



Unified Patent Court  
Einheitliches Patentgericht  
Jurisdiction unifiée du brevet

No hold-up and no hold-out – Willingness to grant and to take a FRAND license in SEP infringement cases

不得专利劫持-反劫持：标准必要专利侵权案件中授予和接受FRAND许可的意愿问题

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All written and said is my personal view and not a communication of the UPC Court of Appeal.  
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**I. No Hold-up – no Hold-out  
不得专利劫持—反劫持**

- **No Hold-up /// 不得专利劫持**
  - SEP owner must be willing to grant a license without /// 标准必要专利权人具有授予许可证的意愿，不得
    - **misusing a market dominant position or /// 滥用市场支配地位，或者**
    - **discriminating the SEP implementer compared to other licensees. /// 将标准必要专利实施人和其他被许可人区别对待。**
  - If the SEP holder is not willing to grant a license under these conditions injunctive relief is not available even if the patent is valid and has been infringed by the SEP implementer. /// 如果标准必要专利权人没有根据上述条件授予许可的意愿，即便其有效专利被实施人侵犯，也无法获得禁制令救济。

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- **No Hold-out /// 不得专利反劫持**
  - The SEP implementer must be willing to take a license. /// 标准必要专利实施人必须具有接受许可的意愿。
  - **No delaying tactics – no free ride. /// 不得采取拖延战术——没有便车可搭。**
  - If the SEP implementer is not willing to take a license injunctive relief is available for the SEP holder. /// 如果标准必要专利实施人没有接受许可的意愿，标准必要专利权人可以获得禁制令救济。

No hold-up No hold-out /// 不得劫持，不得反劫持（搭便车）



**II. Willingness to grant or take a FRAND  
license  
授予或接受FRAND许可的意愿**

## Willingness to grant or take a FRAND license 授予或接受FRAND许可的意愿

- The Court of Justice of the European Union (CJEU) in its leading decision of 16 July 2015 – C-170/13 – Huawei/ZTE laid down a negotiation process to find out whether // 欧盟法院在其2015年7月16日的主要判决中（C-170/13，华为诉中兴案）制定了谈判程序，以查明
  - the patent proprietor is willing to grant a FRAND license // 专利权人愿意授予FRAND许可
    - as required by his undertaking in front of the SSO // 以遵守专利权人向标准制定组织作出的承诺
  - the implementer is willing to take a FRAND license // 实施人愿意接受FRAND许可
    - as required when relying on the patent proprietors FRAND undertaking as a defense. // 将专利权人的FRAND承诺作为抗辩理由，需要以此为前提条件。

### 1) The SEP holder must alert /// 标准必要专利权人必须发出警告

- Prior to bringing an action for an injunction the SEP proprietor has to alert the alleged infringer of the infringement complained by /// 在发起禁制令诉讼之前，标准必要专利权人必须就侵权行为向涉嫌侵权人发出警告。
  - **designation of the SEP and** /// **标准必要专利的名称，以及**
  - **specifying the infringement.** /// **明确侵权行为。**
    - Which embodiments allegedly infringe the SEP /// 哪些实施例涉嫌标准必要专利侵权
    - Which acts are alleged to be SEP infringing. /// 哪些行为涉嫌标准必要专利侵权。
      - May be done by claim charts but this is not mandatory (German Federal Supreme Court [FSC], 5 Mai 2020 – KZR 36/17, para 85 – FRAND defence I). /// 可以通过填写专利要求表完成，但非强制性（德国联邦最高法院，2020年5月5日；KZR 36/17，第85段；FRAND抗辩 [一] ）。



### 2) SEP implementer must express willingness /// 标准必要专利实施人必须表明意愿

- In his response to the patent owner's alert the implementer must express his willingness /// 实施人在回应专利权人的警告中，必须表明对下列事项的意愿：
  - **to take a FRAND license on whatever terms are in fact FRAND (FSC, para 83 – FRAND defence I). /// 根据事实上的FRAND条款接受FRAND许可（德国联邦最高法院，第83段-FRAND抗辩 [一]）。**
- It is not sufficient if the implementer merely shows willingness only /// 实施人仅表明对下列事项的意愿是不够的：
  - **to consider concluding a license agreement or /// 仅愿意对签订许可协议加以考虑，或者**
  - **to enter into negotiations as to whether and under what conditions an agreement would be possible. /// 仅愿意就是否以及在何种条件下有可能达成协议进行谈判。**

### Indications that the implementer is not interested in taking a FRAND license: /// 实施人无意接受FRAND许可意愿的标志:

Implementer ... /// 实施人.....

- **waits too long with a response to the patent holder's infringement notification (in FRAND defense I more than 1 year) /// 回应专利权人侵权警告的等待时间过长 (在FRAND抗辩 [一] 中, 超过1年)**
- does not clearly and unambiguously declare that he is willing to take a FRAND license /// 未明确无误地声明接受FRAND许可的意愿
- uses delaying tactics /// 采取拖延战术
- files a request for an anti-suit-injunction before a court of another jurisdiction (Munich District Court, 25 February 2021 – 7 O 1427/20). /// 向其他管辖法院提出反禁诉令 (慕尼黑地方法院, 2021年2月25日; 7 O 1427/20) 。

### 3) SEP holder must make a specific offer /// 标准必要专利权人必须提出具体要约

- specific written offer for a licence under FRAND terms, in particular /// 基于FRAND条款的具体书面要约，载明：
  - the amount of royalty and /// 许可费，以及
  - the way it is to be calculated (CJEU, para 63 – Huawei/ZTE) /// 许可费计算方法（欧盟法院，第63段；华为诉中兴案）
- The offer should have the format of a contract with all terms that are usually part of a license contract in the particular sector. /// 要约应使用协议格式，并包含该行业许可协议的所有常规条款。

### The offer ... /// 要约.....

- should cover all commercial activities of the implementer (Düsseldorf District Court, 11 July 2018 – 4c O 72/17), /// 应涵盖实施人的所有商业活动 (杜塞尔多夫地方法院, 2018年7月11日; 4c O 72/17) ;
- should not be discriminating or, if so, should have a justification for treating licensee differently (FSC, para 101 et seq. – Sisvel/Haier), /// 不得区别对待被许可人, 有正当理由的除外 (德国联邦最高法院, 第101段及下文; Sisvel诉海尔案) ;
- should not require the implementer to cross-license Non-SEPs, /// 不得要求实施人交叉许可非标准必要专利;
- may encompass a patent portfolio, /// 可以包括专利组合
  - provided sufficient information on the patents belonging to the portfolio is made available (FSC, para 98 – FRAND defence I; 24 November 2020 – KZR 35/17, para 97 – FRAND defence II) /// 前提是对专利组合中的专利提供充分信息 (德国联邦最高法院, 第98段–FRAND抗辩 [一] ; 2020年11月24日; KZR 35/17, 第97段; FRAND抗辩 [二] )

### The offer ... /// 要约.....

- may be a Pool license /// 可以是专利池许可
  - if implementer also uses the other patents of the pool (Düsseldorf Higher Regional Court, 12 May 2022 – I-2 U 13/21 – Signalsynthese II) /// 如果实施人还使用了专利池中的其他专利 (杜塞尔多夫高级地方法院, 2022年5月12日; I-2 U 13/21; Signalsynthese II )
- may not be a Pool license /// 也可以不是专利池许可
  - if a significant number of patents of the pool are not standard essential and not used by the implementer. /// 如果专利池中有相当数量的专利不是标准必要专利, 而且实施人并未使用。
- may be a Global pool license /// 可以是全球专利池许可
  - if the implementer uses the standard globally. /// 如果实施人在全球范围内对标准进行实施。

### 4) SEP implementer must respond /// 标准必要专利实施人必须作出回应

- diligently and in good faith /// 遵循勤勉诚信原则
- accept offer or submit counter-offer /// 接受要约或提出反要约
- within due term (“no delaying tactics”). /// 在适当期限内（“不得采取拖延战术”）。
- Like the offer of the SEP holder also the counter-offer of the SEP implementer should have the format of contract with all terms that are usually part of license contract in the particular sector. /// 同样，实施人的反要约也应使用协议格式，并包含该行业许可协议的所有常规条款。

## Indications that the implementer is not interested in taking a FRAND license: /// 实施人无意接受FRAND许可的标志

- Implementer categorically rejects an obviously appropriate licensing model, e.g. a pool license (Düsseldorf Higher Regional Court, 12 May 2022 – I-2 U 13/21 – Signalsynthese II). /// 实施人断然拒绝明显合理的许可模式，例如专利池许可（杜塞尔多夫高等地方法院，2022年5月12日；I-2 U 13/21；Signalsynthese II）。

**5) If the counter-offer is rejected the SEP implementer must render account and provide appropriate security /// 如果反要约被拒绝，标准必要专利实施人必须披露账户信息并提供适当担保**

- **Rendering account on /// 披露账户信息**
  - the number of the past acts of use of the SEP /// 过往实际实施标准必要专利的次数
  - all information that is necessary to calculate damages or royalties /// 计算损害赔偿或许可费所需的全部信息
- **Providing security /// 提供担保**
  - on the basis of the number of the past acts of use of the SEP /// 以过往实际使用标准必要专利的次数为依据
  - appropriate amount /// 适当金额
  - by bank guarantee or placing the amounts necessary on deposit /// 出具银行保函，或将所需金额存入银行账户



## Willingness to grant or take a FRAND license 授予或接受FRAND许可的意愿

- **A SEP implementer who does not render account or does not provide security may be considered to be unwilling to take a license. /// 不披露账户信息或不提供担保的实施人可能被视为无意接受标准必要专利许可。**

- 6) **If no agreement can be reached, parties may, by common agreement, request that the amount of royalty be determined by an independent third party // 双方无法达成协议的，可以经协商要求由独立第三方确定许可费**
- Parties that choose to request for such a settlement may be considered to be willing to grant or take a FRAND license. // 提出上述和解方案的当事人可被视为具有授予或接受FRAND许可的意愿。

- 7) **Parties have to be willing to grant or take a FRAND license during the whole negotiation process** /// 在谈判全过程中，当事人均必须具有授予或接受FRAND许可的意愿。
- The willingness of the patent proprietor and the implementer to license should not be limited to /// 专利权人和实施人的意愿不应仅限于：
    - **a one-off expression of interest in licensing or** /// 对许可意愿的一次性表达；或
    - **the submission of one offer and one counter-offer.** /// 提出一份要约、提出一份反要约。
  - Rather, both parties are required to contribute to an ongoing negotiation of an appropriate balance of the conflicting interests in the final license agreement on FRAND terms (FSC, 24 November 2020 – KZR 35/17 – FRAND defense II).  
/// 双方均有义务促成进行中的谈判，在基于FRAND条款的最终许可协议中，对利益矛盾作出合理权衡。（德国联邦最高法院，2020年11月24日；KZR 35/17；FRAND抗辩 [二]）。

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Thank you for your attention.  
感谢聆听

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