

Protocol re Keynote Session „SEPs Policy Trends in Europe“ of TUB-SEP-Conference 10/12/2020

The Keynote Session was opened by the moderator (Heinz Goddar) outlining the agenda (topics) of the Session and introducing the panellists, namely Kerstin Jorna, Peter Meier-Beck and Christian Wichard.

In his introductory remarks, the moderator pointed to important SEP-related “events” that happened during the last few weeks, namely a) IP Action Plan of EU Commission of November 25, 2020 (COM(2020) 760 final), b) Landscape and Pilot Study “SEP Essentiality Test Project” of DG GROW of November 25, 2020, c) the German “2nd Patent Modernization Bill (“PMB”)” pending in German parliament since October 28, 2020, and d) the decision of Düsseldorf District Court of November 26, 2020, 4c O 17/19, posing a long catalogue of questions particularly related to SEP supply chain licensing to the EUCJ by referral.

Thereafter, still as a part of the introduction of topic and panelists, the moderator announced that he would like to know from mainly Kerstin Jorna whether there are already efforts of the EU Commission on their way to achieve global harmonization with regard to ongoing standardization efforts, particularly with regard to IoT in relation to somehow institutionalizing essentiality tests, FRAND determination and expediting willingness of SEP holders and implementers in the international context. All this with a specific view to the risk that without early international harmonization specifically in certain technical fields, like IoT and AI, the world might be at risk to develop two different regional standard systems, one in Greater China and Asia, resp., and the other one in U.S.A., with Western Europe being somewhere in the middle. The moderator pointed, ironically, to the fact that sitting “in the middle” easily could mean “between two chairs”, which would not be a comfortable position if not diligently and wisely handled.

Then, Kerstin Jorna, as the first panelist, outlined the IP action plan of November 25, 2020, specifically indicating that solutions outside of courts should hopefully be found, possibly by mediation/arbitration and/or expert councils, in order to assist parties and courts in preparing and conducting swift license negotiations. Possibly, essentiality checks might be used as a pre-condition for actions at court initiated by SEP holders, and certainly the developments at EUCJ with regard to supply chain licensing are in the focus of the EU Commission.

As a next speaker, Peter Meier-Beck explained the developments of German case law, also in an international context, since the Orange-Book-Standard decision as well as Huawei vs. ZTE of EUCJ over the last years, culminating in a first decision of a newly founded XIIIth Civil Senate, i.e. the cartel/competition senate, of the German Federal Court of Justice (GFCJ) being presided by him. The moderator raised the question whether the tendency would be, as far as supply chain licensing is concerned, towards License To All (“LTA”) or to “Access To All” (“ATA”) in supply chain licensing, with interesting, but diverging opinions expressed by some of the panelists in the panel discussion.

Thereafter, Christian Wichard explained, using a very instructive summary in the form of a PPT “Introduction to the draft Patent Law Modernization Bill”, explained the 2nd German Patent Modernization Bill (GPMB) and particularly its importance for hopefully narrowing or even closing the “injunction gap” in patent litigation procedures in Germany, which are a consequence of the otherwise from his viewpoint, supported by the moderator at least as well as Peter Meier-Beck, useful bifurcation system in Germany. The moderator asked Christian Wichard whether there are still plans to further develop the draft German Patent Modernization Bill by allowing nullity actions in Germany even during pending opposition procedures and possibilities, resp., and interesting enough the answer has been that this is still under consideration during the parliamentary process aiming at a final Patent Law Modernization Bill in parliament, which is ongoing.

In a closing discussion, the international aspect was dealt with again in final Q&A. The moderator asked, supported by the audience, Peter Meier-Beck whether after the Düsseldorf referral to EUCJ there would be a stand-still in German SEP-related litigation. The panellists were of the unanimous opinion that particularly in the time of IoT, like looking at the importance of connectivity for autonomous driving etc., requiring latency-free connections between certain components of cars as well as with different cars, conflict-solving solutions which are accepted both internationally and by industry, would be of tremendous importance. The courts would not be out of the picture, but before parties go there, by e.g. international arbitration/mediation, possibly by WIPO or by patent offices, a lot of preparatory due diligence work could be done which would make the courts more able and willing to consider more than one patent in certain litigation procedures, or even more than one patent portfolio only belonging to one “player”. The question remained open as to whether a special SEP-arbitration-body for

both FRAND determination and essentiality checks should/could be created, or whether one should make use of already existing arbitration mechanisms in international organizations like WIPO and/or WTO.

Many questions that have been discussed in the Keynote Session were later on more worked on in an elaborated form during the Thematic Panels.