

**Order**  
**of the Court of First Instance of the Unified Patent Court**  
**issued on 24 July 2025**  
**concerning EP 3 905 730**  
**value in dispute in the case of a FRAND counterclaim**

**CLAIMANT:**

**ZTE Corporation**

ZTE Plaza, Keji Road South, Hi-Tech Industrial Park,  
Nanshan District - 518057 - Shenzhen, Guangdong - CN

Represented by Dr  
Thomas Lynker

**DEFENDANTS**

- 1) **Samsung Electronics Co., Ltd.** Represented by Dr Jan  
(FRAND Counter-Claimant) 129 Samsung-Ro, Ebersohl  
Yeongtong-Gu, - 16677 - Suwon City, Gyeonggi-  
Do - KR
- 2) **Samsung Electronics GmbH** Represented by Dr Jan  
Frankfurter Straße 2 - 65760 - Eschborn - DE Ebersohl
- 3) **Samsung Electronics France** Represented by Dr Jan  
6 Rue Fructidor, CS 2003 - 93484 - Saint-Ouen Ebersohl  
Cedex - FR

- 4) **Samsung Electronics Italia S.p.A** Represented by Dr Jan  
Via Mike Bongiorno 9 - 20124 - Milano - IT Ebersohl
- 5) **Samsung Electronics Benelux B.V.** Represented by Dr Jan  
Evert Van De Beekstraat 310 - 1118 CX - Ebersohl  
Schiphol - NL
- 6) **Samsung Electronics Romania S.R.L.** Represented by Dr Jan  
Platinum Business and Convention Center, sos. Ebersohl  
București-Ploiești, nr. 172-176, Clădirea A, etaj  
5, sector 1 - 013686 - Bucharest - RO

PATENT AT ISSUE:

European patent EP 3 905 730

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This order was issued by the legally qualified judge Böttcher acting as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Patent infringement action with FRAND counterclaim – value in dispute

REASONS FOR THE ORDER:

Reference is made to the order of 20 June 2025. After having been heard, the Defendants did not bring forward any argument which justifies a deviating result at this stage.

First, contrary to Defendants, a FRAND counterclaim is not a mere defence to the infringement action and its value in dispute therefore is not limited to the value in dispute of the infringement action. Rather, a FRAND counterclaim – at least if it is not restricted to a license for the patent-in-suit only - expands the subject-matter and thus the value in dispute of the court proceedings beyond the infringement action. The fact that the Regional Court of Munich may require a defendant to file a FRAND counterclaim in order not to be regarded as unwilling licensee is not decisive in proceedings before the UPC. Moreover, even if a defendant were obliged to file a FRAND counterclaim in order not to risk being considered to be unwilling to obtain a FRAND

license, this would not change the fact that a FRAND counterclaim – at least before the UPC – expands the subject matter of the court proceedings to a subject matter previously not contained in the infringement action. Similarly, the objective interest of the counterclaimant – especially if the counterclaim is not restricted to a license for the patent-in-suit only – goes beyond fending-off the infringement action.

The fact that a FRAND counterclaim is not expressly listed in the fee basis does not justify the conclusion that a FRAND counterclaim is free of court fees. There is no indication that any type of action or counterclaim is intended to be exempt from court fees. At the very least, an additional action or counterclaim in pending court proceedings increases the value in dispute of those proceedings.

Second, the fee limit for a counterclaim of revocation is not applicable *mutatis mutantis* to a FRAND counterclaim.

The reason for limiting the fees for a counterclaim for revocation, which only relates to court fees, is not to avoid that, without the limitation of the court fees, a defendant might be deterred from filing a counterclaim for revocation, which is required to assert the invalidity of the patent-in-suit, just because of the court fees. If this were the case, representatives' costs, or at least reimbursable representatives' costs, which significantly exceed the amount of court fees, would also have been limited. Rather, the reason for limiting the restriction to court fees alone seems to be that not all UPC Member States impose fees on (counter)claims for revocation and, possibly, that the defendant also pursues the public interest in the revocation of an invalid patent by filing a counterclaim for revocation, which might justify granting him preferential treatment with regard to court fees. In any case, the situation with regard to a counterclaim for revocation is not comparable to a FRAND counterclaim because the defendant can instead rely on the pure FRAND objection within the infringement proceedings. Moreover, even if a SEP implementer had to file an action for the grant of a FRAND licence in order to be considered an implementer willing to obtain a licence if the patent proprietor refuses to grant him a FRAND license, this would still have to apply regardless of whether or not the implementer was sued by the patent proprietor for infringement. Against this backdrop, a FRAND counterclaim in order to demonstrate a willingness to obtain a FRAND license is not prompted by the defence against a patent infringement action.

Moreover, taking the scope of the license sought and the parties' different views on the licence fee into account does not conflict with a valuation method that is "as simple as practically possible" (cf. section I.1 of the guidelines of the Administrative Committee for the determination of the court fees and the recoverable costs of the successful party). Rather, the value is usually determined without difficulty from the different licence fees that the parties consider to be FRAND.

Since the Defendant 1, by filing a FRAND counterclaim that is not limited to the patent-in-suit, is seeking a licence agreement that goes beyond the patent-in-suit and that corresponds to its understanding of FRAND, it is not disadvantaged by having to pay fees that exceed the fees for the infringement action. Rather, if successful, Defendant 1 will receive more than if it merely defended itself against the infringement action. For the same reason, higher fees than those for an infringement action are not disproportionate and not unfair.

#### ORDER:

The order of 20 June 2025 is confirmed and remains in force.

ORDER DETAILS

Order no. ORD\_33617/2025 in ACTION NUMBER: ACT\_68656/2024

UPC number: UPC\_CFI\_850/2024

Action type: Infringement Action

Related proceeding no. Application No.: 29513/2025

Application Type: Procedural Order

Related to:

Order no. ORD\_29513/2025 in ACTION NUMBER: ACT\_68656/2024

UPC number: UPC\_CFI\_850/2024

Action type: Infringement Action

Issued in Mannheim on 24 July 2025

NAME AND SIGNATURE

Böttcher

Judge-rapporteur