

Contents

Foreword	VII
1. Chapter Introduction	1
2. Chapter Patents and Standards	7
A. Standards	7
I. <i>Definition and examples</i>	7
II. <i>Types of standards</i>	8
III. <i>Relevance</i>	9
B. Tension between standards and patents	9
I. <i>Hold-up: Unwilling or unreasonable licensor</i>	9
II. <i>Proliferation of patents</i>	11
III. <i>FRAND ambiguity</i>	15
1. Clarifications concerning FRAND	15
a) Main purpose: To avoid hold-up	15
b) Goldstein and Kearsley's definition of FRAND	16
c) Discrimination: Possible if objectively justifiable	16
d) Main problems lie in the term 'Reasonable'	17
2. Is FRAND commitment legally binding?	18
a) Possibilities in German law: Analysis of Maaßen's proposals	19
aa) ' <i>Invitatio ad offerendum</i> ' in conjunction with Section 145 CC	19
bb) 'License of right' in terms of Section 23 Patent Act	22
cc) ' <i>Pactum de contrahendo cum tertio</i> ' in conjunction with Section 328 CC	24
(1) A true pre-contract	24
(2) Third parties and performance: Determined or determinable	25
(3) Performance determinable: <i>Essentialia negotii</i> of the main contract fulfilled in the pre-contract	26
a) First <i>essentialia</i> : Settlement to grant; difficulties if only bundling patents are offered	28
b) Second <i>essentialia</i> : Compensation; FRAND ambiguity and supplementary judicial interpretation	30
c) The circumstances of the case may allow a lower level of certainty	32
(4) Steps to determine FRAND	32
a) The <i>Georgia-Pacific</i> factors	33
b) Goldschneider's 25% rule	35
c) Charts available and previous licensing agreements	36
(5) Conclusion	36
b) Contract for the benefit of third parties in other countries	37
c) Alternative to <i>pactum in contrahendo cum tertio</i> in German law: contradictory conduct – Section 242 CC	39

d) ‘ <i>Bona fide</i> ’ in other legislations	40
IV. <i>Excessive cumulative royalties (royalty stacking): Patents (dis)incentive innovation</i>	41
V. <i>Over-declaration of patents</i>	42
1. Reasons	42
2. Percentage of over-declared patents	43
3. ‘ <i>Nokia v. InterDigital</i> ’: Declaration of non-essentiality	44
4. Does FRAND commitment apply to whatever is disclosed in the database?	45
5. Update obligation: Change of IPR policy may not be necessary	45
VI. <i>Patent family and FRAND commitment</i>	46
C. Summary and conclusion	48
3. Chapter Several ways to participate and evaluate the standard setting process – business models	55
A. Small and medium-sized companies	55
B. Product companies	59
C. Largely research and development (R&D) companies	60
D. Defensive strategy companies: Sleeping dogs	61
E. Pro ‘open-standard’ companies	61
I. <i>Open standards avoid lock-in</i>	61
II. <i>Not necessarily royalty-free</i>	62
F. Different strategies within the same company	63
G. Patent troll companies	65
I. <i>How to recognise patent trolls</i>	65
II. <i>Contrary to the purpose of the injunction</i>	65
III. <i>Patent trolls in the US: The threat of injunction</i>	67
1. ‘ <i>NTP v. RIM</i> ’	67
2. ‘ <i>MercExchange v. eBay</i> ’	67
3. ‘ <i>KSR v. Teleflex</i> ’	68
4. Concerns/Critiques after recent jurisprudence	68
5. Patent trolls: A very lucrative business	69
IV. <i>Patent trolls in Europe: The same concerns as in the US?</i>	70
1. Does a commitment to license certain essential patents on FRAND terms survive the transfer of these patents?	70
a) ‘ <i>IPcom v. Nokia</i> ’	70
b) ‘ <i>N-Data</i> ’	71
c) ‘ <i>Rembrandt</i> ’	72
2. How to defend oneself against unfair injunctions and excessive royalty rates in Germany	73
3. Are patent trolls a problem in Europe?	76
H. Summary and conclusion	77

4. Chapter Harm to the standardisation process	81
A. Phases of the standardisation process: Possible injection of patents	81
B. Patent ambush	84
I. <i>Description and consequences</i>	84
II. <i>Requisites</i>	85
III. <i>18-months hidden period</i>	85
IV. <i>Grace period</i>	86
V. <i>Trying to avoid patent ambush through IPR Policy</i>	87
1. To make information exchanged within the SSO ‘available to the public’ in terms of Article 54 EPC	87
2. Incongruent case-law within EPO Boards of Appeal	88
a) ‘ <i>Erich Jäger & Co. v. Pirna & Procon</i> ’	88
b) ‘ <i>Kabushiki Kaisha Toshiba v. Gemplus Axalto</i> ’	88
3. Conclusions	89
VI. <i>The thin line between use and misuse</i>	90
1. Practical hurdles	91
2. Legal hurdles	92
a) Is a combination of pieces of prior art patentable?	92
b) Revocation or invalidation	94
aa) First example	95
bb) Second example	96
3. The US perspective	97
4. Proposal to amend the IPR policy	98
C. Can deceptive conducts, particularly patent ambush, harm competition law?	99
I. <i>From the US perspective</i>	99
1. ‘ <i>Dell</i> ’	99
2. ‘ <i>Unocal</i> ’	100
3. ‘ <i>Broadcom v. Qualcomm</i> ’	101
a) Background of the case and Qualcomm’s conduct	101
b) District Court	102
c) Third Circuit	102
aa) Unlawful monopolisation under Sec. 2 Sherman Act	103
(1) First pre-requisite: Monopoly power of WCDMA Technology Markets	103
(2) Second pre-requisite: Wilful acquisition or maintenance of monopoly power and causation	103
(3) Conclusion	104
bb) Attempted monopolisation under Sec. 2 Sherman Act	105
(1) Anticompetitive conduct	105
(2) Specific intent to monopolise	105
(3) Dangerous probability of achieving monopoly power	105
4. ‘ <i>Qualcomm</i> ’ and ‘ <i>Rambus</i> ’: similar but different	106
5. ‘ <i>Rambus</i> ’	111
a) Background of the case and Rambus’s conduct	111
b) Section 2 Sherman Act and Sec. 5 FTC Act	112
c) Monopolisation claim: fundamental issues	113

Contents

aa) Exclusionary conduct	114
bb) Possession of monopoly power	115
cc) Causation	115
d) Rambus's arguments rejected	116
e) FTC decision	117
f) Court of Appeals' decision	117
g) Implications of the Court of Appeals' decision	119
h) What does Sec. 2 of the Sherman Act protect?	120
i) The standardisation context: To be considered in court decisions	121
j) Petition towards the US Supreme Court	124
II. <i>From the European perspective</i>	126
1. Patent ambush may harm competition law	126
2. ' <i>Rambus</i> ' from the EC perspective	128
a) Requisite 1: Existing dominant position	128
b) Requisite 2: Abuse of the dominant position	130
aa) Requirements	130
bb) Exclusionary and exploitative abuses: Prognosis of EC decision in Rambus	130
c) Why not exclusionary abuse?	135
aa) Objective justified?	135
bb) Pro-competitive effects: Efficiency defence	135
d) Causation	136
D. Summary and conclusion	137
5. Chapter Proposals to avoid hold-up and royalty stacking	149
A. Minimum Change Optimum Impact	149
I. <i>Quick win solution</i>	149
II. <i>MCOI in connection with the 'Time Multiplex Process' case</i>	151
1. Proportionality and Aggregated Reasonable Terms in every licensing offer	151
2. Provision to guarantee a reasonable cumulative licensing fee	153
3. Two alternative examples suggested by the court	153
III. <i>Conclusions</i>	155
B. Joint negotiations	159
I. <i>Pros and cons</i>	159
II. <i>Exception in terms of Article 81 (3) EC?</i>	160
III. <i>A softer approach</i>	163
1. To 'consider but not discuss' public information	163
2. Conclusions	164
C. Fixing a cap	165
I. <i>The European Commission's interpretation</i>	165
II. <i>Personal interpretation and conclusions</i>	165
III. <i>Abuse of collective dominance of the GSM market in terms of Article 82 EC?</i>	166
D. 'Ex ante' disclosure	169
I. <i>Pros and cons</i>	169
II. <i>VITA and CESI</i>	171

1. VITA	171
2. CESI compared to VITA	172
3. Are <i>ex ante</i> critiques justifiable?	176
4. Relevant difference still not considered	181
III. <i>Conclusions: Possible change of the ETSI IPR Policy to a mandatory ex ante disclosure?</i>	182
E. Summary and conclusion	185
6. Chapter Alternatives to formal standard-setting organisations.	191
A. Next-Generation Mobile Networks	191
I. <i>The origin</i>	191
II. <i>Goals</i>	192
III. <i>'Ex-ante' notification to a trusted third party</i>	193
IV. <i>Some remarks</i>	193
V. <i>Unrealistic results</i>	194
B. Fora and consortia	194
I. <i>Relevance of fora and consortia in ICT standardisation</i>	194
II. <i>Coexistence of open-source and proprietary licensing models: LiMo Foundation</i>	197
C. Cross-license agreements and patent pools	198
D. Summary and conclusions	202
7. Chapter Final conclusions	205
Annex	217
Annex 1 Interview with Ray Alderman, Executive Director VITA	218
Annex 2 E-mail exchange with Ray Alderman, Executive Director VITA	225
Annex 3 Interview with Yann Dietrich (General Counsel LiMo Foundation, ex. EMEA Chief IP Counsel Intel Corporation Ltd.)	227
Annex 4 Interview with Franco Cordera, Peter Kuhn, Alexander Seeger and Fulvio Moschetti, EPO	231
Annex 5 Interview with Dr. Michel Goudelis and Frank Rüschemann, EPO	253
Annex 6 Interview with Dr. Konstantinos Karachalios, EPO	266
Annex 7 Interview with Qualcomm Inc.	269
List of Abbreviations	281
Bibliography	285
Table of Cases	317
Civil Codes And Common Law Contract Acts	331
Index	333