technology in the meantime several times by reflecting this in the average sales price of the phones, in the total load of phones with licences for SEPs and in the number of SEPs to be included in the total licence load.

79. The defendant's settlement licence agreements were already irrelevant and, moreover, they were used incorrectly by the defendant's expert.

With regard to the further details of the facts of the case and the matter in dispute, reference is made to the documents submitted together with the annexes.

REASONS FOR THE DECISION

Responsibility

80. The jurisdiction of the Mannheim local division of the Unified Patent Court for the infringement action and nullity counterclaim arises from Art. 31 UPCA in conjunction with Art. 71b no. 1 Regulation (EU) No. 1215/2015. Art. 71b No. 1 Regulation (EU) 1215/2015, Art. 32(1)(a), (e) UPCA and Art. 33(1)(a) UPCA. The According to the substantiated plaintiffs' submissions, the defendants also committed the acts of infringement on the territory of the Federal Republic of Germany. The defendants withdrew their objection to jurisdiction - albeit under protest - at the oral hearing after the panel pointed out the contradiction between, on the one hand, considering the court to have no jurisdiction in principle and, on the other hand, nevertheless requesting the determination of a FRAND rate by this court, which is considered to have no jurisdiction, in the context of the antitrust dispute between the parties. The Mannheim local division also has jurisdiction for the FRAND counterclaim (see below).

Formalities of the patent in suit

81. The plaintiff bases the claims it is pursuing with the infringement action on the European patent EP 2 568 724 B1 ("patent in suit") relating to a radio communication device and a radio communication method, which was filed on 13 August 2008 and claims the priority of JP 2007211548 of 14 August 2007 and the priority of JP 2008025535 of 5 February 2008. The reference to the grant of the patent in suit was published on 17 December 2014

published. The patent in suit is in force in the Federal Republic of Germany, the French Republic, the Italian Republic, the Kingdom of the Netherlands and the Kingdom of Sweden, among others.

Technical context of the patent in suit and problem definition

82. The patent in suit deals with a solution to a technical problem in the context of the LTE standard. The parties agree in describing the specific problem in that the patent in suit deals with the uplink signal traffic from a radio communication device to the network in a radio cell. In particular, the application case is examined in which such a device is not located in the core of the radio cell, but in its peripheral area. The patent in suit describes it as known that the energy available for the transmission of signalling decreases and transmission losses occur if the communication device is located at the edge of the cell. The problems described also arise in particular with regard to reference signals, which serve to estimate the channel quality in the uplink on the network side (also known as SRS (Sounding Reference Signals) signals). In addition, the reference signals are used to estimate the time offset between the base station and the mobile station. It is known to the relevant skilled person that the reference signals must have a certain minimum size in order to be useful for assessing the time offset and must therefore not be just 1 RB (resource block) in size. This is addressed by the patent in suit in section [0005], where it refers to a certain minimum size of the reference signal. In the following, the patent-in-suit concentrates on the estimation of the channel quality in the uplink, which is to be determined on the basis of the SRS signals. From this dependence of the channel quality and transmission and energy losses on the location of the user equipment (UE), it is already clear to the skilled person that the signalling referred to is not to be considered generally in the abstract, but with regard to the specific UE. Accordingly, the patent in suit describes that a UE which is located in the core of the radio cell has sufficient energy to transmit an SRS signal which is designed as a wideband signal (section [0004]). If this energy is not sufficiently available

narrowband SRS signals are used for channel estimation. From this context, the specialist understands that the corresponding coordination and orders are carried out on the network side and not by the UE itself, because only the network is able to make the necessary decisions regarding the optimal configuration and the resulting signalling in the respective concrete application situation on the basis of the signals transmitted by the UE in the uplink.

83. The patent in suit further describes that in the LTE standard a PUCCH (Physical Uplink Control Channel) located at both ends of the system band by means of frequency multiplexing. The SRS signals would therefore be sent in the system bandwidth minus the PUCCH (section [0006]). The width of the control channels is variable depending on the amount of control data that has to be handled. Therefore, the SRS transmission bandwidth also varies with the variance of the control channels. Here, the patent in suit defines in section [0007] that it refers to the frequency resources used by a single SRS signal as SRS bandwidth and the majority of transmitted SRS signals as SRS transmit bandwidth.

84. The patent in suit sets itself the technical task of offering a solution to the problem that the SRS transmission bandwidth varies with the change in the bandwidth of the PUCCH channels. However, the changing bandwidth, in which the user data is transmitted together with the SRS signals in the PUSCH (Physical Uplink Shared Channel) channel, should also be the best possible estimation of the channel quality by means of narrowband SRS signals. In the state of the art, the problem here is that the SRS signals can overlap with the PUCCH channels as the bandwidth changes, which leads to signal losses. The skilled person is aware that signal losses in the control of the connection in particular must be prevented. For this reason, the PUCCH channels in LTE are also ordered at the two ends of the system bandwidth and not in the middle, where collisions are more likely. In order to avoid interference between the SRS signals and the PUCCH channels, the patent in suit describes as known solutions either the transmission of SRS signals or the transmission of PUCCH channels.

signals from the outset only to the band range that remains when the PUCCHs occupy the maximum bandwidth defined on the network side (see section [0009] and Figure 2). However, this solution has the disadvantage that larger areas of the band in which the SRS signals and user data can be transmitted are not covered by the SRS signals if the PUCCHs do not have the maximum size, but only have a lower utilisation. This would reduce the quality of the estimation of the transmission quality. Conversely, if the minimum size of the PUCCH is assumed, interference with the SRS signals occurs (Figure 3A and B).

85. Another known solution was to stop the transmission of the SRS signal if the SRS overlapped with the PUCCH. However, this would again result in an area that was not covered by an SRS signal. This again reduces the quality of the estimation of the channel quality (see section [0011] and Figures 4A and 4B). Both approaches therefore mean that a larger area of the bandwidth that should be covered for the best possible channel quality estimation under the given boundary conditions, under which only narrowband SRS can be transmitted by means of frequency hopping, is not covered and the quality of the estimation deteriorates as a result.

86. To solve this problem, the patent in suit proposes a radio communication device according to claim 1 and a radio communication method according to claim 13. The features of claim 1 can be summarised as follows:

1.	Radio communication device (200)
1.1	The radio communication device which can be configured to transmit a reference signal with a transmission bandwidth in a given system bandwidth, wherein control channels are assigned to both ends of the same [system bandwidth] and the transmission bandwidth is between the control channels, or to transmit reference signals with a transmission bandwidth in a given system bandwidth. low bandwidth with frequency hopping transmits

1.2	The radio communication device comprises a assignment unit (202) configured to assign the reference signals to frequency resources
1.3	The radio communication device comprises a transmitter unit (204) configured to transmit the associated reference signals 1.3.1 The transmission bandwidth varies in the given system bandwidth
	1.3.2 The allocation unit allocates the reference signals so that the reference signals are allocated to frequency resources, each of which has the low bandwidth that is independent of changes in the frequency resources. the transmission bandwidth is invariable
	1.3.3 The frequency resources are set according to the change in the Transmit bandwidth evenly distributed in a frequency band of the transmit bandwidth

Interpretation of the patent claim

Some features require further explanation: Feature 1.1

87. Feature 1.1 expresses that the radio communication device can be configured according to the specifications of the claim (in the relevant language of the proceedings of the patent in suit: "configurable to"). Based on the relationships described above, the skilled person recognises that it is thus sufficient if the device can be set up accordingly by network-side specifications. However, it is not necessary for the device to always be configured accordingly. Due to the fact that the solution is based in the context of devices moving in the radio cell and thus subject to different framework conditions, the person skilled in the art recognises that certain determinations of the communication are specified on the network side.

be determined. For example, the specialist is aware that the bandwidth required for the control channels is determined on the network side based on the need to send control information, which is determined on the network side. Accordingly, the variance of the bandwidth of the PUCCHs is determined on the network side. According to feature 1.1, the device must be able to operate in accordance with the framework conditions determined on the network side and to implement the other elements of the invention.

88. In the context of the patent in suit, the skilled person understands the term "transmission bandwidth", contrary to the applicant's view, as that bandwidth within a given system bandwidth which is located between the control channels and which is therefore available for transmitting reference signals and user data. The broadband SRS signal referred to in the claim extends over this transmission bandwidth, which is therefore defined by the system bandwidth minus the bandwidth required for the PUCCH. In the event that no sufficient energy is available and therefore no broadband SRS can be transmitted, the narrowband SRS are distributed over this range by means of frequency hopping. Contrary to what the applicant believes, the transmission bandwidth is not defined by the beginning of the first SRS signal transmitted in the bandwidth to the end of the last SRS signal transmitted in the bandwidth, i.e. the area actually covered by the SRS signals. The skilled person will find no support for such an interpretation in the literature. Rather, section [0006] already describes:

"Accordingly, an SRS is transmitted in the band subtracting the PUCCHs from the system bandwidth."

The skilled person finds this understanding confirmed when reading the description, which is to be used to interpret the claim (UPC_CoA_1/2024, para. 35). On the other hand, there is no support for the interpretation put forward by the applicant. At no point is it described that the transmission bandwidth extends - for whatever reason - only from the beginning of the frequency of the first narrowband SRS signal to the end of the frequency of the last narrowband SRS signal

and thus between the PUCCHs at both ends and the beginning and end of the transmission bandwidth there would be a frequency range that is not to be understood as a transmission bandwidth. Although it may be conceivable to the skilled person that other signalling such as a RACH (Random Access Channel) could also be localised in the frequency, such options are not considered for the solution developed by the patent in suit. Rather, all embodiments are based on the fact that the SRS transmission bandwidth is obtained by subtracting the PUCCH transmission bandwidth from the system bandwidth (cf. section [0027] with regard to embodiment 1, to which all further embodiments refer back ("on the SRS transmission bandwidth obtained by subtracting the PUCCH transmission bandwidth from the system bandwidth"), for example [0034]: "different from ... Embodiment 1 only in SRS allocation determination section in the base station"; corresponding to [0045], [0054], [0058], [0061], [0066]). There is therefore a direct correlation between the variance of the control channels and the size of the transmission bandwidth. Nothing else follows from section [0072], which also emphasises that the transmission bandwidth is defined as a function of the variance of the PUCCHs, even if this may be a specific assigned frequency band. The distribution of the SRS signals by the allocation unit in accordance with features 1.3.2 and 1.3.3 also takes place in the initially determined available transmission bandwidth between the control channels. This variance of the transmission bandwidth is then also addressed in feature 1.3.1.

Feature 1.3.2

89. According to the wording of feature 1.3.2, the narrow bandwidth reference signals are invariable regardless of the changes in the transmission bandwidth. The person skilled in the art understands the invariability of the SRS signals in this respect as a central aspect of the proposed solution. This is because he recognises it precisely in the fact that a variance in the width of the control channels and the transmission bandwidth determined exclusively by this is countered precisely with a distribution of SRS signals which are invariable in themselves. For their part, they are not variable in terms of the bandwidth that they each have (for each individual SRS signal).

in the frequency range. The SRS signals are addressed in section [0068]:

"In this way, according to the present embodiment, in accordance with an increase and decrease of the number of PUCCH channels, SRS allocation is changed such that a CQI estimation bandwidth is covered with fixing SRS bandwidths evenly."

Insofar as the applicant refers to section [0073], which declares a variance of ± 1 to 2 resource blocks, which does not interfere with the quality estimation, to be tolerable, after the embodiments were previously described only with invariable SRS signals, no relativisation of the invariability criterion can be derived from this in view of the unambiguous wording of the claim, which specifies the narrow bandwidth as invariable without restriction. The size of the narrowband SRS signals is only limited downwards in the document by the fact that it must be at least $1/\Delta t$ in order to be able to estimate the time offset (cf. Section [0005]). In the document referenced in section [0008] (Annex VB-T D3), it is described after the 3rd indent in the last paragraph of section 3 that the minimum bandwidth is 1.25 MHz in order to be able to estimate the time offset in the uplink. This corresponds to 6 RBs, as the specialist in question is aware. The skilled person therefore does not read a variance of up to 2 RBs the narrow bandwidth of the SRS signal, because this could otherwise result in the narrowband SRS no longer being able to fulfil the function of being able to estimate the time offset at the same time. The example shown in Figure 13B, in which the SRS signals partially overlap but are not adjusted in size despite the overlap not being necessary for quality estimation, also speaks against a variance within a certain tolerance. Therefore, the wording and functional context within the claim argue against recognising a certain variability of the narrowband SRS signals as being in accordance with the claim.

Feature 1.3.3

90. According to feature 1.3.3, the narrowband SRS signals, which are invariable according to feature 1.3.2, should be distributed evenly in a frequency band of the transmission bandwidth (cf. e.g. [0032]: Then, as shown in Fig. 8, the positions where SRSs are frequency-multiplexed in the SRS transmission bandwidth are positions to cover the SRS transmission band evenly, that is, the frequency band subject to CQI estimation." And [0068]: "a CQI estimation bandwidth is covered with fixing SRS bandwidths evenly"). In the description and the figures, the document makes it clear to the skilled person that technically and functionally no complete coverage of the transmission bandwidth by SRS signals is required. Rather, the person skilled in the art understands that smaller gaps in the coverage between the SRS signals or between the first or last SRS and the PUCCH are acceptable for estimating the channel quality. On the other hand, there should be no major gaps in coverage, which are currently criticised in the state of the art. The distribution should therefore result in several small frequency ranges not covered by SRS signals remaining within the transmission bandwidth (see also Figures 8, 10, 11, 13, 14).

91. The above allocations apply in the same way to the interpretation of method claim 13.

Legal validity of the patent in suit

92. Against the background of this understanding of the claim, the patent in suit proves to be legally valid, which is why the action for revocation had to be dismissed.

93. As a result, it can be left open whether the document VB-T-15 cited by the defendants for the first time in their Reply to the nullity counterclaim could be taken into account. The document is cited from the parallel proceedings UPC_CFI_219/2023 conducted against Xiaomi concerning the same patent in suit against the body of law. However, the case nevertheless gives reason to the view of the panel that, in principle, the invalidity counterclaimant is required to submit its attacks already with

of the action for annulment (Rule 25.1(b), (c), (d), (g) RoP). At most, the patent proprietor can raise new attacks in individual cases if he a substantiated submission as to why it was not possible for him to raise the corresponding attack in the revocation counterclaim. This is because the patent proprietor must be given the opportunity to react to new prior art, possibly by making the necessary amendments to the patent claims. However, according to Rule 30.2 RoP, such applications may only be admitted with the express permission of the court. Accordingly, Rule 32.2 RoP only provides that the invalidity opponent may respond to a request for amendment by the patent proprietor with the arguments contained in Rule 44(d) to (h) RoP and may argue as an alternative to non-infringement. On the other hand, there is no provision in principle for the opponent to introduce newly searched prior art into the proceedings which it has not yet searched without being prompted to do so by the patentee's request for amendment. Rather, this prior art is regularly no longer to be taken into account under Rule 9.2 RoP.

94. In the present case, it may also have to be taken into account that the prior art searched by the defendants here was known to the plaintiff from the invalidity attack of the defendants in the parallel proceedings and that they had sufficient opportunity to deal with the prior art there within the time limit regime, especially since fundamental deviations in the assessments of the same prior art by the invalidity plaintiffs here were not demonstrated or otherwise apparent. In any case, the question can remain unanswered in the present case, since the document is not novelty-destroying within the meaning of Art. 54 EPC and cannot give rise to invalidity under Art. 138(1)(a) EPC.

No unauthorised extension

95. Against the background of this interpretation, the patent in suit is not inadmissible within the meaning of Art. 138(1)(c), 76(1), 65(2) EPC.

96. The defendants argue their invalidity attack on the premise that the plaintiff's interpretation of the patent claim is followed with regard to the transmission bandwidth according to the patent in suit. However, as described above, the PANEL does not follow this interpretation.

97. Insofar as the defendants justify their attack by arguing that the teaching according to the patent in suit is inadmissibly extended due to the omission of the "generation section" and the "unit of transmission" disclosed in the parent application, the PANEL does not follow this view. As the applicant has correctly pointed out, it is clear in the parent application in sections [0101 et seq.] and [0102 et seq.] that it is not necessary to fill in the addressed functionality of a "generation section" in a specific physical manner. The fact that a reference signal is to be provided for the purposes of the teaching is sufficiently expressed in the claim. The same to the "unit of transmission" missing from the claim by the defendants. The parent application and the patent in suit show in sections [0097] and [0098] respectively that this functionality does not have to be realised in a specific unit.

No cancellation of the priorities used

98. The defendants justify the elimination of the claimed priorities of the patent in suit in the same way as the attack of inadmissible extension. For the same reasons, the argumentation does not hold water. The priorities are validly claimed.

Novelty compared to VB-T D15 (EP 2 129 022 A1)

99. The citation was published on 2 December 2009 and claims priorities of 15 February 2007 and 23 March 2007, thus constituting an earlier right which can be used for the examination of novelty under Art. 54(3) EPC. Doubts about the legitimate claim to priority of JP 2007077900 are

and is also not evident - the document contains the same disclosure content.

100. The technical background of the document concerns the resolution of the conflict between the channels PUCCH, PRACH and the SRS signal in an SC-FDMA scheme in the uplink, i.e. by a strict frequency division multiplex procedure of PUCCH and PUSCH, whereby - in extension of the task according to the patent in suit - the conflict between PRACH and SRS signal is additionally resolved in the PUSCH data channel (section [0012]).

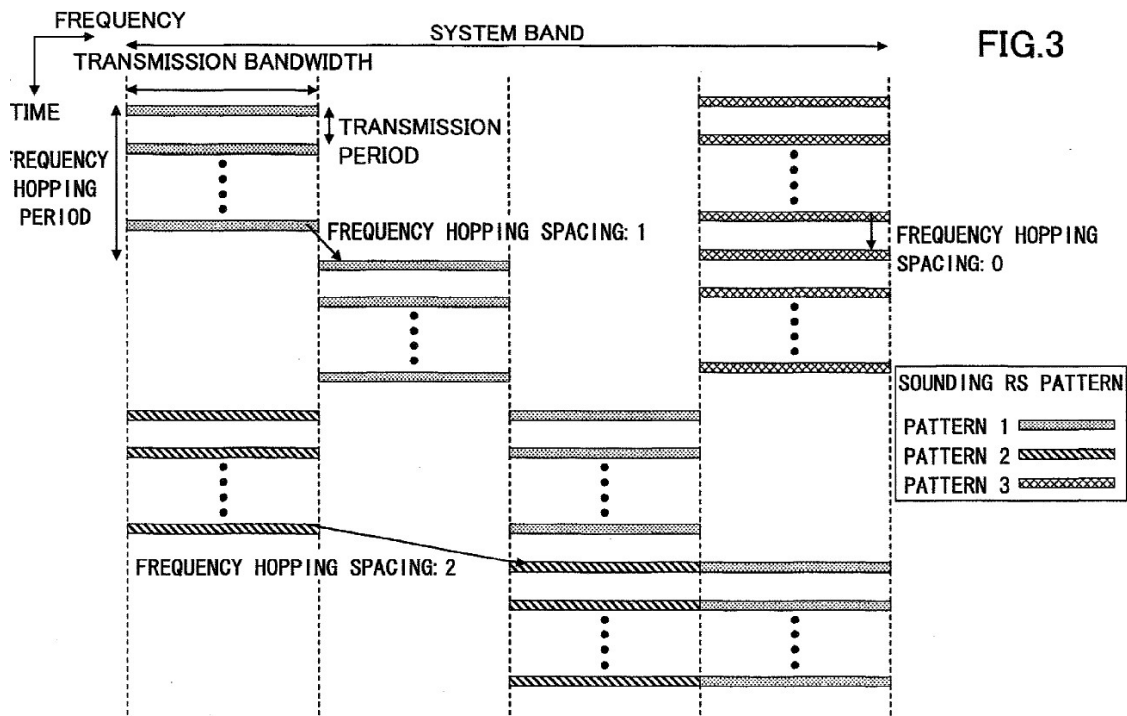
101. In contrast to the patent in suit, which resolves the conflict between SRS and PUCCH exclusively by frequency division multiplexing, i.e. by strictly separate frequency ranges, and does not relate to the time domain, the control channel PUCCH in the citation is of two types. On the one hand as a channel that is separate from the data channel PUSCH in the time-division multiplex, and on the other hand as the control channel PUCCH, which is separate from the data channel PUSCH in the frequency-division multiplex (section [0007]).

102. Thus, in this respect, there is an extension compared to the problem according to the patent in suit, since according to the teaching of the citation, the conflicts are to be solved completely both in the frequency domain (Figures 4 to 6) and in the time domain (Figures 7 and 8). However, a solution focussing solely on the frequency domain is also presented to the skilled person in the art (see section [0025]).

103. A mobile radio system comprising a base station and mobile stations in a radio cell supplied by the base station is shown in Figure 1.

104. Figure 2 shows a subframe which locates the SRS signal in the first long block of the subframe (section [0038]).

105. Figure 3 shows in principle the transmission of SRS reference signals in frequency hopping over the system bandwidth.

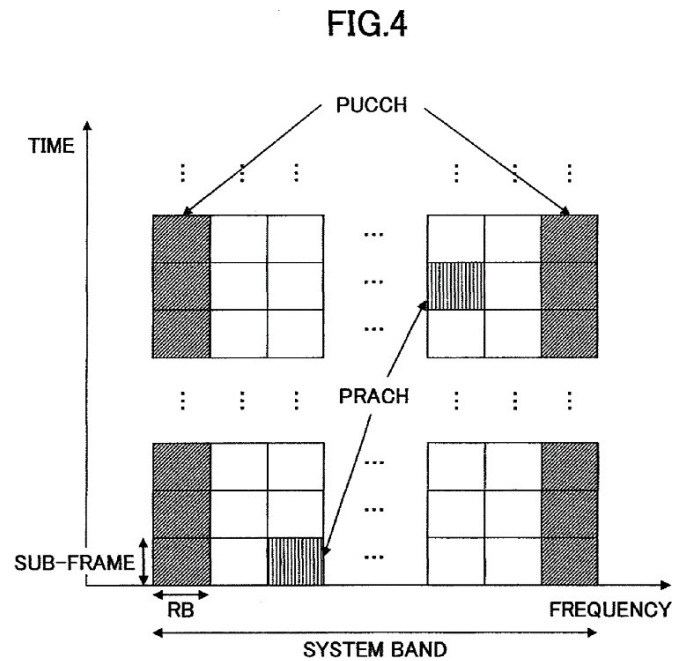


106. However, this figure does not show where control channels are located and whether they are variable or not. Against the background of the underlying problem and the further explanation of the conflict resolution between the SRS signal and the channels in the frequency domain addressed by the text (Figures 4, 5, 6 and 11), it is clear to the skilled person that PUCCH and PUSCH are strictly separated in the frequency domain and that Figure 3 is a simplified representation to illustrate the transmission of the SRS reference signals in the frequency domain.

107. Also, the alternative transmission of a single broadband reference signal in the transmission bandwidth is directly and unambiguously shown by the citation (section [0046]: "It should be noted that the transmission band for the Sounding RS may be divided into one or more transmission bands").

108. The fact that the control channels can be located at both ends of the transmission bandwidth can be seen from Figure 4, which shows a mapping of the resources in the uplink in the time and frequency domain for PUCCH and PRACH (section [0042]). In this case

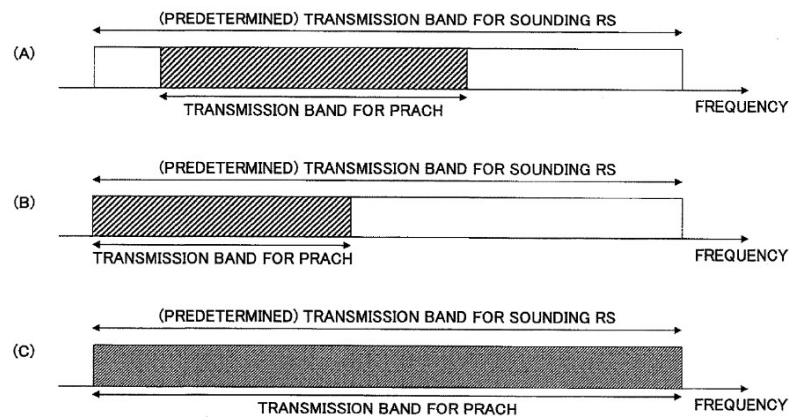
the parties decide whether figures 3 to 5 are read in context by the specialist.



109. What is missing in Fig. 4 is the representation of an SRS reference signal located between the control channels and its possible distribution.

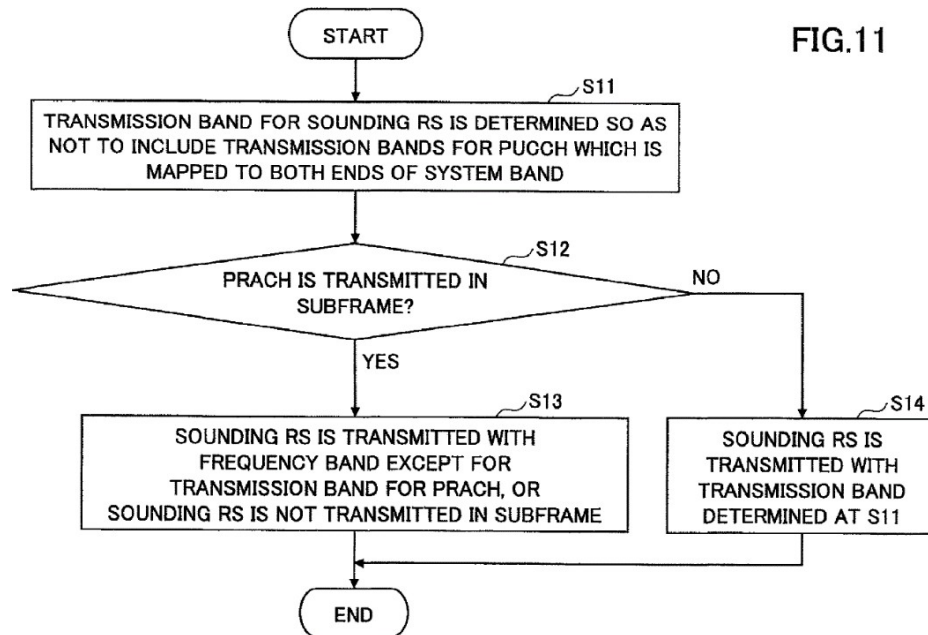
110. However, this does not mean that no SRS reference signals are assigned there. This is the skilled person recognises that PRACH and SRS reference signals can conflict with each other in the same frequency range at certain times, whereby this conflict, which only occurs temporarily, is resolved by the measures shown in Figure 6:

FIG.6



111. Furthermore, the missing information in Figure 4 is also conveyed in the text by the fact that the allocation of the time and frequency resources for the SRS reference signals results from the mapping of PUCCH and PRACH, which is transmitted by broadcast from the base station to each mobile station in the radio cell (section [0045]), and this information is also taken into account when mapping the individual SRS resources of the individual mobile station, which is communicated by means of an RRC message (last sentence [0040] and Figure 11).

112. Step S11 shown in Figure 11 refers to a transmission bandwidth if there is no time conflict in the frequency range between SRS and PRACH. In this case, the SRS is transmitted in this transmission bandwidth (Figure 11 - step S14).

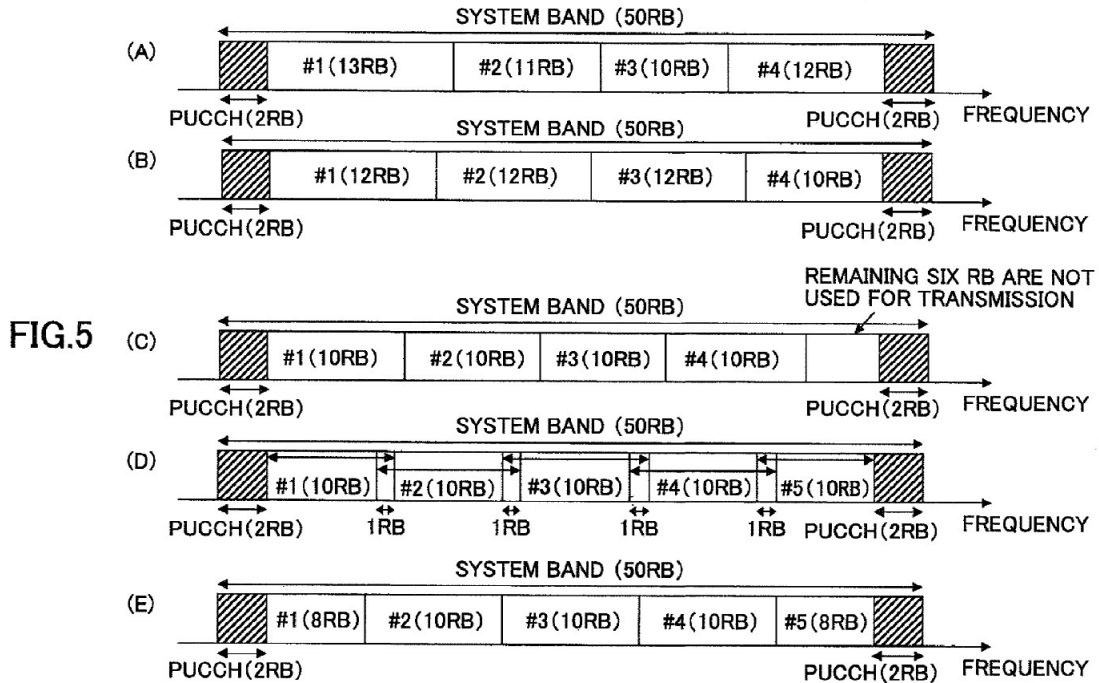


113. If a conflict occurs at certain times (Figure 11 - step S12), this must be resolved in a further step (Figure 11 - step S13) with regard to the options shown in Figure 6.

114. If, therefore, following the argumentation of the plaintiff for revocation, it is taken from the document that in Figure 3 only a simplified representation of the basic principle of the transmission of the SRS reference signals in the frequency hopping is shown and the control channels are assigned to both sides of the system band and there neither SRS reference signals (Figure 11 - step S11) are assigned nor transmitted (Figure 11 - step S14), this nevertheless does not lead to a complete disclosure of the teaching of the patent in suit.

115. Indeed, if Figure 5 is read in this context with Figures 3 and 4, again following the defendant's argumentation (cf. section [0026] - description of the figures: "transmission band for a Sounding RS when a PUCCH is mapped to both ends of the system band"), it shows the distribution of the low bandwidth reference signals in a claim-appropriate variable bandwidth.

transmission bandwidth, but at least not that the reference signals are invariable in size:



116. This is because Figures 5A and 5B initially only disclose a distribution with reference signals of low bandwidth, which, however, is not invariable but varies and is therefore not in accordance with the claim. Within Figure 5A, the bandwidth of the individual SRS signal varies between 10 and 13 RB and thus even outside the tolerance of ± 1 to 2 RB mentioned in the application, which, however, as explained above, does not in any case lead to claim still recognising an invariable SRS signal. In any case, Figures 5A and B are in turn related to Figures 5C, 5D and 5E. The person skilled in the art is thus shown various possible configurations without recognising at this point that a reference signal of invariable width is specified. Rather, the signals in the various embodiments of Figures 5 vary arbitrarily in their width and are merely ordered in such a way that they cover the transmission bandwidth between the PUCCH. However, the skilled person is not immediately and clearly shown as belonging to the invention that the reference signals are invariable. In addition, the PUCCH in Figure 5

are each 2 RB wide and do not vary. The context according to the patent in suit for solving the problem of distributing invariable SRS signals in the variable transmission bandwidth defined by varying PUCCH is thus not shown as an element of the invention of the citation.

117. The other figures 5C, 5D and 5E do not change this either. It is true that Figure 5C and Figure 5D show a distribution with a reference signal of invariable low bandwidth of 10 RB, whereby Figure 5D with overlapping reference signals of invariable 10 RB shows a uniform distribution within the meaning of feature 1.3.3, as also presented in Figure 13B of the patent in suit as being in accordance with the claim. However, the frequency bandwidths occupied by the control channels do not vary here either, but are each 2 RB wide, although the skilled person may read their variability into the figure from section [0042] and section [0045], last sentence, and section [0040] and Figure 11. However, in accordance with the approach of the invalidity applicants, these figures are also to be considered in their context and are therefore on an equal footing with Figures 5A, 5B and 5E, which do not show invariable but varying reference signals. The five different distributions presented in the transmission bandwidth therefore arbitrary for the person skilled in the art. The fact that the reference signals within the meaning of feature 1.3.3 of the patent in suit are invariable in any case despite the variance of the PUCCHs is not disclosed to him directly and unambiguously as belonging to the invention for solving the conflict between PUCCH and SRS signals mentioned in the citation. This solution of the patent in suit is also not directly and clearly conveyed to him in the description passages explaining Figures 5 (sections [0047 ff.]). Rather, the alternatives are juxtaposed as arbitrarily interchangeable without favouring a particular embodiment variant. It is therefore crucial that the invariability of the SRS signal is not shown here, not even in an embodiment variant of Figure 5. Rather, the skilled person reads Figures 5 as well as Figures 3 to 5 in context. In this case, however, the result for the person skilled in the art is not the invariability of the bandwidth of the SRS signal, but only an SRS signal that varies depending on the transmission bandwidth to be covered and not an SRS signal that can be used in spite of the bandwidth.

varying transmission bandwidth unchanging SRS signal. Feature 1.3.3 is thus not disclosed as prejudicial to novelty.

New feature compared to the VB-T D1

118. The teaching of the patent-in-suit is also new compared to citation D1.

119. In the LTE standard, it was known at the priority date of the patent in suit to order the uplink control channels PUCCH (Physical Uplink Control Channel) at both ends of the system bandwidth (uplink bandwidth), with the data channel PUSCH (Physical Uplink Control Channel) shared for the transmission of uplink data being located in the frequency range in between. This understanding is demonstrated by Figure 18 in section 6.4.3 of VB-T D9, whereby section 6.5.2.2 of VB-T D9 states that the "sounding reference signal" is assigned to a long SC-FDMA symbol. VB-T D5 also states in section 1.1, 2nd indent, that the PUCCH bandwidth is variable.

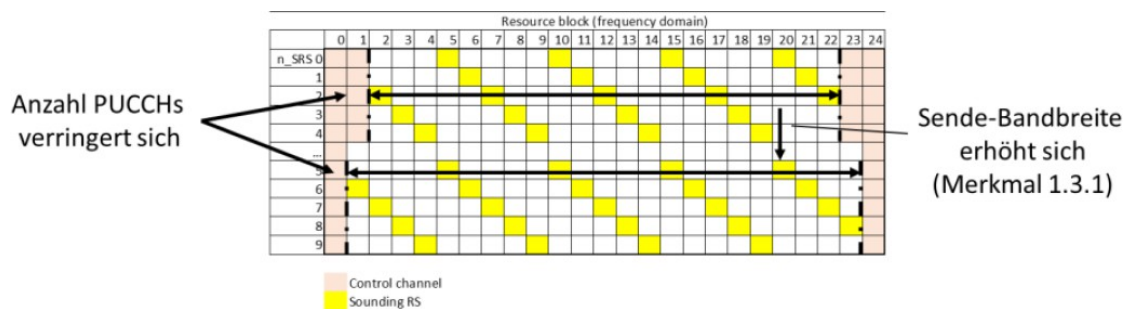
120. According to citation D1, in order to estimate the channel quality of the PUSCH, it was also known that the reference signals required to estimate the channel quality are located in the frequency band of the PUSCH (Chapter 7 - Frequency multiplexing of data and sounding signals).

121. Furthermore, citation D1 distinguishes between broadband reference signals (non-hopped fixed sounding RS with broadband sounding BW1) and narrowband reference signals in frequency hopping (frequency hopped narrowband sounding RS with narrowband sounding BW2), whereby the variability of the bandwidth of the control channels is taken into account in the allocation of the bandwidth for the reference signals (sounding BW) (section 8 - "May be specified in #RB, but will have to take into account the variable control channel overheads within a slot (i.e., top/bottom sounding may be smaller than nominal)).

122. But this consideration inevitably leads to the fact that the narrowband reference signals are not invariable, but depend on the change of the control channels and thus the transmission bandwidth. (Section 8 - "May be specified in #RB, but will have to take into account the variable control channel overheads within a slot (i.e., top/bottom sounding may be smaller than nominal)").

123. Thus, at least feature 1.3.2 is not directly and unambiguously disclosed in D1 with respect to the requirement for an invariable bandwidth of the narrowband reference signals.

124. Even if one were to follow the defendant's submission in relation to citation D1, in its example the narrowband reference signals are shown in the frequency hopping with an invariable bandwidth of 1 RB:



125. However, the selection of a bandwidth of 1 RB for a narrowband reference signal is arbitrary and, above all, contradicts the values that result for the Narrowband Sounding BW2 according to the results of the evaluation in Appendix B and the recommendation according to the table in Section 8, which recommends a bandwidth of 1.25 MHz (6 RBs) for the narrowband reference signal with a system bandwidth of 5 MHz.

126. Moreover, it remained uncontested at the oral hearing that it is clear to the skilled person from paragraph [0005] of the patent in suit that in order to fulfil the requirement for estimating the timing offset between the base station and the mobile station, the reference signals must have a certain minimum bandwidth, which is invariable in the case of narrowband SRS transmission. A

narrowband reference signal comprising only 1 RB does not - as the skilled person is aware - cover the minimum bandwidth in order to be regarded as a narrowband SRS within the meaning of the patent in suit. This is also confirmed by VB-T D3, which is cited in the patent in suit in paragraph [0008] as prior art and states in the 3rd indent in the last paragraph of section 3: "The minimum sounding bandwidth of 1.25MHz would be sufficient for the uplink timing estimation". This corresponds to a width of 6 RB.

Novelty also with a view to the VB-T D1a citation

127. A different result does not emerge even if the VB-T D1a listed in VB-T D1 is taken into consideration.

128. Citation D1a is cited as document [2] in citation D1 and is referred to by the defendants to show where the 1 RB reference signals are to be ordered in a system band with a bandwidth of 5 MHz, i.e. 25 RB (page 4, lines 3 to 6 and 12 to 16), in order to show, in conjunction with D1, the previously described ordering of narrowband reference signals of a bandwidth of 1 RB in frequency hopping.

129. According to the text passage cited in D1a, i.e. "Structure A", Figure 2 shows, however, that the narrowband 1 RB reference signal (narrowband SRS) transmitted there in the BPICH (broadband pilot channel) in frequency hopping is transmitted over the entire system band of 5 MHz and also encompasses the frequency range of the control channels PUCCH.

130. Figure 1 shows the assignment of the BPICH, which occupies the entire system band of 5 MHz and does not exclude the frequency range of the PUCCH control channels.

131. To summarise, when the reference signals are transmitted in the BPICH in accordance with D1a, the entire system band is always covered and the control channels are not excluded.

132. It can be seen directly and clearly from D1a that when a reference signal is sent on the BPICH, the conflict with the control channel is resolved in terms of time, whereby this time block is then not available to the control channel.

133. Thus, based on D1, the text passage quoted in section 7, "it may be desirable to exclude the edge-RBs used for UL control signalling from the sounding blocks, thus resulting in FDMA between sounding signals and control data signals", which specifically refers to an FDMA, does not provide any additional information by reference to D1a that is not already directly and unambiguously apparent from D1.

134. In particular, feature 1.3.2 is still not fulfilled with regard to the requirement of an invariable bandwidth of the narrowband reference signals transmitted in the frequency hopping and is not directly and unambiguously disclosed.

Novelty compared to the VB-T D3 citation

135. D3 is cited as prior art in paragraph [0008] of the patent in suit and was therefore taken into account in the grant procedure.

136. Section 2 of D3 first discusses two previously known approaches for transmitting reference signals (abbreviated as CS RS= uplink channel sounding reference signal) together with uplink control channels (PUCCH) in a system bandwidth.

137. In a first approach, which describes a time division multiplexing method (TDM), the reference signals occupy the entire uplink bandwidth (system bandwidth). In this approach, the control channel cannot be transmitted during the transmission of a reference signal. This means that during the transmission of the reference signals no information can be transmitted to the control channel.

control channels are transmitted. This first approach is shown in Figure 1 of D3. It can be seen that the reference signal utilises the entire system bandwidth.

138. In a second approach (FDM), known as frequency division multiplexing (FDM), the reference signals are only transmitted within frequency bands that are not occupied by a control channel (PUCCH). In this approach, the reference signals only jump within a frequency band that is not occupied by the control channels. This second approach is referred to in D3 by citing citation D3a (see D3a below).

139. According to Table 1 disclosed in D3 in Section 3, for system bandwidths up to 5 MHz the specified bandwidth values of the transmit bandwidth (Wide sounding BW) always amount to the entire system bandwidth. Thus, for system bandwidths up to 5 MHz, no resources remain in the specified system bandwidth for assigning the control channels (feature 1.1) and, in the absence of varying control channels, there is also no change in the transmit bandwidth for a fixed system bandwidth (feature 1.3.1) and, as a direct consequence, no disclosure of features 1.3.2 and 1.3.3.

140. The fact that at system bandwidths above 5 MHz the remaining portion of the system bandwidth not used by the transmission bandwidth remains and could in principle be available does not imply otherwise, since D3 does not comment on this and there is no specific disclosure in this regard.

Cancellation VB-T D3a

141. Citation D3a is cited as document [3] in citation D3 and is referred to by the defendants to show that the reference signals do not use any of the blocks ("LB"=Long Block) of the control channels (PUCCH) and the conflict between control channels and reference signals by means of

Frequency-division multiplexing (FDM) can be used to solve this problem.

142. In fact, section 6 of Figure 1 shows a system bandwidth at each end of which a single control channel is allocated. In the intermediate area of the transmission bandwidth, reference signals with a narrow bandwidth (narrowband SRS) are transmitted in frequency hopping:

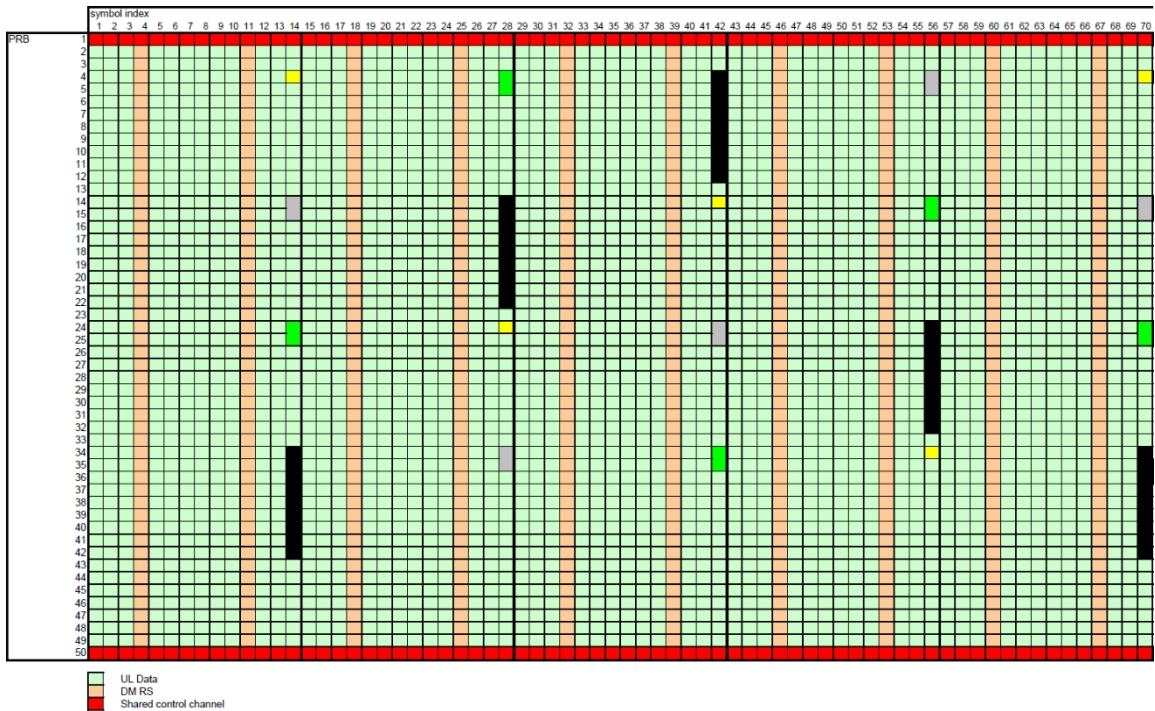


Figure 1. An example of bandwidth allocation for UL data, DM RS and sounding RS.

143. By using FDM, there are no conflicts between the control channels and the reference signals addressed by the patent in suit, since there is a strict separation of control channels and reference signals available frequency resources.

144. However, varying control channels are also not to be taken from D3a and consequently the disclosure of features 1.3.1 and 1.3.3 is still missing.

No lack of novelty of VB-T D2 and inventive step

145. According to the defendant's own argumentation (KE para. 224), the citation VB-T D2 is only prejudicial to novelty if - as is not the case - the plaintiff's interpretation of the term "transmission bandwidth" were to be followed. Consequently, the argument of a lack of inventive step based on the specification cannot be accepted either.

VB-T D4a and 4b citations

146. Both citations VB-T D4a and 4b were published after 14 August 2007 as the relevant priority date and are therefore not prior art.

Other citations cited as evidence of the prior art VB- T D5 to D12

147. The other documents D5 to D12 cited by the defendants as prior art serve only as evidence of a technical understanding already confirmed in the above statements or serve to oppose patentability in the form of the subclaims and therefore do not require further assessment.

Feasibility of the invention and lack of inventive step

148. Contrary to the defendant's view, the invention is also disclosed in sufficient detail for the person skilled in the art (Art. 138(1)(b) EPC, 65(2) EPC). However, the defendant's argumentation, according to its own explanations, only holds up if one were to follow the plaintiff's incorrect understanding of the transmission bandwidth. This would leave unsampled gaps, so that it would remain unclear how a good estimate of the channel quality could be achieved. In this respect, reference is made to the previous statements with regard to the correct understanding of the claim.

149. The patent in suit is also based on inventive step. In their Reply to the revocation counterclaim, the defendants again argue this attack against the patent-in-suit only on the basis of the plaintiff's incorrect interpretation of the claim (see above).

Infringement of the patent in suit

150. The attacked embodiments, in particular the 4G-capable smartphones such as the OPPO Find X5 Pro and the 4G-capable smartwatches of the defendants, operate according to the 4G standard and thereby infringe the patent in suit in its main claims 1 directly according to the wording within the meaning of Art 25(a) UPCA and the method claim 13 indirectly within the meaning of Art. 26 UPCA by offering, on the market, using or importing for these purposes and possessing the attacked embodiments in the territory of the Federal Republic of Germany, the French Republic, the Italian Republic, the Kingdom of the Netherlands and the Kingdom of Sweden without the plaintiff's consent. The accused embodiments are means relating to an essential element of the invention and the defendants should at least have known that they are intended and suitable to be used for the use of the invention in the presently invoked Contracting States in which the respective bundle patent part of the patent-in-suit is in force.

151. The relevant components of the 4G standard are mandatory. The following components are relevant in this context:

- ETSI TS 136 213 V8.8.0 (2009-10), LTE; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical Layer Procedures (hereinafter: TS 136 213), Annex KAP A 16;

- ETSI TS 136 211 V8.9.0 (2010-01), LTE; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical channels and modulation (hereinafter: TS 136 211), Annex KAP A 17;

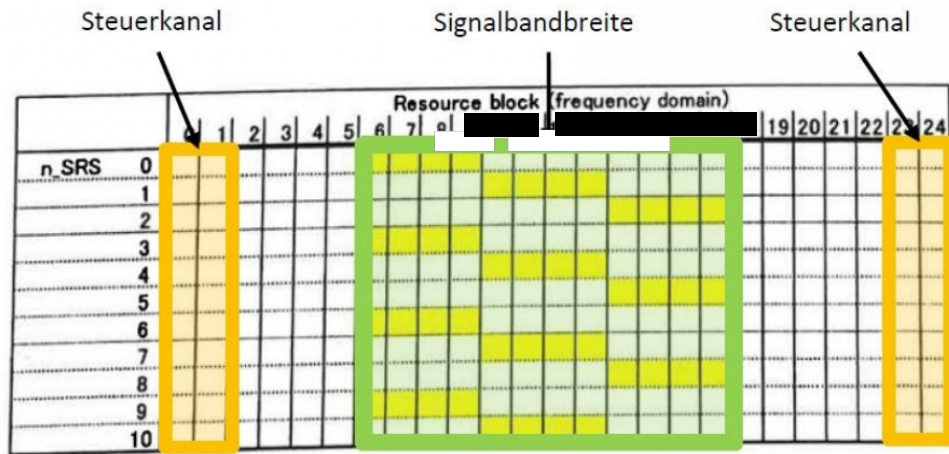
- ETSI TS 136 331 V8.12.0 (2011-01), LTE; Evolved Universal Terrestrial Radio Access (E-UTRA); Radio Resource Control (RRC) (hereinafter: TS 136 331), Annex KAP A 18.

152. The defendants wrongly deny infringement by the LTE standard as far as features 1.1, 1.3.1, 1.3.2 and 1.3.3 are concerned. The realisation of the other features of the claim is not in dispute between the parties and is also not based on misconceptions under patent law.

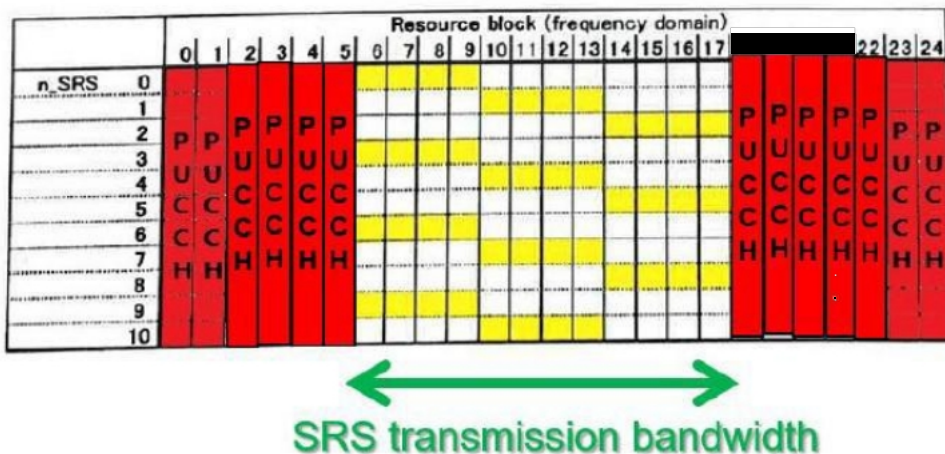
The argument that the patent in suit is not infringed because the LTE standard allows the signal bandwidth of the SRS signals to be set independently of the PUCCH and a change in the signal bandwidth is not dependent on a varying PUCCH is not correct. In this respect, the defendants overlook in their argumentation that it is sufficient according to the claim that the radio communication apparatus can be set by network-side instructions according to the specifications of the claim ("radio communication apparatus configurable to").

Violation Feature 1.3.3

153. According to the standard, the SRS signals can be distributed evenly in the transmission bandwidth as defined in feature 1.3.3. This can also take place depending on the change in the transmission bandwidth. There also do not remain the disadvantageous gaps between the control channels and the frequency ranges actually covered by the SRS signals, which the defendants have illustrated with the graphic shown below, as known from the prior art:



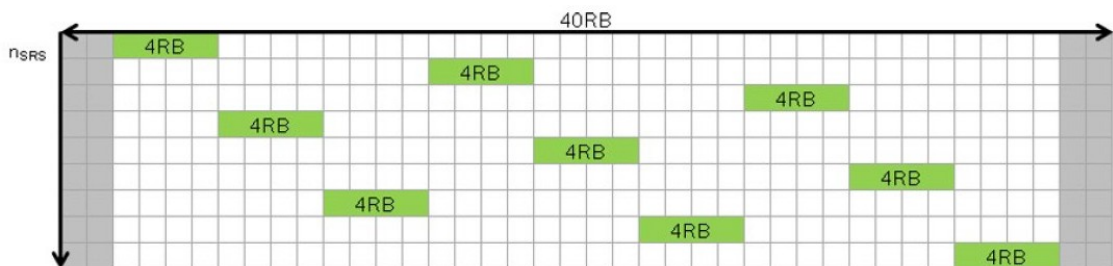
154. With reference to Table 5.5.3.2-1 of TS 136 211 (Annex KAP A 17), the applicant pointed out that this representation is artificial, because in this case the base station would not actually leave any gaps to the right and left of the areas covered by SRS, but would only select the configuration in this way if there was correspondingly high traffic on the PUCCHs and these would then occupy correspondingly more RBs. They have tried to illustrate this schematically using the figure shown below:



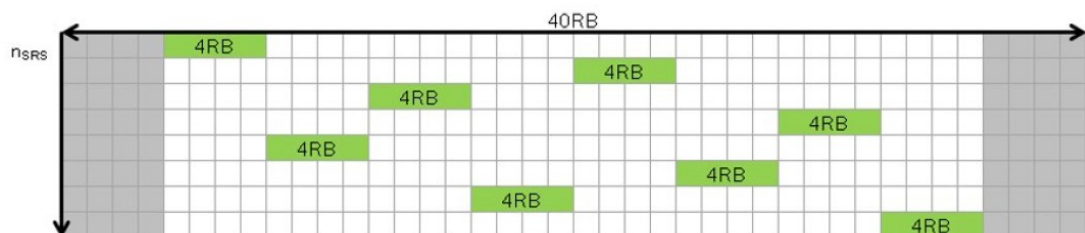
155. In the example shown by the defendants, on the other hand, the network would choose configuration 3 with a bandwidth of 20 RBs in order to cover the area between the PUCCHs as well as possible:

SRS bandwidth configuration C_{SRS}	SRS-Bandwidth $B_{SRS} = 0$		SRS-Bandwidth $B_{SRS} = 1$		SRS-Bandwidth $B_{SRS} = 2$		SRS-Bandwidth $B_{SRS} = 3$	
	$m_{SRS,0}$	N_0	$m_{SRS,1}$	N_1	$m_{SRS,2}$	N_2	$m_{SRS,3}$	N_3
0	36	1	12	3	4	3	4	1
1	32	1	16	2	8	2	4	2
2	24	1	4	6	4	1	4	1
3	20	1	4	5	4	1	4	1
4	16	1	4	4	4	1	4	1
5	12	1	4	3	4	1	4	1
6	8	1	4	2	4	1	4	1
7	4	1	4	1	4	1	4	1

156. The fact that this determination is made by the network and not by the UE does not prevent the claim from being infringed. Rather, it is sufficient that on the network side, for example with a system bandwidth of 8 MHz, the configuration $B_{SRS} = 3$ can also be selected at $C_{SRS} = 0$, which results in the following distribution that is uniform and corresponds to the change in the transmission bandwidth within the meaning of feature 1.3.3:



157. This has also been substantiated by the plaintiff for the configuration $C_{SRS} = 1$ and $B_{SRS} = 3$:



158. The defendants have not countered this with any substance (Rule 172.2 RoP). The defendants' reference to the fact that the 8 MHz example chosen by the plaintiff as an illustration not a common bandwidth in the LTE standard is irrelevant. This is because the defendants have recently merely pointed out that the parameters m_{SRS} and c_{SRS} referred to by the plaintiff are only allocated semi-statically and that the adjustment is only possible in 80 ms intervals at the shortest (Duplik Technik para. 83 et seq.). On the other hand, the PUCCH changes every millisecond and the data assigned to the PUCCH in each subframe is calculated by the terminal device from data that it received from the base station in the downlink only 4 milliseconds before the respective subframe, which is why the LTE standard relied on excludes an adaptation of the (semi-) static SRS configuration to the rapidly and dynamically varying PUCCHs (Duplik Technik para. 90-110).

159. However, this argument is irrelevant under patent law because the present teaching does not presuppose that the conflict between PUCCH and SRS signals addressed by the patent in suit is absolutely excluded in any of the diverse and, as is known to the skilled person, dynamic conditions. The patent in suit does not provide sufficient evidence for such an understanding of the teaching formulating an absolute claim. Therefore, if the realisation of the teaching does not occur in individual time intervals due to adaptation offsets in the signalling by the network, this is irrelevant.

160. The defendant's argument that, according to its submission, there is no difference between the previously mentioned parameters c_{SRS} and b_{SRS} as well as there is no correlation with the parameter $N^{(2)}$, which allocates a certain number of control channels to a mobile device via the base station (statement of defence para. 121). This argumentation does not deny that the radio communication device according to claim 1 can be set up accordingly, which is sufficient under patent law.

Violation Feature 1.3.2

161. Accordingly, the realisation of feature 1.3.2 by the defendants cannot be successfully denied by arguing that in the standard a change in C_{SRS} can cause a change in m_{SRS} and thus a change in the bandwidth of the reference signal and thus the bandwidth of the reference signal is not fixed irrespective of C_{SRS} (cf. Statement of Defence Technology para. 126). This is because the plaintiff correctly points out that the standard has configurations for which only one and the same narrowband bandwidth of the SRS signal is defined, as shown below, configurations 2 to 6 each have a constant 4 RBs as the narrowband bandwidth of the SRS, which is sufficient for the realisation of the feature (Reply Technik para. 68 et seq.):

5.5.3.2 Mapping to physical resources

[...]

Tabel 5.5.3.2-1: $m_{SRS,b}$ and N_b , $b=0,1,2,3$, values for the uplink bandwidth of $6 \leq N_{RB}^{UL} \leq 40$.

SRS bandwidth configuration C_{SRS}	SRS-Bandwidth $B_{SRS} = 0$		SRS-Bandwidth $B_{SRS} = 1$		SRS-Bandwidth $B_{SRS} = 2$		SRS-Bandwidth $B_{SRS} = 3$	
	$m_{SRS,0}$	N_0	$m_{SRS,1}$	N_1	$m_{SRS,2}$	N_2	$m_{SRS,3}$	N_3
0	36	1	12	3	4	3	4	1
1	32	1	16	2	8	2	4	2
2	24	1	4	6	4	1	4	1
3	20	1	4	5	4	1	4	1
4	16	1	4	4	4	1	4	1
5	12	1	4	3	4	1	4	1
6	8	1	4	2	4	1	4	1
7	4	1	4	1	4	1	4	1

Violation Feature 1.3.1

162. According to the standard, the transmission bandwidth also varies in the given system bandwidth. The applicant has shown with substance that for a system bandwidth of 25 RB (5 MHz) several configurations are provided by the standard and that the transmission bandwidth $m_{SRS,0}$ changes by changing the configuration C_{SRS} :

5.5.3.2 Mapping to physical resources

[...]

Tabel 5.5.3.2-1: $m_{\text{SRS},b}$ and N_b , $b=0,1,2,3$, values for the uplink bandwidth of $6 \leq N_{\text{RB}}^{\text{UL}} \leq 40$.

SRS bandwidth configuration C_{SRS}	SRS-Bandwidth $B_{\text{SRS}} = 0$		SRS-Bandwidth $B_{\text{SRS}} = 1$		SRS-Bandwidth $B_{\text{SRS}} = 2$		SRS-Bandwidth $B_{\text{SRS}} = 3$	
	$m_{\text{SRS},0}$	N_0	$m_{\text{SRS},1}$	N_1	$m_{\text{SRS},2}$	N_2	$m_{\text{SRS},3}$	N_3
0	36	1	12	3	4	3	4	1
1	32	1	16	2	8	2	4	2
2	24	1	4	6	4	1	4	1
3	20	1	4	5	4	1	4	1
4	16	1	4	4	4	1	4	1
5	12	1	4	3	4	1	4	1
6	8	1	4	2	4	1	4	1
7	4	1	4	1	4	1	4	1

163. Again, it is sufficient that the steps performed by the radio communication device can be controlled on the network side, because according to the wording of the claim ("configurable to") it is sufficient that the device is set up to interpret and process the corresponding control commands.

Violation of characteristic 1.1

164. Finally, feature 1.1 is also realised by the LTE standard. This is because even if the claim to the transmission bandwidth is correctly understood, a configuration for the value $m_{\text{SRS},0}$ can be provided on the network side as standard, in which the transmission bandwidth lies between the control channels, since it indicates the bandwidth in which the reference signals are distributed. This was not substantiated by the unsubstantiated assertion made in the statement of defence in technical paragraph 134 that it is "obvious" that Table 5.5.3.2-1 is only intended for changing system bandwidths, but does not require an adjustment of the transmission bandwidth within a constant system bandwidth. It is sufficient that the standard enables a patent-compliant configuration.

Passive legitimacy of the defendant

165. The defendants also have standing. Defendant 1. maintains its European headquarters in Düsseldorf and controls the distribution of the attacked embodiments in the respective contracting states of the UPCA asserted in the present case from here. The defendant 2. operates in Düsseldorf together with the defendant 2.

1 is the European headquarters of the group. Defendant 1 controls the business activities of defendant 2.

166. It is aware of the channels through which mobile devices from the OPPO Group are sold, in particular via third-party providers in Europe and especially in the Federal Republic of Germany, and promotes this and does not oppose it despite being aware of it. Its website contains links to providers through which the Oppo Group's 4G-capable products be purchased. In addition, it supports these sales activities by also providing the user manuals for the 4G-capable products written in the respective language on the markets asserted in the present case, offering warranty packages, placing targeted advertising for the attacked designs during the UEFA Champions League and thus actively promoting the sales activities on the markets asserted in the present case. Defendant 2. cooperates with defendant 1. in a structured manner to promote sales.

167. In particular, the plaintiff has submitted in a sufficiently substantiated manner that - in addition to the acts attacked in the other contracting states with the present action - the attacked embodiments are still offered and marketed on online marketplaces such as Otto, Amazon Marketplace and Google Shopping in the Federal Republic of Germany, from which the defendant group allegedly claims to have withdrawn. This means that concrete submissions on acts of infringement have also made with regard to the German part of the bundle patent asserted in the present case. The defendant's blanket denial with regard to acts of infringement by both defendants in the Federal Republic of Germany is unsubstantiated (R.171.2 RoP). It

It is not sufficient to take the general view that the plaintiff's submission does not suffice as evidence for the promotion of the actions described by the plaintiff. The plaintiff's submission was not specifically contradicted.

Legal consequences of patent infringement

168. The established patent infringement by the defendants of the national part of the bundle patent validated in the respective asserted contracting states justifies the legal consequences sought by the plaintiff.

169. The application for a declaration of patent infringement is based on Art. 64(2)

(a) UPCA. In the present context of infringement of a standard essential patent, the determination of patent infringement serves the legitimate interest of the plaintiff, also vis-à-vis (non-)authorised distributors of the defendant.

170. The injunction sought by the plaintiff with regard to the infringing act is based on Art. 25(a), Art. 63(1) UPCA and must be granted because there is a risk of repetition due to the infringing acts committed by the defendants in the past in the contracting states asserted in the present case. The defendants may not continue the acts of offering, placing on the market, using, importing or possessing for these purposes in the Contracting States covered by the action. In particular, sufficient submissions have been made with regard to the national parts of the bundle patent asserted in the present case and their infringement in the respective territories. A separate statement on the "in particular" applications of the plaintiff with regard to the sub-claims was not necessary because they are merely exemplary concretisations of the acts already covered by the main statement.

171. In the present case, there are no apparent reasons to refrain from exercising the court's discretion ("may ... issue") to issue a final order. Rather, proportionality considerations (Art. 42 UPCA and

Art. 3(2) Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights) already comprehensively in the context of the consideration of the examined antitrust compulsory licence objection under application of the of the European Court of Justice's balanced negotiation programme (see below). Further circumstances that would appear to make it necessary from the point of view of proportionality not to issue an injunction in the present case have not been sufficiently demonstrated. It also had to be taken into account that the defendants, according to their own submission, do not see their main business in the markets of the UPCA contracting states anyway, as is also reflected in the fact that the licence share included in their blanket licence offer for the UPCA states is only

Thus, according to the [REDACTED] [REDACTED] from operating in the defendants' core markets. Nor can the generalised argument that the plaintiff itself does not manufacture and is therefore not in direct product competition with the defendants prevail. Rather, specific facts must be presented in this respect that justify a different decision because they are not already reflected in the negotiation programme of the European Court of Justice's decision. This has not been done in the present case. The defendant's submission does not indicate any such further aspects.

172. Contrary to the view of the UK Court of Appeal [2024] EWCA Civ 1143 para. 79, standard-essential patents are also not to be regarded as patents which have solely a monetary assignment content, at least in the legal area of the European Union. On the contrary, according to the case law of the European Court of Justice - which is admittedly no longer relevant for the courts of the United Kingdom - the holder of an SEP can also exercise the prohibition rights to which it is entitled on the basis of the patent, ECJ, Huawei v. ZTE, ECLI:EU:C:2015:477, para. 46:

"It is settled case law that the exercise of an exclusive right attached to an intellectual property right, in this case the right to bring an infringement action, is one of the prerogatives of the owner of an intellectual property right, so that it cannot in itself constitute an abuse of a dominant position, even if it emanates from an undertaking in a dominant position."

173. This is incompatible with an understanding of the SEP as a legal title that does not include the right to enforce an injunction and that serves solely to enforce higher licence claims. Such a view is incompatible with European law, as Article 11 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights as a standard in the European judicial area shows. This also follows from the decision of the ECJ (*ibid.* para. 57-59 and para. 71), in which it is stated that it does not constitute an abuse of a dominant market position to bring an action for an injunction against an infringement as long as certain steps have been taken prior to such an action. Such an understanding would also be incompatible with the minimum constitutional guarantees of the Federal Republic of Germany as one of the contracting states invoked in the present case (Article 14 (1) of the Basic Law of the Federal Republic of Germany) as well as with Article 17 (2) of the Charter of Fundamental Rights of the European Union.

174. Nor is any other restriction of the injunction appropriate in view of the FRAND rate determination taking place in the UK in a different dispute. The decision of the UK Court of Appeal itself states that the Oppo group of companies is not affected by the *declaratory judgement* (*ibid.* para. 2). It can therefore be left open in the present dispute whether the finding made - in the words of the UK Court of Appeal - is *de facto* an "anti-suit relief by the back door" (*ibid.* para. 67) that is unacceptable in the international treaty law context of TRIPs (cf. Art. 1.1, 28.1 and .2, 41.1, 44.1 TRIPs, which must be observed in this context under international law).

175. The threat of a penalty payment for the omission (Art. 63(2) UPCA) raises no objections. The unit-related nature of the penalty payment provides a fixed amount for calculating the penalty payments to be paid to the court for the acts of distribution to be omitted. The determination has deterrent potential. However, the amount was to be reduced to EUR 1,000.00 per infringing form, which is considered sufficient but also appropriate in relation to the sales prices. Insofar as other actions are objected to, the appropriate amount will have to be determined in separate enforcement proceedings. The defendants may counter the risk of any cumulative assessment of penalty payments in parallel proceedings in the enforcement proceedings, insofar as the plaintiff actually pursues parallel enforcement.

176. The threat of measures of disclosure, information, recall and removal are based on Art. 82(1) and (4) UPCA, R. 354.3 RoP. The determination of the appropriate penalty payments is to be reserved for enforcement proceedings because there is currently insufficient evidence to assess the appropriateness of a penalty payment to be determined in terms of amount.

177. The application for destruction of the products directly infringing claim 1 is based on Art. 64 (2) (e) UPCA, the applications for recall of these products from the channels of commerce and final removal of these products from the channels of commerce are based on Art. 64 (2) (b) and (d), (4) UPCA. According to the wording of the UPCA, permanent removal from the channels of commerce is a separate measure from recall. It accompanies the recall, whereby removal can only be considered if the infringer has the factual and legal means to do so. No sufficient reasons have been presented or are otherwise apparent to oppose the ordering of these measures, for example from the point of view of proportionality, and which go beyond the consequences resulting from a patent infringement which

to be borne by the infringer. However, it was not necessary to set a time limit of days for the enforcement of this obligation. In this respect, it had to be seen that, on the one hand, the obligation exists directly on the basis of the court order, but on the other hand - especially in the case of an allegation of infringement extending to several contracting states of the UPCA, the cessation of which can take some time - no rigid time limit could be ordered without a submission on the circumstances of the case at hand, because the court was unable to assess the question of which time limit appears reasonable in view of the considerable scope of the acts of use (unlike the local division Düsseldorf case (UPC_CFI_7/2023 v. 3 July 2024)) is not possible in the present case. Clarification of the question may be reserved for any enforcement proceedings. The version of the application is also sufficiently specific due to the reference back to the injunction in conjunction with the grounds for the decision. In accordance with the wording of the application, the defendants are free to choose the appropriate and effective measures. The territorial limitation lacked by the defendants results from the withdrawal to the injunction, the limitation to the period after the grant of the patent in suit results from a reasonable assessment of the application and then the grounds for the decision. The distribution channels include all commercial end users.

178. The decision to provide the requested information is based on Art. 25 (a), Art. 67 (1) UPCA. The information is necessary for the calculation of damages and for the assessment of the method of calculating damages within the meaning of Art. 68 UPCA. The defendants cannot agree that the owner of an SEP would be limited from the outset to calculating damages against an infringer only by way of licence analogy. On the contrary, the European Court of Justice has ruled that past-related claims are not affected by the antitrust context (ECJ Huawei v. ZTE ECLI:EU:C:2015:477, operative part no. 2). In this respect, it has already been decided in national case law that the scope of the claim for damages can only be limited to the claims arising from

of a licence analogy if the infringer can counter this with its own claim for damages which is directed at the non-fulfilment of its claim to the conclusion of a FRAND licence agreement and as a result of which it can demand to be placed in the same position as it would be under such an agreement (see German Federal Court of Justice GRUR 2020, 961 para. 109 et seq. - FRAND-Einwand, GRUR 2021, 565 para. 137 - FRAND-Einwand II). The information on origin and distribution channels serves to clarify the facts of the infringement and the possibility of claiming further co-responsible parties and effectively stopping further acts of infringement. Again, no rigid deadline for the provision of information was to be set (see above). Upon application, it was also to be ordered that the defendants provide the plaintiff with the information in a list structured for each month of a calendar year and according to infringing products in electronic form that can be analysed with the aid of a computer. This serves the efficient enforcement of the right to information and takes account of the fact that an electronic statement that can be analysed with the aid of a computer is in any case the standard in a business-like accounting system. However, there was again no deadline set for the enforcement of this obligation.

179. The subject of the information is also the accounting requested in application IV.2 ("to disclose their books [...] by providing [...] the following documents"). On a reasonable interpretation of the argumentation submitted in this regard (statement of claim para. 247 et seq.), the application is not aimed at verifying the correctness of the information and accounting provided within the meaning of the German Civil Code.

R. 141 et seq. RoP, but rather requests the submission of accounts with supporting documents. This is also based on Art. 68(3) UPCA, R. 191 RoP. In this respect, the local division agrees with the Düsseldorf local division (UPC_CFI_7/2023 of 3 July 2024 at F.I.2.b) that the rules contain a substantive entitlement to demand information that the infringed party needs in order to be able to check the validity of the information and to obtain indications for its calculation of damages to . This is supported by in particular

Efficiency aspects, because this can save further stages of the procedure. In addition, within the scope of this right of transmission, the patent proprietor may also request a documentary evidence for the information under Art. 67(1) UPCA, namely invoices or - if these are not available - alternatively delivery notes. Apart from the interest in the pure information which the patent proprietor receives under Art. 67(1) UPCA, his interest in being able to check the accuracy of this information, at least on a random basis, is also worth recognising. The possibility of redaction in the pronouncement takes account of any confidential information (R. 191 p. 2, 190.1 p. 2 RoP). However, there was again no time limit set by day for the enforcement of this obligation.

180. The requested auditor reservation allows an appropriate balance to be struck between the interest of the infringed party in receiving accurate information and the legitimate confidentiality interests of the infringer. Since the auditor may only work to the extent specified in the decision and is also obliged to maintain confidentiality towards the infringed party, the selection can also be by the infringed party. Again, the Order of a fixed deadline was not appropriate.

181. The determination of the obligation to pay damages is based on Art. 68(1) UPCA and is justified by the established infringement. The defendants also acted negligently in any case. The requirement of a notice of infringement by the SEP proprietor in accordance with the case law of the ECJ does not imply a lack of fault, as already shown by the fact that the ECJ has not subjected the past-related claims to any further restrictions. Moreover, according to the relevant regulations, it serves to prevent any claims from becoming time-barred. The plaintiff is also entitled to demand the determination of the damages incurred Panasonic Intellectual Property Corporation of America as the previous patent holder. Panasonic Intellectual Property Corporation of America has assigned its claims to the plaintiff in this respect.

182. Insofar as the plaintiff seeks provisional damages in the amount of € 250,000€ , this was to be granted in the present case pursuant to Art. 68(1) UPCA, Rule 119 RoP because the court fees alone exceed this amount in the amount of € 336,000.
183. However, the application for publication of the judgement had to be dismissed. In this respect, the decision under Art. 64(2)(a) UPCA is sufficient from the point of view of proportionality (see above). Circumstances that would justify a more extensive interest in the requested publication of the judgement have not been submitted and are not otherwise apparent.
184. With regard to the indirect infringement of the patent in suit in its method claim 13 by the challenged embodiments, the plaintiff's right to prohibit the continuation of the infringement follows from Art. 26(1) UPCA in conjunction with Art. 63(1) UPCA. The applicant also has a right to information and transmission of information pursuant to Art. 26(1) UPCA in conjunction with Art. 67 UPCA, Art. 68(3)(a), (b) UPCA in conjunction with Art. 67 UPCA. Art. 67 UPCA, Art. 68(3)(a), (b) UPCA in conjunction with R. 191 p. Alt. R. 191 S. 1 Alt. 2 RoP and the payment of provisional damages and the determination of the award of damages on the merits (Art. 26(1) UPCA in conjunction with Art. 68(1) UPCA). Art. 68(1) UPCA, R. 119 RoP). The threat of coercive measures is governed by Art. 63(2), 82(1) and (4) UPCA, R. 354.3 RoP and applies mutatis mutandis to decisions on contributory infringement. Reference is also made to the above statements.
185. The award of costs is based on Art. 69(2) UPCA, Rule 118.5 RoP. In view of the fact that the plaintiff was only marginally unsuccessful with regard to the scope of individual legal consequences, no share of the costs to be borne by the plaintiff is to be awarded.
186. Pursuant to Art. 82(2) UPCA, R. 118.8 S.2 RoP, the court may make any order or measure subject to the provision of a security, which it shall fix. The local division is entitled to exercise its discretion when ordering the provision of security, whereby the applicant's interest in the effective enforcement of its IP right is taken into account.

must be weighed against the interest in the effective enforcement of possible claims for damages in the event that the judgement is subsequently set aside. In the present case, the defendants rightly argue that the enforcement of such an Order will prevent their core business, namely the sale of smartphones, in the countries concerned. This would not only result in the loss of all current sales, but also future business damage. Potential end customers and existing commercial customers would switch to other manufacturers and possibly remain there permanently. This is accompanied by specific risks of increased and permanent market losses. These fears are by the special features of smartphone sales. Smartphones are offered and distributed to a considerable extent via commercial resellers and via national telephone network providers, whereby the latter often work with long-term supply contracts. If the defendants were forced to discontinue deliveries to the network providers despite existing contracts, this would possibly lead to a permanent exclusion from the network providers' programme. This would result in the loss of an important distribution channel and it would be difficult to predict whether and when it could be reopened. The defendants leave the amount of the security deposit to the discretion of the court. In the present case, in view of the parties' recently opposing blanket licence offers, setting the security deposit at 10 million€ appeared necessary, but also sufficient.

It had to be taken into account that the defendants themselves only allocated less than [REDACTED] tel of the total amount to the business in all EPC states in their lump sum offer [REDACTED] Based on the last

The plaintiff's lump-sum offer [REDACTED] was to be estimated at [REDACTED] and therefore just under [REDACTED] If, in addition, the costs for the the renewed market entry of [REDACTED] , an amount € 10 million appears to be sufficient. It should be noted that the present judgement does not cover all EPC states, but only the contracting states of the UPCA listed in the judgement. Therefore, the security amount is in any case sufficient without any further submission by the defendants, who expressly left the decision to the discretion of the court without providing any details. The adjudicating body exercises its

The court further exercised its discretion to extend the group of credit institutions eligible to issue the bank guarantee to credit institutions authorised to do business there, contrary to the defendant's application, in view of the fundamental freedoms of the European Union. With regard to the equally enforceable claims for information/invoicing and preliminary damages, no security was to be ordered as a prerequisite for enforcement in view of the lack of indications that the plaintiff would not be able to financially compensate the resulting damage if the first instance decision were not to stand.

187. The Orders are only enforceable after the plaintiff has notified the court which part of the Orders it intends to enforce and has submitted a certified translation of the Orders into the official language of the Contracting Member State in which enforcement is to take place and after the notification and the (respective) certified translation have been served on the defendants and the security has been provided, R. 118.8 RoP. Since the defendants are sufficiently protected by the security ordered, it was no longer necessary to order that the defendants be authorised to avert enforcement.

FRAND objection

188. The above legal consequences are also not by a FRAND objection based on Art. 102 TFEU. While the plaintiff acted in accordance with the ECJ's programme of obligations addressed to it as SEP holder, the defendants did not participate in the negotiations for a FRAND-compliant licence in accordance with the negotiation programme developed by the European Court of Justice in Case C-170/13 - Huawei v. ZTE, ECLI:EU:C:2015:477, in a targeted manner and in accordance with the practices of a party seriously interested in taking a licence.

189. The Unified Patent Court applies Union law in its entirety and respects its primacy, Art. 20 UPCA. Union law is the primary source of law to be applied by the Unified Patent Court, Art. 24(1)(a) . In questions concerning the correct interpretation of European law, the Court of First Instance may refer questions relevant to the decision to the CJEU, Art. 267 TFEU. The decisions of the CJEU are binding on the Unified Patent Court, Art. 21 UPCA.

190. However, the present case - especially for the Court of First Instance - does not give rise to a referral to the ECJ, even against the background of the amicus curiae brief of the European Commission, which the Commission submitted to the Higher Regional Court of Munich on 15 April 2024 under the number 020078-24 MLO / DLF and with which the European Commission "encourages" the court there to refer the case to the ECJ. Rather, the ruling body is of the opinion that the only questions that arise in this case relate to the individual case at hand, which can be resolved by applying the balanced principles developed by the Court of Justice, which allow the courts called upon to apply the law in individual cases to make an appropriate assessment of the case in question. At the same time, the opinion of the European Commission - which is admittedly not binding on the constitutionally independent courts - can be taken into account. The document has also been introduced in the present proceedings and was discussed intensively with the parties during the oral hearing.

191. In the Huawei v. ZTE decision, the ECJ established a negotiation programme that has since been binding on the courts of the Member States - unlike the courts of the United Kingdom. Since then, the courts of the Member States have applied this negotiation programme and have continued to fill in the details on the basis of the cases submitted for decision (see Dutch Court of Justice The Hague, case number: 200.219.487/01, of 2 July 2019 - Philips v. Wiko; the same case number: 200.233.166/01, judgment of 24 December 2019 - Philips v. ASUS; German Federal Court of Justice GRUR 2020, 961 - FRAND-Einwand, GRUR 2021, 565 - FRAND-Einwand II). Here is the

PANEL is of the opinion that the ECJ's negotiation programme is not solely focused on determining the respective licensing conditions, which would, as it were, be stripped of an assessment of the respective conduct of the parties in the context of the negotiations. Rather, the central concern of the decision is to establish a negotiation programme with reciprocal obligations that also serves to assess the primary EU law question of whether the enforcement of the prohibition and recall rights from the patent is subject to antitrust restrictions. The determination of a FRAND licence rate, if applicable, is only one component of this programme. Accordingly, the present case is the first time that a local division of the Unified Patent Court has been called upon to rule as a common court of the Member States. This gives rise to the following comments.

192. In its leading decision *Huawei v. ZTE*, the European Court of Justice set out a negotiation programme that shows the parties their respective obligations in the context of negotiations for a licence to a standard essential patent and enables the courts to assess the conduct of the parties on the way to a licence. According to settled case law of the ECJ (*loc. cit.* para. 46), the exercise of an exclusive right associated with an intellectual property right, in this case the right to bring an action for infringement or recall, is one of the prerogatives of the holder of an intellectual property right, so it cannot in itself constitute an abuse of a dominant position, even if it emanates from an undertaking in a dominant position. However, the exercise by the holder of an exclusive right associated with an intellectual property right may, in exceptional circumstances, constitute abusive behaviour within the meaning of Art. 102 TFEU (*ibid.* para. 47). It should be recalled - particularly in light of the decision of the UK Court of Appeal - that the ECJ has stated that account must be taken of the need to safeguard intellectual property rights, which one of the purposes of Directive 2004/48. The Directive provides, in accordance with Article 17(2) of the Charter, for a number of remedies intended to ensure that intellectual property rights in the internal market and the right of defence set out in Article 47 of the Charter are protected.

The Court of Justice has ruled that the right to effective judicial protection, which comprises several elements including the right of access to the courts, requires a high level of protection (ECJ loc. cit. para. 57). This requirement of a high level of protection intellectual property rights implies that their owner cannot, in principle, be deprived of the possibility of taking legal action to ensure that his exclusive rights are effectively respected and that the user of those rights, if he is not their owner, must in principle obtain a licence before any use (ECJ loc. cit. para. 58).

193. The negotiation programme developed by the ECJ serves these principles. An assessment of the conditions of a FRAND licence that ignores the steps established by the ECJ in the sense of a purely economic determination of the licence amount without taking into account the relevant conduct of the parties involved in the negotiations can therefore not stand up under European law and would violate mandatory law in the Member States.

194. According to the ECJ's decision, the SEP holder must first inform the patent user of the patent infringement of which he is accused before bringing an action for an injunction. In doing so, he must identify the SEP in question and indicate how it is alleged to have been infringed (ECJ loc. cit. para. 61). It had already become established in the cited case law of national courts that the sending of claim charts is sufficient for these purposes in any case (see, for example, from national case law, Court of The Hague, case number 200.233.166/01 of 24 December 2019, para 4.157 et seqq. - Philips vs ASUS; Higher Regional Court Karlsruhe, judgement of 9 December 2020, 6 U 103/19 - Mobilstation; Regional Court Mannheim, judgement of 19 August 2016, 7 OD 2016, para 4.157 et seqq. 19.08.2016, 7 O 19/16 - Secondary station; judgement v. 29.01.2016, 7 O 66/15 - control channel; LG Düsseldorf, judgement v. 11.07.2018, 4c O 81/17 para. 108). Insofar as the European Commission takes the view in its opinion in this context that this reference must be made in the letter itself (amicus curiae letter para. 65), such a formalistic understanding cannot be accepted. It is true that a reference to a generalised website of the SEP holder, which does not contain any easily accessible information on the specific

patent-in-suit too little to be considered a sufficient indication. For good reason, however, the ECJ judgement does not impose any strict formal requirements at this point, but leaves it up to the courts of the Member States to decide on a case-by-case basis. Particularly in the case of an allegation of infringement of a large number of standard-relevant patents, a notice in the formalised form deemed necessary by the Commission may lead to confusion rather than the desired transparency.

195. In the present case, it was sufficient to make the defendants aware that they were also accused of infringing patents valid in the EU legal area and thus to encourage them to deal with the further steps of the ECJ's balanced negotiation programme that the plaintiff - in addition to a large number of other claim charts requested by the defendants - also sent a claim chart concerning the Chinese family member of the patent family, which also includes the patent in suit. The claim chart contained an explicit reference to the patent in suit. If the defendants argued at the oral hearing that the Chinese patent had a broader scope of protection and therefore the relevance of the patent-in-suit for the standard not be assessed without further effort and explanation, this behaviour provides an example of how an implementer seriously interested in a FRAND licence should not behave. Such an implementer would have raised a corresponding complaint at least once if it had actually had problems of understanding and for a more in-depth discussion. The defendants, on the other hand, did not raise any such objection, but only repeatedly requested further claim charts for other patent families, only to then withdraw without further discussion of all the requested material to the effect that the sources they consulted would in any case provide generally valid findings as to what proportion of declared patents is actually generally essential for the standard (see below for details). It is not in line with the practice of commercial transactions, to which the ECJ refers (*loc. cit.* para. 65, 67), to resort to formalistic objections, as the defendants do in such a situation, and to deduce from this that

there were no further obligations for the own side with regard to targeted negotiations towards a FRAND licence. The infringement notice was sufficient.

196. The patent user must then express its intention to conclude a licence agreement on FRAND terms in a further step - also before filing an action (ECJ loc. cit. para. 63). The significance of this step in the ECJ's negotiation programme is assessed differently, at least with regard to the weighting of this step in the negotiation programme. The Federal Court of Justice explained this in para. 83 of its FRAND decision (BGH GRUR 2020, 961 para. 83):

"Therefore, it is not sufficient, after the first indication, to establish further obligations on the part of the dominant patent proprietor if the infringer then merely indicates its willingness to consider concluding a licence agreement or to enter into negotiations as to whether and under what conditions it might consider concluding an agreement (see Opinion of Advocate General Wathelet of 20 November 2014 - C-170/13 para. 50). Rather, the infringer must clearly and unambiguously declare its willingness to conclude a licence agreement with the patent proprietor on reasonable and non-discriminatory terms and must also subsequently participate in the licence agreement negotiations in a targeted manner. The High Court of England and Wales (J. Birss) has aptly expressed this by stating that "a willing licensee must be one willing to take a FRAND licence on whatever terms are in fact FRAND" (EWHC, judgment of 5 April 2017, [2017] EWHC 711 (Pat) para. 708 - *Unwired Planet v Huawei*)."

197. According to the European Commission, this criterion, known as "willingness to licence", should be assessed solely "on the basis of the content and circumstances of the declaration, but not on the basis of subsequent conduct during any negotiations" (amicus curiae letter para. 7, 75, 80 et seq.). The first two steps of the framework programme preceded the start of the negotiations, in particular the SEP holder's offer. Therefore, the assessment of their existence could not be linked to specific licence conditions or licence fees (ibid. para. 82). The patent user's willingness to licence could not be determined on the basis of its subsequent conduct during the negotiations; the second step was merely a formal step as a prelude to negotiations. In particular, this step may not be linked to the

subsequent steps, the offer of the SEP holder and the counter-offer of the patent user (loc. cit. para. 84 et seq.).

198. The European Commission agrees that the initial declaration of willingness to licence the prelude to further negotiations. It must not be limited to mere lip service, but must be serious in the sense of the statements of the BGH. However, consideration of the respective declaration alone does not generally lead to any further examination of whether a patent user is seriously interested in taking a licence. A corresponding declaration, even if it is based on the wording of the cited UK or BGH decision or adopts it in a clichéd, identical wording, is not in itself a suitable indication for assessing whether the respective user is actually serious about his declaration. For this purpose, the respective behaviour must always be considered in an overall view. However, the Commission correctly addresses the fact that the examination of FRAND-compliant behaviour must not focus solely on the willingness to licence in the sense of an analysis of the user's behaviour alone. It is therefore incorrect to "willingness to licence" be the basis of the patent user's counter-offer by again using this as an indication for or against the seriousness of the user's behaviour without first considering the SEP holder's offer. With such an understanding, there is a considerable risk that the necessary examination of the offer of the SEP holder bound by antitrust law will not be carried out at all or will be cursory at best. This would not do justice to the ECJ's decision. It is precisely this point that is criticised by the European Commission in the context of the decision of the Regional Court of Munich I that it analysed. Rather, the SEP holder's offer must always be checked for its FRAND compliance if there is sufficient initial willingness to take a licence. This step must not be omitted or only carried out very cursorily. In its referral in the case of *Huawei v ZTE*, the Düsseldorf Regional Court had already formulated the question of whether Art. 102 TFEU places special temporal and/or qualitative requirements on the willingness to negotiate and stated in the referral that it could not be satisfactory to use the term "willingness to negotiate" as a criterion.

of such abuse, as this term leaves room for many interpretations (ECJ loc. cit. para. 38). In this sense, an examination that intends to comply with the case law of the ECJ must not be content with merely analysing the conduct of the patent user for indications that are then singled out in order to criticise an insufficient willingness to license without seriously examining the SEP holder's offer. Such an approach is already contradicted by the fact that the ECJ deliberately did not want to leave it at the so-called Orange Book case law of the Federal Court of Justice. On the contrary, Advocate General Wathelet stated in his Opinion (ECLI:EU:C:2014:2391 para. 51 f.):

"In my opinion, the simple transfer of the judgement Orange-Book-Standard of the Federal Court of Justice or the press release to the present case would result in a situation in which the SEP holder, the user of the teaching of the patent or the consumer would receive either too much or too little protection. A middle way must therefore be found."

199. In this sense, the ECJ initially declared the SEP holder to be obliged to submit a FRAND offer:

"As the Advocate General stated in point 86 of his Opinion, if the holder of an SEP has made a commitment to the standardisation organisation to grant licences on FRAND terms, he can be expected to make such an offer. Moreover, if neither a standard licence agreement nor licence agreements already concluded with other competitors have been published, the SEP holder is in a better position to verify whether its offer complies with the condition of equal treatment than the alleged infringer."

200. The application of the Orange Book case law of the German Federal Court of Justice (BGH GRUR 2009, 694) should not continue. According to this case law, the patent user must first make an unconditional offer to conclude a licence agreement, which the patent proprietor may not reject without violating its obligations under antitrust law not to unreasonably hinder or discriminate against the licence seeker. It is therefore also incorrect to interpret FRAND case law in a way that would de facto lead to a

application of the Orange Book case law. In this respect, we agree with the Commission that the sequence of steps in the ECJ's negotiation programme must not be mixed up in such a way that the investigation of the SEP holder's offer is pushed too far into the background.

201. To the extent that the European Commission's view that the willingness to licence to be expressed prior to filing an action forms the starting point for further negotiations can be accepted, it has not yet been clarified to what extent the further conduct during the negotiations is to be included in the assessment. From the point of view of the PANEL, the seriousness of the initial declaration of willingness to take a licence, understood in this narrower sense, must be assessed on the basis of the immediate circumstances accompanying it. However, this does not mean that the further behaviour of both parties during the subsequent negotiations should be excluded from the assessment. Rather, both the SEP holder and the implementer must behave in accordance with "normal business practice" during the negotiations and work in good faith towards the conclusion of a licence agreement. Their conduct must be assessed according to whether it takes sufficient account of the fundamental objective of the ECJ's negotiation programme to achieve the timely conclusion of a FRAND licence agreement on a primarily private-autonomous basis in targeted negotiations. This requirement results in obligations to be concretised for the individual case at each stage of the negotiations. Nor is it in line with the ECJ's negotiation programme to examine the willingness of the implementer to take a licence alone, without sufficiently examining the SEP holder's offer, just as it would be insufficient to consider only the opposing offers and counter-offers after affirming the first two steps of the examination and to ignore the further conduct of the parties. This is because whether a (counter)offer meets FRAND criteria can only be assessed on the basis of the specific negotiations and the behaviour of the parties. Just as the implementer cannot make a favourable offer without sufficient knowledge of any licensing conditions granted to third parties, the SEP holder cannot make a favourable offer without sufficient knowledge of any licensing conditions granted to third parties.

if the implementer deliberately leaves him in the dark about the extent of his acts of use and his economic framework conditions, such as the sales prices demanded by him on the market, and if he does not provide any information on the economic framework conditions of his actions, which conversely must be sufficiently plausible for the SEP holder - depending on the progress of the negotiations. The depth of the court's examination of the plaintiff's conduct is largely based on the points the licence seeker has objected to vis-à-vis the plaintiff in the negotiation process and, conversely, what information he has made available to the holder in order to be able to make him, the user, an offer tailored to his circumstances. Objections raised only in the course of the proceedings before the court against the background of the threatened injunction alone are not sufficient. With the exception of extreme constellations, the patent user always has the obligation to respond to an offer from the SEP holder and at least to raise his objections against it and to request improvements (see from German case law BGH GRUR 2021, 585 para. 71 - FRAND-Einwand II; OLG Karlsruhe GRUR 2022, 1145 para. 152 et seq. - Steuerkanalsignalisierung II.).

202. This interplay of mutual obligations in the negotiations is again exemplified by the present case. The defendants refused to provide the plaintiff with sufficient information about their acts of use. Even after rejecting their counter-offer, they refused to the plaintiff with information on their actual acts of use. Rather, the defendants referred the plaintiff solely to data from economic data services of the provider IDC, without making these plausible at least for exemplary meaningful periods of time by providing information on their own real acts of use. In this respect, the defendants cannot expect the plaintiff to make an offer that fully reflects the circumstances affecting them if they are not willing to make these circumstances accessible. Insofar as the defendants object in this context that the plaintiff, for its part also used IDC data in order to

The defendants misjudge two things in their attempt to demonstrate the comparability of the conditions offered to the defendants on the basis of third-party licence agreements: Firstly, the third-party licence agreement partners have a legitimate interest in confidentiality insofar as their specific transactions are concerned. In any case, the SEP holder is therefore not obliged to such figures directly accessible to a negotiating partner if it is still open whether the latter is seriously negotiating the conclusion of a FRAND licence. The implementer cannot demand more disclosure from the SEP holder than it is prepared to disclose itself. In addition, the SEP holder does not have this information in the case of blanket licence agreements because there are no reporting obligations regarding acts of use to be remunerated in certain periods of time. Secondly, the defendants fail to recognise that, as a patent infringer using the technology (see above), which, unlike the plaintiff's settlement licensees, drags out the negotiations over years, they cannot demand to be treated equally in every respect with the SEP holder's cooperative licence agreement partners, who resolve any differences in a short time and purposefully participate in negotiations and bring them to a conclusion. Therefore, it may well be unobjectionable under antitrust law if an SEP holder makes do with data from commercial services for the negotiations if the prospective licence holder in question works constructively and swiftly towards the conclusion of such a licence. On the other hand, the ECJ has also clearly that the patent user using the technology unlawfully must provide information and security at the latest after its counter-offer has been rejected. The plaintiff's argument can be accepted in that the information serves the purpose of assessing whether the security offered sufficiently covers the risk of insolvency of the patent infringer. In this context, the SEP holder, who has himself submitted an offer that is to be assessed as FRAND-compliant under the respective circumstances of the negotiations, does not have to be satisfied with data from commercial services compared to a patent infringer who drags out the negotiations.

203. The examination of the SEP holder's offer must be based on the above statements.
The adjudicating body is of the opinion that the SEP holder

when submitting its offer, must not only state the mere mathematical factors with which it calculates the licence fee. Rather, he is required to plausibilise, in the manner possible to him according to the status of the negotiations, why he believes that the offer submitted by him can be regarded as FRAND-compliant. This follows from the ECJ's statements in para. 64 of its decision. The SEP holder has the better knowledge of its licensing practice and should communicate this to the patent user so that the latter can react to it in good faith. This also corresponds to the understanding of the judgement developed by the Commission, which states this in para. 50 f. of the amicus curiae brief:

"The background to this distribution of obligations is that, in the absence of a published standard licence agreement and if the licence agreements concluded with other users are not published, only the patent proprietor regularly knows the conditions under which he has already concluded licence agreements and which conditions are therefore non-discriminatory. The patent proprietor must examine the licence offer in a fourth step and respond to it within a reasonable period of time."

204. The extent of the explanations depends on the stage reached in the negotiations between the parties. It is therefore not necessary in every case - including the present case - to disclose the names and conditions of the third-party licence agreements directly in order to check plausibility (see below for details).

205. Based on these principles, the following applies to the present case:

Sufficient notice of infringement before filing suit

206. As stated above, the reference to the infringement of the patent in suit by the plaintiff was sufficient. On 22 July 2020, the plaintiff sent Guangdong Oppo a list of which of its essential patents it considers to be infringed for the 3G and 4G standards (Annex KAP FRAND 1). Explicit designations of the defendant's 4G-capable products can be found in the presentation of 4 August 2020 (Annex VB-

F 3), whereby the defendants were already aware that the allegation of infringement was directed against all 4G-capable products. The plaintiff submitted an updated list of patents deemed to have been infringed on 7 January 2022 (Annex KAP FRAND 2). This also contains a reference to the patent in suit. In addition, on 31 August 2020, the plaintiff also sent claim charts relating to the Chinese family member of the patent in suit (ZL201310315589.X). According to the plaintiff's uncontradicted submission at the hearing, this also contained an explicit reference to the patent in suit. Objections that this was not sufficient for the comprehensibility of the infringement allegation were raised by the defendants for the first time at the oral hearing. This is late. In addition, the objection was not justified on the merits, since defendants objected that the Chinese patent had a broader scope of protection than the patent in suit. If there had been a need for clarification here, the defendants, as a cooperative licence seeker, could and should have asked the plaintiff. In the rejoinder, however, the defendants retreated to the formalistic position that a reference to the patent in suit was required in the letter of reference itself. As already explained, this argument is not convincing.

Declaration of willingness to licence by the defendants before filing suit

207. According to the standards set out above, the defendants have expressed their initial willingness to take a licence in a sufficient manner to serve as a starting point for further negotiations. The statements they made before filing the action have made it sufficiently clear that the defendants are interested in taking a licence and that the plaintiff, as the holder of the SEP bound by antitrust law, is therefore obliged to enter into constructive negotiations with the defendants, which includes in particular the submission of a FRAND offer. The PANEL is of the opinion that insisting on a certain wording at this point does not promise any further insight into the actual intention of the user. Even an explanation that includes the wording of the decision of the High

Court of England and Wales ("a willing licensee must be one willing to take a FRAND licence on whatever terms are in fact FRAND") may prove to be mere lip service. The Federal Court of Justice also correctly states in this context that "the requirements to be made in detail [elude] a general definition" (BGH, judgment of 24 November 2020 - KZR 35/17 (FRAND-Einwand II), GRUR 2021, 585 para. 59). Against this background, the defendant's statements at the receipt of the negotiations appear sufficient to be regarded as a sufficiently serious prelude to further negotiations. In their email of 29 September 2019 (Annex VB F-1), the defendants made a sufficient declaration and named a specific contact person for further discussions ("As a willing licensee, OPPO intends to conduct constructive licence negotiation with you on a good faith basis, and I will be in charge of this matter."). The plaintiff did not object to this statement as insufficient, but took it as an opportunity to continue the negotiations.

to begin to clarify the modalities of a first meeting [REDACTED]
[REDACTED] to the defendants in the form of term sheets. There are no circumstances that would show that the defendant's statement was already insufficiently serious and unsuitable at this point to enter into concrete discussions.

Submission of an offer to conclude a FRAND licence by the applicant

208. The plaintiff then submitted the economic cornerstones of an offer in a Zoom meeting on 4 August 2020 (Annex VB-F 3, p. 4). In the presentation, the plaintiff not only limited itself to demanding prices that were not explained in detail, but also attempted to clarify its position as to why it considered the prices to be appropriate. This is considered in more detail below:

209. On slide 3, the plaintiff put the defendant's market activities in relation to the geographical coverage of the plaintiff's patent portfolio for, inter alia, the LTE standard and showed that, particularly in Asian countries and Europe, the plaintiff's patent protection and the defendant's market activity are opposed to each other.

210. Furthermore, the applicant has explained that it has at least [REDACTED] standard essential patent families, making it [REDACTED] of the top [REDACTED] holders of large portfolios relating to the LTE standard. [REDACTED] of the families had claims directed to terminal devices (ibid., slide 20). It also pointed out that [REDACTED] of the families had been evaluated before being included in a pool aimed at the automotive sector. In favour of the defendant, it based its calculations on [REDACTED] patent families.

211. The plaintiff also used a top-down analysis (Annex VB-F 3, slides 17 et seq.) to show how it derived its licence fees. For this purpose, it used the average sales price (ASP) of the defendant's products on the basis of the sales prices on the exemplary market in the UK and showed the ASPs it determined for five different models of the defendant. It then referred to three court decisions and derived from them that the aggregate royalty rate for LTE-SEPs was between 6 and 10% of the ASP for a mobile device (ibid. slide

19). Of this, it used the middle value (8%) and assumed an ASP of [REDACTED], which rather at the lower end of the sales prices found by the plaintiffs. When applying the system, the

On the one hand, according to the decision of the UK High Court in the Unwired Planet case [2017 EWHC 711 (Pat)], it arrives at a licence fee of EUR 1.5 million when [REDACTED] applying the system from the TCL v. Ericsson decision, 8:14-cv-00341-JVS_DFM to a fee from [REDACTED]. This justifies its Standard licence fee (Standard rate) for the "Major Markets [REDACTED] and "Other Markets" [REDACTED] and even more so their preferential licence rate (ICR= incentivised [REDACTED] compromised rate, [REDACTED]. In addition, the plaintiff has explained its ideas on the basis of a comparison with pool licence rates, although it has taken the view that pool rates are regularly significantly lower than bilaterally negotiated rates and can therefore only be used for comparisons to a limited extent. In addition, the plaintiff points out that the majority of TOP LTE patent holders, like the plaintiff, do not participate in pool licence models. Nevertheless, it argues that its idea also proved to be reasonable compared to the licence rates of the pool licensors.

212. With these statements, the plaintiff clearly set out its demands at an early stage and sufficiently plausibilised for the further negotiations why it believes it is entitled to submit a FRAND-compliant offer. If the defendants, as cooperating licence seekers, had still had questions, e.g. on the non-discriminatory nature of the offer, they should have asked them immediately or shortly afterwards.

213. The defendants, on the other hand, insist in their argumentation that these statements are not yet to be regarded as an initial offer because a written contractual offer is required. The court cannot agree with this view. What can be demanded of the SEP proprietor cannot be determined in a generalised, formalistic manner. The requirements for the behaviour of the patent proprietor and the behaviour of the user of the invention are mutually dependent. The yardstick for the examination is what a reasonable party interested in the successful conclusion of the negotiations in the interests of both parties would do to promote this goal at a certain stage of the negotiations (in this sense also BGH FRAND II, loc. cit., para. 59). At the beginning of the negotiations, it is not in line with customary business practice to directly each other with draft contracts ready to be signed as long as not even the central economic points have been clarified. Therefore, it is also not the behaviour of a patent user negotiating in good faith in the direction of a FRAND licence to nevertheless insist on this in a formalistic manner in its argumentation before the court. Rather, the SEP holder's offer should represent the constructive starting point further negotiations towards the conclusion of a FRAND licence agreement, because the individually appropriate contractual terms in complex patent licence agreements must be adapted to the respective economic framework conditions (Court of Appeal The Hague GRUR Int 2020, 174, 179 para. 4.34; in this sense also BGH loc. cit. FRAND II para. 70). Rather, it is sufficient if the SEP holder's offer allows the patent user to determine the essential economic framework conditions of an intended licence agreement.

and, if necessary, to respond to this with a different counter-offer. As a rule, this does not require a written contract offer that is differentiated in all secondary points and ready for signature. Rather, it is up to the patent user to request the submission of such a formal contractual offer if, contrary to customary practice, he wishes to receive it at this stage of the negotiations. The decisive factor is not the concept of an offer under contract law, but a concept of an offer that is to be understood economically in the context of European antitrust law. The defendants did not respond to these economic ideas of the plaintiff until 28 July 2021, almost a year later, and in the meantime focused on technical discussions and requested claim charts. The defendants did not draw any further conclusions from this requested technical material in the further course of the discussions. Rather, the defendants resorted to commissioning a private expert to carry out an ex-post analysis of the plaintiff's offers and to have him analyse the circumstances solely on the basis of the patents declared as standard-essential, but then reserved the right to make corrections it became apparent that the scope of the patents actually essential to the standard differed from the scope of those declared as such (KE para. 409). It therefore seems incomprehensible why the defendants focused for a long time in the negotiations on the technical analysis of repeatedly requested further claim charts in order to come to the conclusion in the court proceedings now initiated that "any qualitative assessment (of the standard-essential patents to be "actually" assumed) generally harbours the risk of an (unknown) error size" (KE para. 409). Rather, they would have been required to take a concrete position on the plaintiff's ideas at this stage and to raise objections, submit counter-proposals or raise economic issues to be clarified. Raising such questions by means of a private expert opinion only before the court cannot replace this obligation to co-operate.

214. It also had to be taken into account that the plaintiff submitted the offer on 22 June 2021 on the basis of a further comparison with the portfolios of three other TOP LTE patent portfolios.

and also attempted to show why, in her opinion, she was demanding appropriate licence rates (cf. Annex VB FC 5 pages 14 ff., see summary of the results of the analyses on slide 44). In addition, the plaintiff defined further key points for a licence agreement (cf. slide 46). By this time at the latest, the plaintiff had submitted the key points of an offer.

215. Then, on 22 April 2022, the plaintiff also submitted a lump-sum licence offer to the defendants by granting a lump-sum discount of [REDACTED] on its actual ideas in order to advance in the discussions.

and also explained this offer. Even at this early stage

The plaintiff pointed out its concerns about the ASPs and quantities used by the defendants in their calculations (see Annex VB-F 5 slides 6 and 7). At the same time, the plaintiff made it clear that it had no better information to make a blanket licence offer to the defendants than the information available from commercial services and databases for a fee. In addition, the plaintiff based its concerns on objective circumstances accessible to it. She explained that the information provided by the defendants in their

The ASP of [REDACTED] used in the calculations is in obvious contradiction to the publicly accessible sales prices on sales platforms and is also far below the overall average sales price of 4G-capable Android smartphones worldwide. With regard to the unit numbers stated by the defendants, the plaintiff argues that these figures also contradict the data that can be derived from the economic databases.

216. Nevertheless, in this presentation, the plaintiff referred to two of its own blanket licence agreements in order to demonstrate to the defendants that, in relation to these two licensees considered comparable by the plaintiff, their asking prices were far removed from the comparative licence rates. While the unnamed licensees X and Y namely [REDACTED]

[REDACTED] the offers made by the defendants were within the

merely [REDACTED]. In the opinion of the PANEL, the plaintiff did not have to provide the defendants with any more information at that time. In particular, under these circumstances, it did not have to submit the licence agreements with third parties used for comparison purposes.

217. The plaintiff then reduced this offer again on 28 June 2022 by [REDACTED] (see KAP FRAND 17) in order to take into account declines in sales due to the COVID pandemic and the war in Ukraine in the industry. It also checked the plausibility of the figures it had used for past use in the years [REDACTED]

218. On 15 September 2022, the plaintiff then submitted another proposal for a FRAND licence agreement to the defendants (Annex KAP FRAND 18a). In the proposal, the plaintiff criticised in its receipt that the defendants had still not provided any comprehensible information on their quantities. There was a lack of any information on the figures relating to the year [REDACTED]. Furthermore, the plaintiff objected that the defendant's proposal only covered the period [REDACTED] and thus past sales in the scope of [REDACTED] without any justification - despite the fact that [REDACTED] discussions had already been held between the parties. At the same time, the plaintiff complained that the defendant's position had remained unchanged since the counter-offer of 27 August 2021, which suffered from the above deficiencies.

219. Nevertheless, the plaintiff further reduced its offer across the board by [REDACTED] % [REDACTED] at [REDACTED] in order to make progress in the talks (see Annex KAP FRAND 18a slide 6). In explaining its positions, it again drew a comparison with the still unnamed settlement licences with companies X and Y. In addition, it referred to another publicly known benchmark, the conclusion of a multi-year worldwide licence agreement between InterDigital and Xiaomi, stating that according to the analyses of the business service Strategy Analytics, the market penetration and sales volumes of Xiaomi and Oppo were comparable. In addition, the plaintiff deduced that the unnamed

Company X, with which a licence agreement already existed, approximately [REDACTED] % of the agreed between InterDigital and X to the plaintiff (cf. ibid. slide 12). The plaintiff derived these figures from the so-called 10K report submitted by InterDigital, the annual submission of which is prescribed by the US Securities and Exchange Commission (SEC) in a standardised form. From this, the plaintiff derived the payments of

Xiaomi to InterDigital and applied this [REDACTED] as a factor and thus achieved to a quarterly payment of [REDACTED] [REDACTED] and therefore for a contract that

[REDACTED]

[REDACTED] At the same time, the plaintiff out, that their blanket licence offers of 22 April and 28 June 2022 were within this range, whereas the defendant's proposals did not even correspond to the settlement payments for one quarter (cf. ibid. slide 13).

220. In order to reach a target in the talks, the plaintiff then adjusted its offer again on 29 November 2022, i.e. also before the action was filed (Annex VB-F8). In doing so, the plaintiff referred to more recent decisions of Chinese courts, in particular the decision between Siemens and Huawei, and also adjusted the assumed ASP downwards as well as the sales figures projected for the future. The plaintiff adjusted its unit licence offer downwards by [REDACTED] % downwards (cf. slide 7 above) and also applied this adjustment to the blanket licence offer it had now submitted and deducted from the amount determined instead of [REDACTED] %, so that the last offer made before the action was filed

[REDACTED]

221. This offer thus represents the end point of the plaintiff's proposals on the way to a FRAND licence and will be examined in more detail below. In this context, the argumentation that the extent of the concession in relation to the initially expressed ideas

Although the SEP holder may not be obliged to disclose its own sales data in full, a licence seeker negotiating in good faith can nevertheless be expected to make such data accessible for certain periods of time that make it comprehensible to the SEP holder as a whole why the licence seeker feels entitled to calculate on its deviating basis in order to check the plausibility of its own objections to the figures used by the other party. This was not done in the present case, even after the plaintiff rejected the defendant's counter-offer, contrary to what the PANEL considers to be clear ECJ case law in this respect. As the plaintiff rightly argues, the patent user must provide information after the rejection of its counter-offer in a form that enables the SEP holder to assess whether the security to be provided is sufficient and, in particular, covers an insolvency risk (ECJ Huawei/ZTE para. 67). The defendants did not provide such information at any time. Nor can the defendants refer to the fact that the plaintiff also referred to general economic information, specifically IDC data, with regard to the figures on which the settlement licence agreements submitted by its side are based.

has. In this respect, the plaintiff is entitled to [REDACTED]

[REDACTED] the patent holder participated in the negotiations in good faith and, therefore, to allow generally available economic data to suffice for a price approximation in these negotiations. As a patent infringer who has now been dragging out the negotiations for five years, the defendants are not entitled to be treated equally with a constructive negotiating party who is seriously interested in taking a licence and with the negotiations can be brought to a swift conclusion.

223. Moreover, the defendants cannot now justify their lack of constructive negotiation before the action was brought ex post by subjecting the factual material now available to a private expert assessment

and derive a wealth of objections from this. It is insufficient to substantiate the objections only in the court proceedings by means of commissioned expert opinions, which, moreover, are only partially explained in the main pleadings with regard to their systematics. Rather, it is advisable to present the objections in close temporal connection to the presentation of the opponent's calculation approach and then, without the need for judicial assistance, to give the opponent the opportunity to overcome the existing discrepancies by means of suitable negotiation proposals on the way to a FRAND licence.

224. Even if the now disclosed settlement licences are included in the assessment of whether the plaintiff must be prevented from enforcing the asserted injunctive relief and the other forward-looking claims under the patent for antitrust reasons, the plaintiff's offer described above does not prove to be FRAND-inconsistent, but rather FRAND-compliant. In this regard, the plaintiff must first agree that FRAND is a corridor. This view now appears to be generally recognised. However, there is not just one FRAND offer, but several forms of a licence agreement within the bandwidth, all of which can satisfy FRAND criteria. Therefore, the plaintiff also has room for manoeuvre within this range. For antitrust reasons, it is not obliged to submit the cheapest offer that is still within the corridor. Nor is it obliged to use a calculation method favoured by the other party. From the point of view of reasonableness, it may only not deviate in a way that is no longer justifiable from the circumstances used as a benchmark, whether these circumstances lie in its own comparative licences, which regularly have the strongest indicative effect, or in licence agreement structures used for comparison purposes, which have been discussed in court decisions, for example, and which can be applied to the specific circumstances.

225. In the present case, the plaintiff has submitted three comparative licence agreements, whereby it considers one agreement to be only partially comparable. In doing so, it has used the comparative licence terms for the purpose of deriving a comparative figure under

Using the same system, the defendant "unpacked" the LTE devices and applied the same factors to them in order to relate the derived unit licence rate to the offer to the defendants (see Annexes KAP FRAND 23, 25 and 28). To this end it specified the sales period under consideration and the number of LTE devices sold (based on business information data) and reduced these by the plaintiff's scaled sales. It then calculated a unit licence rate from the blanket licence. To this, the plaintiff applied various factors to account for the differences between the comparator licence and the ratios applicable to the defendants.

226. The decisive factor here when considering the first settlement agreement is a [REDACTED] % mark-up for transaction costs saved was recognised because the Comparison licences in each [REDACTED]. The company was therefore spared corresponding double transaction costs. In addition, a premium of [REDACTED] % was applied because

would have been justified to grant a discount to the quickly and purposefully negotiating third-party licence agreement partners due to the quick conclusion of the transaction and due to the large quantities covered, which the defendants would not have deserved. Finally, a mark-up of [REDACTED] % was applied in order to reflect the risks associated with blanket licensing, according to the plaintiff.

227. The same procedure was followed for another settlement agreement, whereby here [REDACTED] due to [REDACTED] existing [REDACTED] other [REDACTED] supply relationships with the licence agreement partner in question [REDACTED] been granted a price advantage of [REDACTED] %, which the defendants did not earn, as well as a [REDACTED] % discount for large quantities. The surcharge for the blanket licence was set at [REDACTED] %, [REDACTED] the surcharge for dual licensing is again [REDACTED] %.

228. The plaintiff has shown that the unit licence rates - not yet increased by the mark-ups it considers justified [REDACTED] the unit licence rate for the third-party licence agreement, which the PANEL considered to be comparable only to a [REDACTED] extent. Applying the licence rate proposed by the plaintiff

adjustment factors, which they consider to be justified and which are intended to establish comparability, result in unit licence rates of [REDACTED]

229. Against this background, the PANEL is of the opinion that the offered unit licence rate of [REDACTED], which the plaintiff had last offered when the transaction was concluded quickly, is FRAND-compliant because - depending on the point of view - it is within the range of the comparable licences or differs from the [REDACTED]. The defendant's use of the above-mentioned range does not in any case indicate abuse. Furthermore, the rate of [REDACTED] in the defendant's most important market in China and the "rest of the world", which is by far the largest share of their own counter-offer [REDACTED]. The rate of [REDACTED] applied in view of the higher ASP in the major markets was also unobjectionable. In view of these circumstances, it was not necessary in the present case to subject the adjustment factors applied by the plaintiff to a further detailed assessment.

230. If the licence rates offered by the defendants for the conclusion of a worldwide 4G licence in the range from [REDACTED] to a maximum of [REDACTED] are set in relation to this, it becomes apparent that these figures on which the counter-offer is based are only a fraction of the unit licence rates resulting from the settlement licence agreements, even if the adjustment factors of the plaintiff objected to by the defendants are not taken into account. Therefore, it is not necessary in the present case to decide whether the adjustment factors used to establish comparability from the plaintiff's point of view are viable or not. These rates offered by the defendants are far outside the range derived the plaintiff on the basis of the comparative licences disclosed in the proceedings and on the basis of the further market information and court decisions referred to in the offers described above. The defendant's counteroffer therefore does not prove to be FRAND-compliant.

231. The decisive circumstance for this discrepancy is already the defendants' approach, which is to be assessed as non-FRAND-compliant. On the one hand, with reference to their expert opinion, they insist on an ad valorem approach that takes better account of the fact that their devices do not require all releases of the LTE standard, while on the other hand - as the plaintiff undisputedly stated at the hearing - they have never asked for a licence that covers only some of the LTE releases. They have always aimed for an LTE licence that covers all releases of the standard. In addition, the defendants' approach, with which they want to compensate for the past use to be covered by the licence agreement, i.e. the acts of use carried out in the past without paying for the licence, cannot be justified. The defendants could not even invoke conduct by the plaintiff in breach of antitrust law if the plaintiff had been prepared to pay a lower lump sum for past use to a third-party licence partner working purposefully towards the conclusion of a transaction if this would have enabled the licence agreement applicable for the future to be drafted quickly and by mutual agreement. It is not justifiable that the defendants not even prepared to cover the full period since the start of negotiations with the plaintiff in their counter-offers. In their counter-offer of 17 March 2022, for example, they only wanted to cover the period from [REDACTED] to [REDACTED], although negotiations had already [REDACTED] begun in 2019 (cf. KE para. 564 et seq.). This continued in the counter-offer of 29 July 2022 (VB-F2, p. 6), and they did not address the plaintiff's objections in this regard in their offer of 15 September 2022 (cf. *ibid.*, para. 4 above). Even in the counter-offer of 25 October 2022, the past is still not fully addressed. The plaintiff rightly points out that the defendants contradict their own party expert in this respect, who also includes acts of use for 2019 (Reply Part II FRAND para. 575).

232. Moreover, the defendants cannot be reversed when considering the settlement licence agreement with [REDACTED] the both parties as the basis for settlement discussed at the hearing, sales up to six years prior to the conclusion [REDACTED] of the contract (but according to Duplik FRAND para. 196 with reference to the party opinion (Annex VB-F39, section 4.1)), in that

IDC data had been used for the previous six years, resulting in significantly lower unit licence fees of ██████████ for 4G multimode devices (Annex VB-F39, Figure 2 after para. ██████████ compared to ██████████ according to plaintiff's calculations. The unit licence fees applied by the plaintiff are also based on the IDC data and were not objected to by the defendants. Only the periods for which they were collected differ. This naturally leads to the fact that the ██████████ licence rate - in particular in the case of the market participants who have always been important in this period. The defendants' calculations are based on a longer period than they themselves were willing to take into account, resulting in a significantly lower unit licence rate, which the defendants believe they can hold against the plaintiff. The same applies to the calculations of the defendant's expert with regard to past use in the settlement licence agreement with ██████████ (cf. para. 38: 6 years past use). If one were to recognise this system, this would privilege a user who engages in hold-out. The defendants apply a double standard without sufficient grounds.

233. But also in other respects, the defendants did not behave in good faith as required by the practices of a user seriously interested in taking a licence. The case law of the ECJ is to be understood correctly with the plaintiff as meaning that the information to be provided after rejection of the counter-offer should allow the patent proprietor to gain an overview of the scope of the actual acts of use. This is the only way to enable him to check whether the security offered is sufficient. The user must disclose the extent of his acts of use. If the patent user wishes to obtain a licence in return for a lump sum, he is also regularly required to disclose sales figures to the patent proprietor from this point of view so that the latter can assess the extent of the acts of use that are to be licensed in return for a lump sum payment.

234. Furthermore, the security offered by the defendants is also insufficient for the reasons put forward by the plaintiff. Due to the wording in the deed of guarantee, a total default is to be feared in the event of insolvency. This is because neither can an insolvency administrator give his consent for the guarantee to be drawn in the event of insufficient assets, nor can it be expected with sufficient certainty that a final judicial clarification can still be brought about in this case, because insolvency regularly brings the proceedings to a standstill in this respect (cf. only Rule 311.1 RoP).

235. Finally, the procedural conduct of the defendants must also be characterised as contrary to good faith, as it is characterised by self-contradictory conduct. In this respect, the defendants wanted to contest the jurisdiction of the Unified Patent Court with their objection until the oral hearing. This is contradicted by the fact that they then nevertheless requested the determination of a FRAND rate by way of a FRAND counterclaim. The defendants were only able to refrain from pursuing the opposition - albeit under sharp protest - following a firm indication from the panel. Furthermore, the defendants' applications in the context of the FRAND counterclaim were initially aimed solely at having the panel determine a territorially limited licence rate, which was to be limited to the PANEL contracting states, the USA and Japan. This is in contradiction to its own argumentation that FRAND is solely the determination of a global FRAND rate. However, this contradiction was also only responded to upon judicial notice and at least the new main claim of the FRAND counterclaim was directed towards a global lump-sum licence payment. However, the defendants continued to adhere to the territorially limited determination approach in the context of the alternative claims. According to the first alternative claim, the main part of the licence is to be determined by the Beijing Intellectual Property Court and only a very limited lump sum is to be paid for the previously named countries in view of the acts of use. In this respect, in the opinion of the PANEL, it is also not in line with the approach of a user working in good faith towards the conclusion of a licence agreement to make the already complex situation of a licence agreement more complex.

The fact that FRAND rate determination proceedings for sub-regions of the world are brought before various courts around the world, between whose states there are no treaties that stipulate a priority order between the courts seised, further complicates the matter. This is because the provision cannot be determined with a clear territorial distinction. Rather, there is a considerable risk that the respective courts involved will pursue different approaches when determining the FRAND rate. This in turn harbours the risk of contradictory rulings, meaning that appeals be expected to be pursued in the various jurisdictions. This is not conducive to the speedy conclusion of global disputes. In addition to the court in Beijing and the UPC Agreement, the defendants' exclusive licence holder in Italy has also recently initiated determination proceedings limited to Italy before the national court in Milan. The defendants also emphasise the determination proceedings between the plaintiff and the Xiaomi group of companies before the High Court of England Wales. The conflict is particularly apparent here because Italy is also a contracting state of the UPCA and the present action explicitly also covers acts of use in Italy.

FRAND counterclaim

236. The defendant's FRAND counterclaim is admissible, but had to be dismissed as unfounded.

Responsibility of the UPC Agreement:

237. The UPC Agreement has jurisdiction over the counterclaim filed by the defendants together with the statement of defence, which is aimed at determining a FRAND licence. Jurisdiction follows from Art. 32(1)(a) UPCA. Accordingly, the court has exclusive jurisdiction over actions for actual or threatened infringement of patents and related defences, including counterclaims relating to licences. This does not only cover

disputes relating to existing licences to a patent, but also actions aimed at the conclusion of a licence.

238. The fact that the claim pursued by the defendants in the present case - in addition to contract law based on the plaintiff's ETSI FRAND Declaration - is derived European antitrust law does not change this. This is because the Unified Patent Court is a court common to the Contracting Member States and is therefore subject to the same obligations under Union law as any national court of the Contracting Member States, Art. 1 UPCA. court applies Union law in full and respects its primacy (Art. 20 UPCA) and bases its decisions on this (Art. 24(1)(a) UPCA). This also includes the mandatory application of EU antitrust law, in particular Art. 102 TFEU.

239. In the present case, the defendants derive their claim to a FRAND licence on the one hand from contractual principles, which they see in the ETSI FRAND Declaration, and on the other hand from Art. 102 TFEU. Even if one were to assume that this was a claim based on Art. 102 TFEU and with which the infringer demands that the SEP holder refrain from abusing its dominant market position by refusing to grant it a FRAND licence, this does not change the UPC Agreement's jurisdiction. This is because, in essence, the claim is aimed at defending against the monopoly right conferred by the state, the granted patent, and the powers derived from it, the injunctive relief and the further future claims for removal and destruction, by arguing, on the basis of the generally recognised legal principle of good faith, that there is a corresponding claim for performance under antitrust law which can be invoked against the exercise of the powers under patent law. The UPC Agreement's contracting member states were of this connection when the UPC Agreement was created and the associated transfer of national judicial sovereignty. The connection between patent law and antitrust law is in any case inherent to the patent and indissoluble. Due to the obligations of the member states under European law

and thus also the UPC Agreement, the task assigned to the UPC Agreement is the same as that of the national courts when dealing with patent disputes. Here, the national courts decide on both the patent law dimension and the inherent antitrust law dimension - due to the nature of patent law as an exclusive right. This is also evident from the fact that before national courts, for example in Germany or the Netherlands, the national patent litigation chambers regularly also decide on the antitrust aspects of the case and even the German Federal Court of Justice has formally decided SEP cases through the antitrust senate, but a member of the patent senate was always appointed to report on SEP cases in order to bring in the necessary patent law expertise. Therefore, a reference to the fact in national proceedings a panel responsible for antitrust law has formally ruled on SEP cases on the basis of the corresponding provisions of a business allocation plan drawn up by the Court Presidium would be substantively meaningless in the matter.

240. Accordingly, Advocate General Wathelet has already stated in his Opinion on Case C-170/13 Huawei v ZTE that, against the background of the obligations under European law, it cannot be held against the alleged patent infringer if it demands that FRAND conditions be set by a court or arbitration tribunal (see Opinion of Advocate General Melchior Wathelet of 20 November 2014 Case C-170/13 para. 93: "If no negotiations have been entered into or if they have remained unsuccessful, the conduct of the alleged patent infringer cannot, moreover, be regarded as hesitant or not serious. November 2014 Case C-170/13 para. 93: "Moreover, where no negotiations have been entered into or where they have been unsuccessful, the conduct of the alleged infringer cannot be regarded as dilatory or not serious if the latter requests that those terms be determined by a court or an arbitral tribunal."). The Convention does not provide any indication that the Member States, in transferring judicial sovereignty to the UPC Agreement, contrary to the requirements of European law, would undermine the power of cognizance of the common court, which also replaces the national courts, and would not allow the uniform decision on patent law to be taken by the UPC Agreement.

issues on the one hand and the antitrust issues on the other. If the antitrust claim for the grant of a licence on FRAND terms can be raised as an objection to the patent claims concerned, there is no reason not to regard counterclaims based on this as counterclaims within the meaning of Art. 32(1)(a) UPCA.

241. In this respect, it should also be noted that the UPC Agreement already exclusive jurisdiction for SEP disputes that have their origin in a European patent with unitary effect. The same applies to European bundle patents that are not the subject of an opt-out after the expiry of the transitional provision pursuant to Art. 83 UPCA. A national court would therefore have no jurisdiction for these cases. If, for example, an antitrust claim for a FRAND licence were to be asserted before a national court and the preliminary question of the antitrust examination is a question of patent law - such as whether the teaching of the patent in suit is actually essential for a standard and thus whether a monopoly position exists due to its standard essentiality - this question would have to be clarified by the UPC Agreement. However, since the UPC Agreement would, in turn, be required to take into account any restriction under antitrust law when deciding whether an application for an injunction can be granted, the indissolubility of the question of patent and antitrust law becomes apparent. The same would apply if the patent proprietor were to file only a limited application for an injunction before the UPC Agreement, making the enforceability of the injunction as a condition to the unrestricted injunction subject to the condition that the patent user refuses to comply with a FRAND provision assigned to the court by refusing to cooperate as required for the implementation of the FRAND licence agreement determined by the court.

Unfoundedness of the defendant's counterclaims

242. However, the defendant's applications are not well-founded as filed.

243. The main claim must be dismissed because the plaintiff cannot be obliged by the court to accept the defendants' FRAND-inconsistent offer of 17 July 2024 pursuant to Annex VB-FC 14. As explained above, the lump sum licence fee submitted by the defendants in the offer to conclude the contract is not FRAND-compliant within the meaning of the case law of the ECJ, if only because the lump sum licence fee offered was not calculated on the basis of the defendants' own acts of use. The defendants persistently do not disclose the extent of actual use, but calculate what they consider to be an appropriate global lump sum licence solely on the basis of the IDC data disputed by the plaintiff. As explained in detail above, this is insufficient.

244. For the same reasons, auxiliary request I.2, which conversely sought to order the plaintiff to submit the same offer to the defendants, was also to be dismissed.

245. The further auxiliary request I.3 was also to be rejected. The application is aimed at ordering the applicant to submit a licence agreement offer with the content according to Annex VB-FC16. The plaintiff is not obliged to do so because, on the one hand, the lump sum licence amount offered for the acts of use in the EPC contracting states, Japan and the USA was again only calculated on the basis of the IDC data, but not on the basis of its own disclosed acts of use. Moreover, it is not in line with the customary business practice to have the main economic part of the licence fee determined by another court, in this case the Beijing Intellectual Property Court. This means that the key points of the contract are still open on the one hand, and on the other hand, both parties ultimately agree in their arguments that only a comprehensive dispute resolution through a global FRAND rate determination is in line with customary practice. The defendants have also not put forward any arguments that could nevertheless justify a partial determination of the licence rate only for certain global regions. The mere reference to the greater local proximity of a court to the respective submarket is not sufficient for this.

sufficient. The calculation on the basis of the IDC data is also flawed by the other alternative applications submitted within the alternative application.

246. Insofar as the defendants request, in the alternative to the applications of application group I with application group II.1, to make findings on a claim to a licence and its amount in the territory of the EPC contracting states, the application was to be dismissed for the simple reason that a provision limited to the EPC territory does not meet FRAND criteria (see above).

247. Insofar as the defendants further with the alternative claim II.2. that the defendants "subject to the existence of a FRAND commitment" to again pay a flat licence rate limited solely to the EPC contracting states, the application had to be dismissed for the same reasons as application II.1.

248. The alternative application under claim II.3, to require the applicant to cooperate fully to bring about a FRAND licence on the terms set by your court, is already too indefinite and therefore not grantable as an unenforceable application.

249. The further auxiliary application group III. was already not grantable because the defendants have no need for legal protection in the requested abstract findings. The defendants themselves argue that they are entitled to a FRAND licence. They were required to assert this with suitable groups of applications, which they did not succeed in doing. The defendants have no noteworthy legal interest in further abstract findings, such as those pursued with the present group of applications, since they have not yet behaved in accordance with the requirements of the ECJ's case law, as explained above. It can therefore be left open in the present case whether a determination of a specific FRAND licence rate by the court - even without a FRAND counterclaim by the implementer - can be considered, for example, if both parties have each submitted a (counter)offer within the FRAND corridor and then do not, as contemplated by the ECJ, focus on overcoming the remaining FRAND corridor.

differences by a third party (cf. ECJ loc. cit. para. 68). Moreover, application III.1(e) again suffers from the fact that the plaintiff is to be ordered to submit an offer limited to the EP territory only, although both parties agree that only a global licence will finally end their disputes.

250. The further groups of claims asserted in the alternative, which were the subject of the counterclaim of 22 December 2023, must be dismissed for the same reasons as auxiliary claim group III.1. Mere declarations are requested (application (i), (iii), (vi), (vii), (viii), (ix)) or the applications are too vague (application (ii), (v)) or, again in accordance with the grounds of the counterclaim, relate only to the EP territory (application (ii), (iv), (v), (x)). This is because the defendants did not switch to a global licence regime until the explicit reference was made by order of the court.

Applications by the applicant in the context of the FRAND counterclaim

251. The plaintiff's applications "in the context of the counterclaim" were subject to the condition that the defendants' counterclaims were not dismissed and the defendants behaved like parties willing to grant a licence in the negotiations with the plaintiff that were the subject of the dispute. This intra-procedural condition did not materialise.

Value of the claim

252. The ruling body sets the amount in dispute - in settlement of the application for review filed against the judge-rapporteur's order pursuant to Rule 333 PANEL - at over € 50 million. At the hearing, the parties considered an amount of € 25 million to be appropriate. However, it must be seen in the present case that the plaintiff's applications pursued in the context of the FRAND counterclaim are aimed at enforcing a lump sum licence of US\$ [REDACTED] [REDACTED] the defendant to have to pay only US\$ [REDACTED] [REDACTED] and

to avert the obligation to pay the additional amount claimed by the plaintiff. Since the parties [REDACTED] submitted the global licence dispute for decision through their mutual applications in the FRAND counterclaim, the value in dispute could not be determined with regard to the patent in suit only. Accordingly, only the maximum amount in dispute provided for in the UPC Agreement could be determined.

DECISION

A.

I. It is established that the defendant has infringed European Patent No. 2 568 724 B1.

II. The defendants are condemned,

t h e r e a r e t h e m o s t ,

1. Radio communication devices

which can be configured to transmit a reference signal with a transmission bandwidth in a given system bandwidth, wherein both ends of the same [system bandwidth] are assigned control channels and the transmission bandwidth is between the control channels, or to transmit reference signals with a low bandwidth with frequency hopping, and the radio communication devices comprise: an assigning unit configured to assign the reference signals to frequency resources; a transmitting unit configured to transmit the assigned reference signals,

in the Federal Republic of Germany, the French Republic, the Italian Republic, the Kingdom of the Netherlands and the Kingdom of Sweden, or to place them on the market or use them, or to import or possess them for these purposes,

where

the transmission bandwidth varies in the given system bandwidth, and the allocation unit allocates the reference signals so that the reference signals are allocated to frequency resources each of which has the small bandwidth which is invariable irrespective of changes in the transmission bandwidth, where the frequency resources corresponding to the

change in the transmission bandwidth is evenly distributed in a frequency band of the transmission bandwidth.

(direct infringement of device claim 1)

2. Devices suitable for performing a radio communication method which can be configured to transmit a reference signal with a transmission bandwidth in a given system bandwidth, both ends of the same control channels being assigned and the transmission bandwidth being between the control channels, or to transmit reference signals with a low bandwidth with frequency hopping,

in the Federal Republic of Germany, the French Republic, the Italian Republic, the Kingdom of the Netherlands and the Kingdom of Sweden,

wherein the radio communication method comprises the following steps:

assigning the reference signals to frequency resources; and

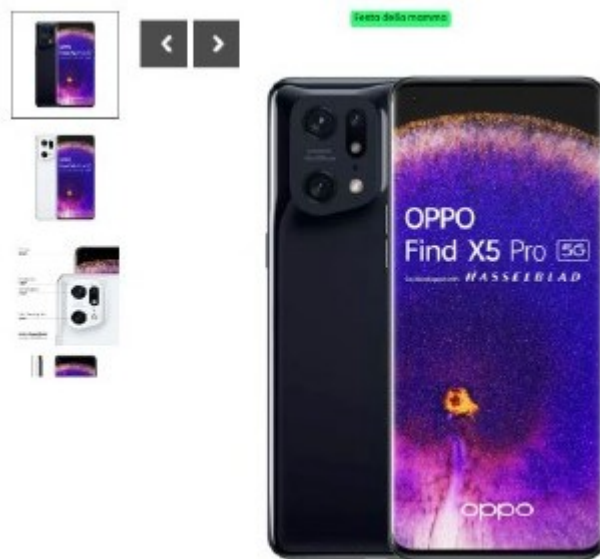
Sending the assigned reference signals,

characterised in that the transmission bandwidth in the given system bandwidth varies, and

the reference signals are allocated frequency resources, each of which has the small bandwidth which is invariable regardless of changes in the transmission bandwidth, the frequency resources being distributed evenly in a frequency band of the transmission bandwidth in accordance with the change in the transmission bandwidth.

(indirect infringement of procedural claim 13)

Devices in the aforementioned sense include, in particular, 4G-capable smartphones such as the OPPO Find X5 Pro



and 4G-enabled smartwatches, such as the 4G-enabled smartwatch



OPPO Watch 46 mm LTE - Smartwatch (AMOLED Display, GPS, Bluetooth 4.2, Wear OS by Google, VIOC Schnellladefunktion, 5 ATM), Schwarz
 Besuche den OPPO-Store
 4.1 ★★★★★ - 86 Sternbewertungen

411 €

Vorauszahlung der Importgebühren erwünscht
 Preisangaben inkl. USt. Abhängig von der Lieferadresse kann die USt. an der Kasse variieren. Weitere Informationen

Nutzen Sie die Monatsrechnung und bezahlen Sie erst im nächsten Monat [Mehr erfahren](#)

Größe: 46mm
 Farbe: Schwarz

Marke: OPPO
 Modellname: Watch 46 mm (LTE)
 Stil: smart
 Farbe: Schwarz
 Besonderes Merkmal: GPS

Form: Quadratisch

▼ Mehr anzeigen

Info zu diesem Artikel

- Das Dual-Barre-Display ist einzigartig und zeigt Ihre Inhalte auf jedem Bildschirm bequem anzeigen können.
- Die Oppo Watch mit 46 mm kann wasserdicht Regen oder Wasser

In the event of any infringement of the orders under Clause 1 and/or Clause 2, the defendants shall pay a penalty payment of EUR 1,000 each.

III. The defendants are ordered to pay, at their own expense

1. to recall the products mentioned under No. II. from the distribution channels;

2. to permanently remove the products mentioned under No. II. from the distribution channels;
3. to destroy the products mentioned under No. II;

IV. The defendants are condemned,

1. to provide the plaintiff, in a list structured for each month of a calendar year and according to infringing products in electronic form, which can be analysed with the aid of a computer, from 17 December 2014, with information on the products mentioned under No. II. on

- a) the origin and distribution channels of the products mentioned under No. II;
- b) the quantities delivered, received or ordered and the prices paid for the products mentioned under No. II;
- c) the identity of all third parties involved in the distribution of the products mentioned under No. II;

2. to disclose to the plaintiff its accounts to prove the information provided pursuant to No. IV.1. plus the information on the profit realised by providing the following documents for each month of a calendar year and for each infringing product in electronic form which can be analysed with the aid of a computer:

- a) Invoices - or, if these are not available, delivery notes - of the individual deliveries, itemising the respective deliveries by offer quantities, offer periods, prices of the goods offered and type designations as well as names and addresses of the commercial recipients of the sales offers for all products sold or otherwise disposed of;
- b) Evidence of the advertising carried out including evidence of these advertising activities, breaking down the advertising carried out by advertising medium, its distribution, the distribution period and the distribution area;
- c) Proof of costs, with a breakdown of costs by individual cost factors and the profits realised;
- d) Invoices - or, if these are not available, delivery notes - and the corresponding statements of all

costs incurred, on which the defendants rely calculating their profits;

the accuracy of which is audited and confirmed by a sworn auditor appointed by the plaintiff at the defendant's expense, whereby the auditor is obliged to maintain confidentiality vis-à-vis the plaintiff beyond the above-mentioned information;

V. It is established that the defendants are jointly and severally liable to compensate the plaintiff for all damages incurred by Panasonic Intellectual Property Corporation of America as a result of actions pursuant to No. II. since 17 December 2014 and which the plaintiff has incurred since 29 July 2016 and will incur in the future.

VI. The defendants are ordered jointly and severally to pay the plaintiff an amount of EUR 250,000.00 as provisional damages;

VII. In all other respects, the action for infringement is dismissed.

- B. The action for annulment is dismissed.
- C. The FRAND counterclaim is dismissed.
- D. Orders the defendants to pay the costs.
- E. The amount in dispute is set at over 50 million€ .
- F. Orders are not enforceable until

with regard to A.II.1, A.II.2, A.III. (omission/recall/removal/destruction)

- after the plaintiff has provided security in favour of the defendant in the form of a deposit in the amount of € 10 million or a written, irrevocable, unconditional and unlimited guarantee of € 10 million from a credit institution authorised to do business in the territory of a Member State of the European Union;
- after the plaintiff has notified the court which part of the Orders it intends to enforce and has submitted a certified translation of the Orders into the official language of the Contracting Member State in which enforcement is to take place, and after the defendants have been served with the notification and the (respective) certified translation.

Mannheim on 22 November 2024

NAMES AND SIGNATURES

Presiding judge Prof Dr Tochtermann	Peter Michael Dr Tochtermann Digital signed by Peter Michael Dr Tochtermann Date: 2024.11.19 17:40:28 +01'00'
Legally qualified judge Böttcher	Dirk Andreas Böttcher Digital signed by Dirk Andreas Böttcher Date: 2024.11.19 19:10:09 +01'00'
Legally qualified judge Brinkman	Edger Frank BRINKMAN Digitally signed by Edger Frank BRINKMAN Date: 2024.11.21 10:02:23 -03'00'
Technically qualified judge Loibner	Klaus Loibner Digitally signed by Klaus Loibner Date: 2024.11.19 21:23:05 +01'00'
For the Deputy Registrar: Kranz, Clerk LK Mannheim	ANDREAS. MICHAEL wreath Digitally signed from ANDREAS MICHAEL Kranz Date: 2024.11.21 14:58:52 +01'00'

INFORMATION ON THE APPOINTMENT:

An appeal against this decision may be lodged with the Court of Appeal within two months of service of the decision by any party whose applications were unsuccessful in whole or in part (Art. 73(1) UPCA, R. 220.1(a), 224.1(a) RoP).

INFORMATION ON ENFORCEMENT (ART. 82 EPGÜ, ART. 37 PARA. 2 EPGS, R. 118.8, 158.2, 354, 355.4 ROP):

A certified copy of the enforceable decision is issued by the Deputy Registrar on application by the enforcing party, R. 69 RegR.

This decision was announced in open court on 22 November 2024. Presiding judge Prof Dr

Tochtermann

Peter
Michael Dr
Tochterma
nn

Digitally signed by
Peter Michael Dr
Tochtermann
Date: 2024.11.22
10:07:20 +01'00'

