

“Good-Faith” licensing negotiation

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Outline

- FRAND and good-faith negotiation
- Legal contexts
- Different Approaches to Restriction of enforcement of SEPs
(contractual/competition law)
- Other issues
(non-discrimination; choice of licensee)
- JPO's "Guide"

FRAND

- Two aspects
 - a range or set of license terms
 - a process to agree on licensing terms (a “FRAND approach” to the negotiation of a license on FRAND terms)

(Unwired Planet v. Huawei (UK, 2017); TCL v. Ericsson (US, 2017); JPO draft Guide, p.4 (5 in the English version))

Legal Contexts

- In what legal context are we going to discuss the “good-faith” negotiation on licensing of FRAND-encumbered SEPs?

[いかなる法的問題として、誠実な交渉について論じるか？]

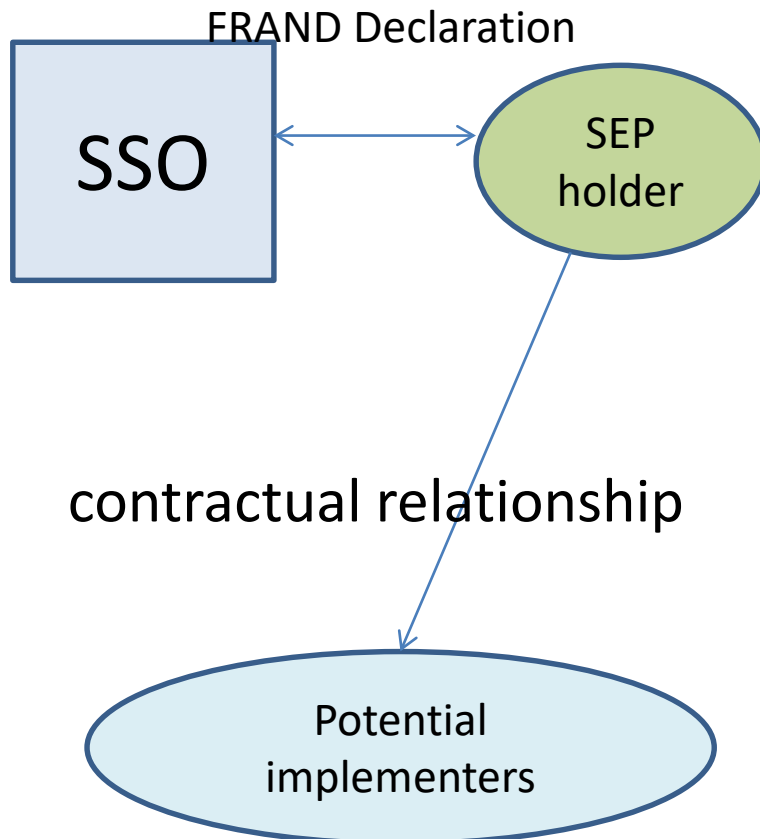
Legal Disputes Involving FRAND-encumbered SEPs

Categories	Examples
Patent infringement Disputes [特許権侵害]	Apple v. Samsung (Japan), Apple v. Motorola (US), Ericsson v. D-Link Sys. (US), Huawei v. ZTE (Germany, EU), Unwired Planet v. Huawei (UK), etc.
Disputes under Competition law [競争法]	Samsung case (EU), Motorola case (EU), Qualcomm case (Japan, Korea, etc.), etc.
Contractual Disputes [契約]	Microsoft v. Motorola (US)

Restriction of Enforcement of SEPs

- Contractual Approach [契約法アプローチ]
 - Implementers as the third-party beneficiary
 - Obligation of good-faith negotiation in the process of forming a contract
- Competition Law Approach [競争法アプローチ]
 - Abuse of a dominant position

Contractual ground for restriction



- Some court decisions in the U.S. and the UK recognized a contractual obligation by SEP holders to implementers (third party beneficiaries) based on the FRAND declarations.
- *E.g.*, Microsoft v. Motorola, 696 F. 3d 872 (9th Cir. 2012) (a breach of contract case) ; Apple v. Motorola, 886 F. Supp. 2d 1061 (W.D. Wis. 2012); Unwired Planet v. Huawei [2017] EWHC 711 (Pat).

Good-faith negotiation obligation

- The Japanese IP High Court also recognized a good-faith negotiation obligation for the holder of the SEPs (Apple v. Samsung).

“In light of the fact that the appellant has made the FRAND Declaration, the court finds that the appellant at least has **an obligation to have a good-faith negotiation** with the appellee for the execution of a FRAND license agreement, based on the principle of good faith under the Civil Code of Japan.”

Competition Law Approach

- In EU and its members, particularly Germany, the defendants have been resorting to a defense of anti-competitive practice against the enforcement of FRAND-encumbered SEPs.
- BGH, 6.5.2009 - Orange-Book-Standard (infringer can have a compulsory licensing defense against the injunctive relief due to patent holder's abuse of dominant position.)

Competition Law Approach

- Huawei v. ZTE, CJEU, 16.7.2015.
 - Provides a general framework for SEP holders and implementers to follow for the enforcement of SEPs and the use of injunctions.
 - The framework lays out a procedure For SEP holders to avoid committing an abuse of their dominant position under Article 102 of the TFEU when they seek an injunction to prevent infringement of SEPs.

Difference?

- Necessity of market power or dominant position under Competition Law Approach
 - cf.* ownership of SEPs = rebuttable presumption (AG Wathelet in Huawei v. ZTE; Unwired Planet (UK, 2017))
 - FRAND declaration ≠ sole reason to deny market power
- Claim for injunction/damages
 - Huawei v. ZTE (CJEU, 2015): compulsory license defense can only be used against injunctive relief, and not against actions seeking damages.

Claim for Damages

- Suppose the SEP holder is found to be not conducting good-faith negotiation, while the implementer is a willing licensee,
 - the SEP holder is likely to be unable to claim for damages equivalent to FRAND royalties (Japanese IP High Ct. 2014).
 - the SEP holder may still be able to claim for damages equivalent to FRAND royalties (Unwired Planet v. Samsung, LG Düsseldorf, 2016).

Other Issues

- Non-discrimination [非差別要件]
- Who should be a licensee? [誰をライセンス
シーとするか]

Non-discrimination [非差別要件]

- TCL v. Ericsson (US, 2017)
 - Non-discrimination among “similarly situated” licensees.
 - basis for comparison: “all firms reasonably well-established in the world market”, excluding “local kings”.
 - Violation of FRAND so long as discrimination harm an individual firm (competitor firm).

Choice of Licensee

- In the business chain of products or services, who should be a licensee of the related SEPs?
 - Practical issues: royalty rates, etc.
 - Legal issues: patent exhaustion (or implied license), etc.

JPO's "Guide"

- “Not intended to be prescriptive” [規範を設定するものではない]
- “Guide” from the viewpoint of patent policy (to achieve its ultimate goal to promote innovation) (?)