



Newsletter Edition 12/2020

Düsseldorf/Essen/Frankfurt/München, 3. December 2020

“FRAND 2.0” - Submission of the
Regional Court Düsseldorf to the ECJ

Federal Council decides on 18 December on the
Unitary Patent System (Re-)Ratification Act

The EPO Boards of Appeal and the new Rules
of Procedure: a first impression

M I C H A L S K I



H Ü T T E R M A N N

P A T E N T A N W Ä L T E

“FRAND 2.0” - Submission of the Regional Court Düsseldorf to the ECJ

For some years now, particularly in Germany, there have been disputes arising from standard essential patents, where the defendants are not (or no longer) active in the telecommunications or mobile phone sector, but in the automotive sector – quasi a “FRAND 2.0”.

This has made such a strong impact that it can be assumed that the legislative initiative¹ to soften the automatic injunctive relief in German patent law is also partly due to this.

One line of defense of the defendants from the automotive industry is that they point out that they would use the essential standard patents in question - or even have to do so due to EU requirements (so-called “e-call”) - but that they have purchased the corresponding technology. This means that it is not them who would have to be sued, but the respective suppliers, or, if these suppliers are trying to obtain a license or even already have one, this would be ahead of any legal action against them.²

After Daimler was unsuccessful a few months ago in a case before the Mannheim Regional Court (judgement dated August 18, 2020, Case No. 2 O 34/19) with a corresponding argument against a lawsuit filed by Nokia, the Düsseldorf Regional Court decided a few days ago in parallel proceedings between the same parties to suspend the lawsuit and question the ECJ (decision dated November 26, 2020, 4c O 17/19).

At the same time, it also took the opportunity to have individual aspects of the Huawei/ZTE decision (C-170/13) of the ECJ clarified in more detail.

In summary,³ the questions of the Regional Court are the following:

To the supply chain complex:

- Is it FRAND- and/or anti-trust violation if a SEP patent holder denies a license to a supplier and sues a customer (= car manufacturer) instead?
- To what extent do the customs of the market play a role here?
- Is there a licensing priority in the case of several suppliers who build on each other?
- If a license is or has to be granted to the supplier, does the buyer even need his own license?
- How is the licensing requirement according to FRAND or antitrust law to be understood otherwise?

To ascertain the Huawei/ZTE judgement:

- To what extent is the “Huawei/ZTE Protocol” binding? Or can individual steps, which according to Huawei/ZTE are actually to be taken prior to legal proceedings, be made up for in an ongoing court case?⁴



In Our Own Affairs

4IP council published an [interview](#) with Dr. Aloys Hüttermann with questions about the unitary patent system.

¹ See our [newsletter 2/2020](#)

² Cf. here also Kühnen, GRUR 2019, 665

³ The exact wording can be found here: <https://www.lg-duesseldorf.nrw.de/behoerde/presse/Pressemitteilungen-2020/22-20.pdf>

⁴ Note: The question of the extent to which the „Huawei/ZTE Protocol“ is binding or merely represents a kind of „safe procedure“ is one of the main differences between German and British jurisdictional practice, with German practice being more of the former and British practice more of the latter, see also our [newsletter 6/2020](#)

- Furthermore, there are questions regarding the assessment of the defendant's willingness to license - how detailed and how quickly must this be explained so that it continues to meet the Huawei/ZTE conditions?⁵

The parties still have the possibility to appeal against this decision before the Higher Regional Court Düsseldorf. However, it seems unlikely that this will be granted, as it is assumed that the Higher Regional Court will also support the submission.⁶

Similar to the first Huawei/ZTE decision, which was also based on a submission by the Regional Court Düsseldorf, this new submission also has the potential to determine the practice of FRAND disputes, insofar as they leave the telecommunications sector, not only throughout Europe but even worldwide.

The *iam magazine*, together with the developments regarding the unitary patent system (see following article), even believes that an era of global leadership for the EU in the patent field is possible.⁷

The judgement of the ECJ may be expected thus with tension.

Federal Council decides on 18 December on the Unitary Patent System (Re-)Ratification Act

After the Bundestag approved the Unitary Patent System (Re-)Ratification Act on 26 November 2020⁸ with a majority clearly exceeding the required two-thirds majority of all members of parliament, the law is now on the agenda⁹ of the Bundesrat for the last plenary session of this year, which will take place on 18 December 2020.

Here, too, a two-thirds majority is mandatory, but this is considered a formality because the only party that voted against the law in the Bundestag, the AfD, is not represented in any state government. On the contrary, unanimous approval can even be assumed.

Afterwards, the law must still be executed and then signed by the Federal President. There is no deadline for this, but usually about two to three months pass. In the case of the first ratification law, however, during this time the Federal Constitutional Court requested that the law not be signed - but whether this will happen again seems less likely than the first time.¹⁰

However, even if the signing is then carried out quickly, the protocol phase will still take place first, but this will still require the conclusion of the protocol by two further signatory states of the unitary patent system. However, if Germany has ratified successfully, this is expected to happen quickly so that the preparatory work for the introduction of the unity patent system can then begin. If everything goes smoothly, the 2022 Unified Patent System could then become (a) reality.



⁵ Note: This was, among other things, an important aspect of the Sisvel/Haier decision of the Federal Court of Justice, see our [newsletter 6/2020](#)

⁶ Vgl. <https://www.juve-patent.com/news-and-stories/cases/connected-cars-lawsuits-referral-to-cjeu-increasingly-likely/>

⁷ <https://www.iam-media.com/frandseps/saturday-opinion-eu-patent-leadership>

⁸ See our [newsletter 11/2020](#)

⁹ https://www.bundesrat.de/SharedDocs/TO/998/tagesordnung-998.html;jsessionid=FBB-CA59C59FB23553B02EC72F662776B.2_cid365

¹⁰ See our [newsletter 11/2020](#)

The EPO Boards of Appeal and the new Rules of Procedure: a first impression

The new Rules of Procedure of the Boards of Appeal (RPBA) of the European Patent Office have been in force for just under a year. The Rules of Procedure have essentially been tightened up with regard to actual and alleged late submissions. For example, de facto Art. 12 (1) and (2) of the RPBA oblige the parties to re-submit their submissions from the first instance - if still relevant - together with the statement of grounds of appeal.¹¹

Unsurprisingly, 15 of 34, i.e. almost half, of the decisions with the distribution key "C"¹² made so far in 2020 now mention late submissions in the keywords.

As a general look at the decision database of the Boards of Appeal shows, the aforementioned paragraphs 1 and 2 of Art. 12 RPBA obviously do not play a role so far. However, this is not to be expected for a few years, since in practically all cases currently under consideration, the statement of grounds of appeal and the response to it were filed well before 2020. So far, only the practice of admitting late filed applications can be considered.

An important point when admitting late applications is the reasoning given by the respective party; this is shown, among others, by the decision [T 989/15](#).

According to Art. 13(1) RPBA, justifiable reasons for the delay must be given, whereupon the Board may, at its discretion, allow the application. The justification "to respond to all objections raised by the Board and the opponents" did not convince the Board here, especially when the party concerned confirmed at the hearing that no new aspects had been raised.¹³ The Board further pointed out that according to Art. 13 (2) RPBA, at the stage after service of the summons to the oral proceedings, exceptional circumstances must normally exist for requests submitted.¹⁴

However, decision [T 1418/17](#) shows that even under the new procedural rules it does not have to be a completely hopeless undertaking to submit a new auxiliary request after the summons to the oral proceedings. In this case, the justifying reasons were limited to one sentence, namely that the procedural claims were deleted from one of the pending auxiliary requests. The Board took into account the fact that the only apparent consequence of the deletion of the claims would be that any discussions on novelty would be completely resolved. Furthermore, the auxiliary request was filed 7 months before the date of the oral proceedings, so that the opponent would have sufficient time to react. The auxiliary request was granted.¹⁵

Art. 13 (1) RPBA contains a list of criteria which the Chamber "shall take into account in the exercise of its discretion". In decision [T 954/17](#), however, the Chamber concluded, on the basis of the explanations on the RPBA, that it was entirely free to decide whether and which of the specified criteria it would take into account.¹⁶

As Decision [T 84/17](#) shows, the Boards continue to look very closely at the exercise of discretion in the first instance regarding the admissibility of late applications. In this case,



¹¹ See our [newsletter 1/2020](#)

¹² Distribution to Chairpersons; decisions with allocation key „B“, distribution to all members of the Boards of Appeal, not yet made in 2020

¹³ See point 6 of the grounds of the decision

¹⁴ See point 16.1 of the grounds for the decision

¹⁵ See points 3.2 and 3.3 of the reasons for the decision

¹⁶ See point 3.10 of the grounds for the decision

the patent proprietor had stated as justification that the new auxiliary request was made in response to new documents submitted by the opponent. However, the Opposition Division had found that even without these new documents, the same reason for filing this auxiliary request had existed before. The other considerations of the Opposition Division, such as prima facie allowability, were also shared by the Board.¹⁷

The previously established practice of the Boards of Appeal, i.e. not to admit requests that have already been withdrawn in the first instance proceedings, remains unchanged.¹⁸

In decision [T 0950/16](#), the Board had to examine a secondary aspect raised by Covid-19, namely whether it is possible that a new summons to the oral proceedings could lead to a procedure falling under the new Rules of Procedure quasi through the back door. Against this background, the Board found that it would be unfair to let the date of the summons decide which version of the Rules of Procedure is to be applied.¹⁹

In Our Own Affairs

We wish your relatives, employees, colleagues and of course yourself all the best for the current difficult time and - as far as possible - happy holidays and only the best for 2021.

Impressum:

Michalski · Hüttermann & Partner
Patentanwälte mbB

Speditionstrasse 21
D-40221 Düsseldorf
Tel +49 211 159 249 0
Fax +49 211 159 249 20

Hufelandstr. 2
D-45147 Essen
Tel +49 201 271 00 703
Fax +49 201 271 00 726

Perchtinger Straße 6
D-81379 München
Tel +49 89 7007 4234
Fax +49 89 7007 4262

De-Saint-Exupéry-Str. 10
D-60549 Frankfurt a.M.
Tel +49 211 159 249 0
Fax +49 211 159 249 20

The content of this newsletter only reflects general information and does not constitute legal advice as per the German Legal Advice Act.

Despite thoroughly checking the content, Michalski · Hüttermann & Partner Patent Attorneys mbB does not assume any responsibility for the validity, accuracy, integrity or quality of the information above.

¹⁷ See points 2.2 to 2.5 of the reasons for the decision

¹⁸ See decision [T 74/17](#), points 4.2 and 4.3 of the grounds for the decision

¹⁹ See point 3.2.2 of the grounds for the decision

²⁰ P. here: [http://documents.epo.org/projects/babylon/eponet.nsf/0/26fc88f4ebb-475fec125861f002f09e7/\\$FILE/user_consultation_art_15a_RPBA_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/26fc88f4ebb-475fec125861f002f09e7/$FILE/user_consultation_art_15a_RPBA_en.pdf)