
Date: 20.07.2021
Court: Düsseldorf Higher Regional Court
Panel: 15th Civil Senate
Decision type: Decision
Reference number: 15 U 39/21
ECLI: ECLI:DE:OLGD:2021:0720.15U39.21.00

Previous instance: Düsseldorf District Court, 4a O 23/20
Parallel decision(s): Complete
Legal force: legally binding

Tenor:

The defendant's request that the plaintiff's execution of the judgment of the Düsseldorf District Court dated May 11, 2021 (file no.: 4b O 23/20) be temporarily suspended with respect to the claims for injunction, recall and destruction (items I, II, VI, VII of the operative part) - if necessary against a security deposit placed at the discretion of the Senate - is dismissed.

Reasons:

The defendant's admissible request for temporary suspension of execution from the judgment of the District Court challenged by the appeal (Sections 719 (1) sentence 1, 707 (1) sentence 1 Code of Civil Procedure (ZPO)) is unfounded.

Pursuant to Sections 719 and 707 of the Code of Civil Procedure (ZPO), if an appeal is lodged against a judgment that has been declared provisionally enforceable, enforcement of the judgment may be suspended for the time being - against or without the provision of security. Within the framework of the discretionary decision to be made accordingly, the court must always comprehensively weigh the conflicting interests of the creditor on the one hand and the debtor on the other. In doing so, it must observe the value decision of the legislature that the interests of the creditor in enforcement are in principle to be given priority. The provision of section 709 sentence 1 Code of Civil Procedure (ZPO) states that the enforcement debtor is generally already sufficiently

protected by the security to be provided by the creditor prior to enforcement. It is therefore in line with established case law that in cases in which the contested judgment (as here) is only enforceable against the provision of security by the creditor, suspension of enforcement can only be considered in exceptional cases under special circumstances (cf. only Senate, Decision of January 13, 2016 - 15 U 65/15, BeckRS 2016, 1679 para. 2; Decision of January 13, 2016 - I-15 U 66/15, BeckRS 2016, 1680 para. 2; Düsseldorf Higher Regional Court [2nd ZS], GRUR-RR 2010, 122, 123 - prepaid telephone calls, in each case with further references).

For the area of patent law, there is also the special feature that the term of the patent and thus the injunction it imparts is limited in time, which is why, at least in the case of a timely expiration of the property right, any postponement of the enforcement can lead to a complete running dry of the injunctive relief (Federal Supreme Court), GRUR 2000, 862 - Spannvorrichtung; Senate, BeckRS 2016, 1679 recital 3; Decision of January 13, 2016 - I-15 U 66/15, BeckRS 2016, 01680 recital 3; Decision of June 9, 2016 - I15 U 26/16, BeckRS 2016, 9323; Düsseldorf Higher Regional Court [2nd ZS], GRUR-RR 2010, 122, 123 - prepaid telephone calls).

Against this background, discontinuation of enforcement is in principle only justified if either it can already be established at the time of the decision on the application for discontinuation in the summary examination required in the proceedings under sections 719, 707 Code of Civil Procedure (ZPO) that the contested judgment is unlikely to stand, or if the debtor can demonstrate and substantiate the risk of special damage that goes beyond the general enforcement effects (cf. e.g. Senate, BeckRS 2016, 1679 recital. 4; BeckRS 2016, 1680 recital 4; BeckRS 2016, 9323; Düsseldorf Higher Regional Court [2nd ZS], GRUR-RR 2010, 122, 123 - prepaid telephone calls; Decision of December 2, 2019 - 2 U 48/19, GRUR-RS 2019, 43964 recital 4 with further references; see also Higher Regional Court Karlsruhe, GRUR-RR 2015, 326 - Mobiltelefone; GRUR-RS 2021, 9325 recital 27).

The contested judgment will probably not be upheld if it is obviously or manifestly erroneous. Whether this is the case shall be assessed on the basis of the factual findings and legal considerations that are decisive for the first instance decision. If these findings or legal considerations already prove to be unsustainable during the summary review to be carried out, enforcement of the judgment must be suspended as a rule. This generally applies irrespective of whether the contested judgment may prove to be correct in the result with other findings or on the basis of other legal considerations (Senate, BeckRS 2016, 1679 recital 5; BeckRS 2016, 1680 recital 5; BeckRS 2016, 9323; Düsseldorf Higher Regional Court [2nd ZS], decision of August 5, 2019 - I-2 U 35/19, GRUR-RS 2019, 24918 recital 5; Higher Regional Court Karlsruhe, GRUR-RR 2015, 50 - Leiterbahnstrukturen; GRUR-RR 2015, 326 - Mobiltelefone; GRUR-RS 2021, 9325 recital 30). For one thing, it is not the purpose of the proceedings under Sections 707, 719 Code of Civil Procedure (ZPO) to completely anticipate the appeal proceedings and to conclusively clarify the likelihood of success of the pending appeal within its framework. Rather, it serves to remove the provisional enforceability of such decisions that already prove to be manifestly untenable upon summary review. Secondly, the principle that discontinuance is only required if it can already be established on summary examination at the time of the decision on the application for discontinuance that the judgment under appeal is unlikely to stand is based on the fact that the court whose judgment is being appealed has already dealt with the facts of the case in detail and decided on the questions that arise. Then the decision enjoys the confidence that justifies its provisional enforceability and thus the fundamental priority of the interests of the prevailing plaintiff. However,

this consideration does not come into play if the court of first instance has disregarded essential aspects of the case that are relevant to the decision and has not decided on the questions arising in this respect (Senate, BeckRS 2016, 1679 recital 5; BeckRS 2016, 1680 recital 5; Düsseldorf Higher Regional Court [2nd ZS], GRUR-RR 2010, 122 - prepaid-telephone-calls. cf. also: Karlsruhe Higher Regional Court, GRUR-RS 2021, 9325 recital 27). Alternative reasons of a legal or factual nature, which may result in the appeal being unsuccessful and the contested judgment ultimately being upheld, must therefore in principle be disregarded in temporary recruitment proceedings (Senate, BeckRS 2016, 1679 recital 5; BeckRS 2016, 1680 recital 5; BeckRS 2016, 9323; Düsseldorf Higher Regional Court [2nd ZS], GRUR-RS 2019, 43964 recital 5). Something else can only apply if it can already be established on the basis of summary examination that the (undisputed) alternative facts or the alternative legal considerations obviously support the decision taken by the court (Senate, BeckRS 2016, 1679 recital 5; BeckRS 2016, 1680 recital 5; Düsseldorf Higher Regional Court [2nd ZS], GRUR-RS 2019, 43964 recital 5).

2.

On the basis of these legal principles, the requirements for a temporary suspension of enforcement are not met in this case.

a)

The Senate is unable to establish that the contested judgment is obviously or manifestly incorrect insofar as the District Court did not allow the defendants' objection to compulsory licensing under antitrust law to prevail.

However, without further examination, it can initially be assumed in the recruitment proceedings in favor of the defendant that the patent in suit gives the plaintiff a dominant position. Likewise, it can be assumed without further discussion that the principles developed in the decision "*Huawei ./. ZTE*" (ECJ, GRUR 2015, 764) are applicable to the present case. Since the defendants do not oppose the District Court's assumption with their motion to discontinue that in any case the letter of February 13, 2017 constitutes a sufficient notice of infringement, there is also currently no reason to review this assessment of the District Court. In contrast, to the extent that the defendants, with their request for discontinuance, object to the District Court's denial of their readiness for licensing, the Senate, in the summary review required in the discontinuance proceedings alone, cannot identify any obvious errors of law that disadvantage the defendants.

aa) The defendants do not succeed in their objection that the District Court assumed an incorrect legal standard for the assessment of the willingness to license.

(1) As the District Court has correctly pointed out, the Federal Supreme Court has recently dealt in detail with the requirements for the patent infringer's willingness to license required under the case law of the European Court of Justice (GRUR 2015, 764 - *Huawei/ZTE*) in the decisions "*FRAND-Einwand I*" ("*Sisvel/Haier I*"; GRUR 2020, 961) and "*FRAND-Einwand II*" ("*Sisvel/Haier II*"; GRUR 2021, 585).

According to this case law, which is understood by the Federal Supreme Court (BGH) as a concretization of the ECJ case law, an abuse of the dominant position of a patent owner does not in principle result from contractual terms offered by the patent owner before or at the beginning of

negotiations as such, which, if they were contractually agreed, could unfairly hinder or discriminate against the licensee. Rather, the abuse of market power only follows from the refusal of a requested access to the invention per se or from unreasonable conditions for a requested access from which the patent owner is not willing to deviate even at the end of negotiations, i.e. the refusal to conclude a license agreement with the licensee, to offer the licensee seeking the conclusion of a license agreement on FRAND terms, as a result of a negotiation process, those fair, reasonable and non-discriminatory contractual terms and conditions which the licensee can claim and to which it, for its part, is prepared to conclude with the patent owner (Federal Supreme Court (BGH), GRUR 2021, 585 recital 54 - FRAND Objection II).

Accordingly, there is no scope for the assumption of an abuse of market power, in particular, if the user, who has been made aware of the infringement and of the willingness to license, has not clearly and unambiguously indicated that he is seeking a license on FRAND terms (Federal Supreme Court (BGH), GRUR 2021, 585 recital 56 - FRAND-Einwand II). For this purpose, it is not sufficient that the user merely shows willingness to consider the conclusion of a license agreement or to enter into negotiations as to whether and under which conditions a conclusion of an agreement would be possible for him. Rather, the user must declare his willingness to enter into a license agreement and must continuously and purposefully participate in the license negotiations and must always, or until the conclusion of a license agreement, show that he is willing to enter into a license agreement (Federal Supreme Court (BGH), GRUR 2020, 961 recital 83 - FRAND-Einwand; GRUR 2021, 585 recital. 57 - FRAND-Einwand II). If a user has failed over a longer period of time to express his interest in a license agreement on FRAND terms and/or has failed to cooperate (further) as required, the defense of a claim for licensing on FRAND terms remains available to him in principle. However, it can only be successful if he makes additional efforts to contribute to the conclusion of a corresponding license agreement as soon as possible, notwithstanding his failure to do so (Federal Supreme Court (BGH), GRUR 2021, 585 recital 60 and recitals 62,83, 89, 109 - FRAND-Einwand II). The longer he has waited with the assertion of his licensing claim, the higher the requirements to be placed on his cooperation (Federal Supreme Court (BGH), GRUR 2021, 585 recital 83 and recitals 60, 62, 89; 109 - FRAND-Einwand II). An infringer who remains silent for several months in response to the infringement notice and thus regularly indicates that he is not interested in taking a license (Federal Supreme Court (BGH) GRUR 2020, 961 recital 92 - FRAND-Einwand I; Federal Supreme Court (BGH) GRUR 2021, 585 recital 87 - FRAND-Einwand II) can be expected to indicate that he now wants to do everything to promote the negotiations in case of genuine willingness to take a license (Federal Supreme Court (BGH) GRUR 2021, 585 recital 89 - FRAND-Einwand II). Whether such can be established is a question of the individual case, which must be answered on the basis of a careful examination.

According to the cited case law, the willingness to license understood in this way is also relevant if the patent owner has already made a license offer to the infringer (Federal Supreme Court (BGH), GRUR 2021, 585 para. 69 - FRAND-Einwand II).

(2)The District Court correctly reproduced the relevant case law of the Federal Supreme Court (BGH) in the contested judgment (LG judgment, pp. 50-51) and applied its principles to the dispute.

(3)

Insofar as the defendants - without any discussion of the supreme court case law reproduced above - believe that the standard of the District Court (and thus that of the Federal Supreme Court (BGH)) is incorrect, and they claim that the standard advocated by Kühnen (Handbuch der

Patentverletzung, 13th edition, Chapter E, recital 393 et seq.) must be applied instead, which the 4c Civil Chamber of the Düsseldorf District Court used as a basis in its order for reference of November 26, 2020 (4c O 17/19, GRUR-RS 2020, 32508 - Telematikkontrolleinheit), the Senate does not have to deal with the different legal opinions in more detail in the setting proceedings and also does not have to comment on the extent to which it adheres to its previous case law (cf. Decision of 17 November 2016 -1-15 U 66/15, GRUR-RS 2016, 21067 para. 8 et seq.; GRUR 2017, 1219 recitals 135 et seq. (151 et seq.) - Mobiles Kommunikationssystem). Even if the case law reproduced should not be (fully) agreed with, it can of course not be regarded as "obviously incorrect" if the District Court followed the opinion of the Federal Supreme Court (BGH)'s Cartel Senate in an antitrust law legal question, which confirmed and deepened its requirements for the infringer's willingness to license set out in the "FRAND Einwand" decision - in the knowledge of the opposing opinion cited by the defendants - in the "FRAND Einwand II" decision (cf. *Rätz, GRUR-Prax 2021, 174*).

bb)At the same time, it follows from the foregoing that the standard for the summary examination in the hiring procedure here is only the requirements of the case law applied by the District Court. The District Court's finding that the defendants had not shown themselves willing to conclude a license agreement on FRAND terms by the end of the oral proceedings is therefore only to be examined as to whether the contested judgment, in light of the case law cited, assumed manifestly incorrect requirements or applied correctly recognized requirements manifestly incorrectly. Neither is the case. The District Court followed the case law of the Federal Supreme Court (BGH) and understood the requirements of this case law correctly in principle. The application of the specifications to the individual case at hand is not objectionable in the rough review that is currently required alone. When considering the question of the defendant's required (continued) willingness to license, the District Court took into account in particular the defendant's conduct before and outside of court as well as during the proceedings, and made its determination of unwillingness to license on the basis of a comprehensible, detailed overall assessment, taking into account the requirements of good faith.

(1)

The District Court first looked at the - undisputed - pre-trial conduct of the defendant or its "parent company" (hereinafter also: "A.") following the infringement notice in the letter of February 13, 2017. It found that A. did not comment orally or in writing on this or on the plaintiff's offer to conclude a bilateral license agreement. Furthermore, the District Court found that there was no reaction from A. also to the subsequent letter from the pool administrator (B. C.) dated April 13, 2017, with which A. was made an offer to conclude a standard pool license agreement. According to the District Court's findings, the same applies to the further letter from D. dated 11.10.2019, in which reference was made to the infringement notice and the bilateral portfolio license offer from 2017. Insofar as there were personal meetings of the negotiating parties in the period from February 2017 to October 2019, the defendants have, according to the unchallenged findings of the District Court, not presented any evidence from which anything could be inferred for their willingness to license (LG judgment, p. 51/52).

According to the further - likewise unchallenged - findings of the District Court, A. did not comment on the infringement notice for the first time until more than three years (!) after the infringement

notice in a letter addressed to D. dated June 17, 2020 and in a letter addressed to B. C. dated August 17, 2020 regarding the infringement notice as well as the plaintiff's bilateral license offer and the pool license offer. According to the District Court's assessment of the facts, however, despite the declarations of willingness to license contained in the letters, there are no indications that A. was actually willing to negotiate after several years of inactivity. Rather, the content of the letters expresses behavior on the part of A. that was aimed at further delaying the contract negotiations. The parent company essentially asserted deficiencies in information, and the letters in question did not indicate any constructive contribution to the contractual negotiations on the bilateral license offer or the pool license offer. With regard to the aspects in respect of which A. complained about lack of information, these were to a large extent aspects on which D. and B. C. had already acted, which had arisen for the first time or again only because the parent company had not responded to the infringement notice from 2017 or the license offers, or with regard to which it already had knowledge or could at least have obtained such knowledge. In its judgment, the District Court explained this in detail in a comprehensible and plausible manner (LG judgment, pp. 52-56). Its assessment in this regard does not reveal any legal errors, and the defendants do not point to any such errors in their motion to dismiss. Accordingly, the defendants have not presented themselves for years, either before or outside of court, as being willing or able to obtain a license.

(2)The District Court then dealt with the defendants' conduct in the context of the present infringement dispute (District Court judgment, pp. 57-68). It assessed this conduct to the effect that the defendants had not attempted to bring about a constructive exchange within the meaning of Federal Supreme Court (BGH) case law, even in the course of the trial. Rather, the defendants had continued their conduct aimed at delaying the trial. With equally detailed reasons, the District Court came to the conclusion that with regard to the defendants, the overall picture shows user behavior that was initially characterized by simply ignoring attempts to initiate contractual negotiations. There was no reaction at all until after the complaint had been filed, and there was also a lack of constructive cooperation in the subsequent period aimed at the conclusion of a license agreement. Taking this into account, special efforts were required on the part of the defendant - in accordance with the requirements of the Federal Supreme Court (BGH) - to promote the conclusion of a license agreement and thus to express that a willingness to license had now arisen. However, such efforts were not expressed in the counter-offer of March 13, 2021, which is why A. must still be considered unwilling to take out a license at the end of the oral proceedings (LG judgment, p. 75/76).

The Senate is not able to establish that this assessment based on an overall weighing - on the basis of the case law of the Federal Supreme Court (BGH) - is manifestly incorrect in the result. On the contrary, on the basis of the aforementioned case law, the finding that the defendants have not made sufficient constructive efforts, also procedurally, which now indicate the necessary willingness to license and (can) lead to a speedy conclusion of a license agreement on FRAND terms, is comprehensible and in any case justifiable.

(2.1)

First of all, the assessment of the defendants' conduct up to the provision of the license agreements (LG judgment, pp. 57-59), the submission of which the parent company had requested for the first time in a letter dated June 17, 2020, more than three years (!) after the infringement notice, does not reveal any evident legal errors. Insofar as the District Court also referred in this context to the fact that the defendants for their part, even without knowledge of the existing license agreements, could in any case have commented on their price expectations and on the order of magnitude in which they could take a license without competitive impairment, it is irrelevant here from what point in time such a user willing to take a license can regularly be expected. In any case, it is certain that A. did not request the submission of license agreements at all until more than three years after the notice of infringement and that, on the basis of the District Court's findings, the defendants (or A.) themselves did not make any constructive and targeted efforts to conclude a license agreement on FRAND terms. On the basis of the case law of the Federal Supreme Court (BGH) referred to by the District Court, however, the defendants were required to make increased efforts to contribute to the conclusion of a corresponding license agreement as soon as possible, notwithstanding their failure to do so. They should now have clearly and unambiguously stated their willingness to license. In any case, such a declaration or increased effort to cooperate cannot be seen in a request for the submission (and explanation) of license agreements made several years later.

(2.2)

In its further assessment of the defendants' conduct, the District Court reproaches them with the fact that, after inspecting the license agreements made available by the plaintiff in an electronic data room in the course of the legal dispute, they still essentially relied on the fact that the plaintiff had not complied with its obligations to submit and explain the documents, without dealing with the content of the documents submitted in a constructive manner and to the extent possible for them. In this respect, the defendants must admit that this allegation can be made in connection with the following statements of the District Court in the contested judgment (District Court judgment, p. 61: "*In particular, it was possible for the defendants to provide information on the actual sales figures of the licensees that were covered by the agreed ... lump sums, on the basis of market data obtained from third-party suppliers. ...*") can be understood to mean that the defendants did not deal at all with the license agreements made available for inspection on the basis of available market data from third-party providers, such as "E.". In fact, however, as Defendants have detailed and substantiated in their Motion to Quash, Defendants have certainly provided certain data or sales figures on individual licensees in their writs dated January 11, 2021 and March 15, 2021, and have addressed them with respect to the relevant license agreements. This concerns the bilateral license agreements with F. (1), G., H., I. and J. as well as the pool licenses with K. and L.. The defendants have also provided data on pool licensee 2. Even though the District Court did not deal with this or at least did not deal with it in more detail, the allegation remains that the defendants - despite increased efforts to be expected from them - did not make constructive efforts in the course of the legal dispute to bring about a license agreement on FRAND terms (be it a bilateral license agreement, be it a pool license agreement) and did not promote the conclusion of such an agreement in an appropriate manner. Apart from that, the District Court's accusation that the defendants did not deal with market data is only *one* aspect of the District Court's chain of reasoning.

(2.3) Insofar as the defendants object in their motion to discontinue that the District Court considered their denial with ignorance with regard to the contractual relationships of the plaintiff with the licensees K. and L. (3) to be inadmissible, it can be left open here whether such a denial was admissible purely procedurally under Section 138 (4) Code of Civil Procedure (ZPO). In this context, the District Court was apparently concerned with evaluating the defendant's (negotiating) conduct relating to the conclusion of a license agreement and examining whether this was "constructive", i.e. whether it (properly) promoted the conclusion of a license agreement. As far as this "negotiation side" is concerned, it is obvious that it cannot be considered constructive in this sense if a patent infringer, from whom additional efforts are to be expected according to the concrete circumstances of the individual case in order to contribute to the conclusion of a license agreement on FRAND terms as soon as possible, simply limits himself to contesting the patent owner's factual submissions in the lawsuit, but does not make the attempt to quickly seek talks with the patent owner and to enter into concrete and serious negotiations with him. The latter also applies to the defendant's denial concerning other pools ("Access Advance Pool" for "M."; "Sisvel Pool" for "N."; "Mobile Communication Pool" from O.; "LTE Pool" of B. C.). In this regard, the District Court may have overlooked the fact that the defendants did not dispute with ignorance the "fee structures" of the pools in question, but rather the fact that the publicly available fees are actually demanded and paid in this way. In this respect, too, however, it is immediately apparent that it is not constructive in the sense of the case law of the Federal Supreme Court (BGH) if the infringer restricts itself to disputing practically everything that can somehow be disputed in the proceedings, even if it is of course permitted to do so in purely procedural terms.

(2.4) To the extent that the defendants also counter the District Court's reproach that they, for their part, could in any case have commented on their price expectations even without knowledge of the existing license agreements (see above), the District Court did not expressly address the relevant statements of defence of the defendants with reference to the pool licensing regarding "P./H.264" and "M./H.265". However, it is neither shown nor evident that the relevant statements in the writs can be seen as a constructive contribution to license agreement discussions, especially since the defendants are apparently not even interested in an AAC pool license. Apart from that, the defendants' communication of their own price expectations, which was criticized by the District Court, is also only an argument of the District Court in connection with the discussion of the order for production requested by the defendants (LG- Urt., p. 58).

(2.5) The District Court's further assessment of the defendant's conduct in the course of the proceedings following submission of the license agreements (District Court judgment, pp. 63-65) does not reveal any obvious legal errors. Insofar as the District Court assumed in this respect that there was a lack of connecting factors for a serious effort on the part of A. to conclude a license agreement, this appears to be correct.

(2.6) The defendants unsuccessfully complain that the District Court did not make any findings as to whether the plaintiff's license offer complies with FRAND criteria. On the basis of the case law of the Federal Supreme Court (BGH) applied by the District Court, there is no evident legal error in this respect. According to this case law, the infringer, to whom the patent owner has made a contractual offer despite the lack of willingness to license, must deal with this offer in a way that

already complies in every respect with the requirements of the contract to be concluded for fair, reasonable and non-discriminatory conditions of use of the contractual property rights (Federal Supreme Court (BGH), GRUR 2021, 585 recital 72 - FRAND Objection II). According to the Federal Supreme Court (BGH), if the patent owner - as here the plaintiff according to the findings of the District Court - has made an (at least essentially complete) contractual offer to the infringer despite the infringer's unwillingness to license, the fact that the patent owner's offer treats the infringer worse than other licensees, e.g. with regard to the amount and calculation of the royalties, without any objective justification, does not in itself constitute an abuse of the dominant position (BGH, GRUR 2021, 585 recital 108 et seq. - FRAND-Einwand II).

(2.7) The fact that the District Court did not consider the parent company's counter-offer of March 13, 2021, which was submitted only ten days (!) before the main hearing date, to be an expression of a now existing willingness to license, taking into account the defendant's previous conduct (District Court judgment, pp. 66-68), is also not evidently incorrect.

The District Court assumed that this license offer - submitted quasi "at the last minute" - which, with regard to the assessment of the lump sum license fee, is based on the bilateral license agreement concluded between D. and I., which, according to the plaintiff, was concluded in the course of a legal dispute in India, cannot be interpreted as an expression of a now existing willingness to license based on A.'s previous conduct, irrespective of the question whether this offer proves to be in compliance with FRAND in all respects. In any case, the parent company could not have assumed that the counteroffer could have properly promoted the conclusion of a license agreement on FRAND terms, i.e. that it was a suitable basis for negotiation. The District Court justified the latter in two respects. On the one hand, A. disregarded the reasons put forward by the plaintiff for a justified unequal treatment of licensee I. in comparison with A.. In this regard, it is irrelevant whether the defendants can dispute the facts put forward by the plaintiff in a procedurally admissible manner with ignorance. From the point of view of seriously negotiating contracting parties, the parent company's conduct was such that it completely ignored the reasons put forward by D. and applied this contract, which was particularly favorable to it, without looking at it. Secondly, the explanation of the counter-offer also lacked any presentation of the sales volumes achieved in the past, so that the plaintiff was deprived of any assessment as to whether comparable constellations existed between I. and A. in this respect and whether a complete waiver of compensation for acts of use prior to the entry into force of the agreement was also appropriate in the relationship with A.. The concerns with regard to the contract with I. as a reference for a counteroffer by the parent company were reinforced by the fact that there were no reliable sales figures on the basis of which A. calculated the lump sum to be paid by it.

Upon summary examination, these considerations appear at least justifiable and plausible in principle. This applies in particular to the District Court's assumption that a patent owner with an agreement on a lump sum license has a justified interest in the submission of actual sales figures by the infringer, who has so far been unwilling to grant a license, and in this respect does not want to be satisfied with available market data, such as E. figures. This applies in particular if the lump

sum license amount is also intended to cover all acts of use in the past and if acts of use committed over many years are in question in this respect.

Insofar as the defendants claim that the District Court should not have denied their willingness to license without determining whether the counter-offer complies with FRAND criteria, such an examination is precisely not mandatory according to the case law of the Federal Supreme Court (BGH). According to this case law, in the case of an offer of a license agreement by the infringer, the infringer's willingness to conclude a license agreement on FRAND terms can be negated irrespective of whether this offer in itself meets FRAND criteria (see Federal Supreme Court (BGH), GRUR 2021, 585 recital 102 - FRAND-Einwand II).

(2.8) The fact that the parent company's counteroffer was not (yet) rejected by a representative of the plaintiff authorized to do so at the hearing on May 23, 2021 is irrelevant. Apart from the fact that a final examination of the offer submitted a few days previously was recognizably hardly seriously possible for the plaintiff up to the hearing date, the plaintiff's legal representative had already stated at the hearing that the counter-offer was not acceptable in the state in which it was now, i.e. at the time of the oral hearing. Therefore, a rejection of the counteroffer by the plaintiff was to be expected. A rejection of the counteroffer then also undisputedly took place by e-mail dated April 6, 2021. In addition, it should be noted that a rejection of a counter-offer (alone) does not allow a valid conclusion to be drawn as to the willingness of an infringer to license.

(2.9) The fact that the District Court did not refer in the reasons for the contested judgment to the bank guarantee in favor of the plaintiff in the amount of ... EUR in favor of the plaintiff does not mean that the contested judgment is obviously incorrect. In the decision "*FRAND-Einwand II*", the Federal Supreme Court (BGH) also did not attach any decisive importance to the fact that the defendants there linked a license offer to a security deposit - albeit considerably lower there (see Federal Supreme Court (BGH), GRUR 2021, 585 recital 105 et seq. - FRAND-Einwand II).

(3)

Finally, the District Court's comments on the plaintiff's FRAND licensing readiness (District Court Judgment, 68-75) also do not reveal any obvious errors of law.

(3.1)

The District Court's failure to examine whether the plaintiff's license offer actually complies with FRAND conditions does not - as explained - constitute a manifest error of law. The defendants themselves point out that the omitted examination is a consequence of the District Court's approach - which they regard as erroneous in law. However, this legal approach is in line with the case law of the Federal Supreme Court (BGH).

(3.2)

The District Court comprehensively assessed the plaintiff's conduct. It came to the conclusion that the plaintiff had not shown itself to be unwilling to license according to the standard established by the Federal Supreme Court (BGH), which it in turn explained in detail. For example, the District Court noted, among other things, that the plaintiff responded to the parent company's out-of-court letter of June 17, 2020, by letter of July 16, 2020, that the relevant license agreements were

submitted by the plaintiff within a reasonable period of time after the conclusion of the NDA agreement with the parent company, and that the plaintiff explained the lump sum license amounts agreed in the submitted bilateral license agreements using E. figures and submitted facts which are in principle suitable to objectively justify unequal treatment to a certain extent. It also took into account the fact that A.'s pool license offer was also a contractual offer that had been accepted in this form by other market participants and that gave it an opportunity to gain access to the technology. Finally, the District Court also noted in this context that the plaintiff has indicated in different contexts a willingness to adapt contract terms to the defendants. The defendants do not address this overall assessment of the conduct of the plaintiff and the pool administrator - which is comprehensible and plausible at first glance - in their motion to dismiss. Rather, they challenge the District Court's statements only selectively. Whether they are successful in their attacks in this regard and whether these can ultimately change anything at all in the result found by the District Court is reserved for closer examination in the further course of the appeal proceedings.

With regard to the aspects raised by the defendants in this context, the following should also be noted:

(3.2.1) Whether the plaintiff would have been required to also submit the license agreements with 5 and 4 is not to be decided in the hiring procedure. In this respect, the District Court correctly assumed, at least in approach, that, as far as the claim for injunctive relief is concerned, in principle only the active license agreements are relevant, while license agreements that have already expired must be disregarded because they cannot have any effect on the competitive situation of the competitors (Düsseldorf Higher Regional Court [2nd ZS], Judgment of. March 22, 2019 - I-2 U 31/16, GRUR-RS 2019, 6087 recital 123 - Improving Handover). All other disputes in connection with this will have to be decided only in the further appeal proceedings - if this should be relevant for the appeal decision to be made by the Senate.

(3.2.2) The fact that the license agreement with 4 had not yet been terminated at the time of the submission of the license agreements, based on the information provided by the plaintiff in its writ of April 15, 2021, which has not been supplemented, was taken into account by the District Court in its decision, as was the fact that the plaintiff had initially argued in writing that all standard licensees would pay the same ongoing license fees that had also been offered to the defendants (District Court judgment, p. 73). Insofar as the defendants object to the fact that the District Court considered these corrections to be harmless in each case as a result, this criticism of the District Court's assessment of the facts cannot justify a discontinuation order due to a manifest error in the contested decision. Particularly in light of the fact that the plaintiff submitted a large number of third-party license agreements in the course of the legal dispute or posted them in an electronic data room and that it named six specific pool license agreements that contain provisions that deviate from the standard pool license agreement, it seems plausible to the Senate in any case that the District Court did not conclude from the circumstances stated at the beginning that the plaintiff was "unwilling to license".

(3.2.3) Insofar as the District Court denied hesitant behavior on the part of the plaintiff in connection with the submission of the third-party license agreements (LG judgment, p. 70 f.), the statements made in this regard do not reveal any legal errors.

b) That an execution from the provisionally enforceable District Court judgment would lead to extraordinary damages for the defendants, which would not be recovered or at least not with the help of the previously provided security, is neither conclusively shown nor made credible.

Suspension of compulsory enforcement on the grounds of imminent non-compensable damage is generally only possible if the creditor is unable to satisfy the debtor's claim for damages under section 717 of the Code of Civil Procedure (ZPO) and no security has been set in the judgment at first instance (section 708 nos. 1 to 9 and 11 of the Code of Civil Procedure (ZPO)). If, on the other hand, the court of first instance has - as here - declared the contested judgment provisionally enforceable only against the provision of security, the damages threatened by the compulsory enforcement must be of such a nature that they cannot be covered by the provision of security, i.e. in the present case they must exceed the amount of EUR 700,000.00 set as security by the District Court with regard to the order to cease and desist, recall and destroy. In the case of a claim for injunctive relief due to patent infringement, the disadvantages regularly associated with compulsory enforcement and to be accepted by the debtor include the cessation of the prohibited infringing acts, including the economic losses caused thereby. The cessation of production and distribution of the challenged embodiment and the resulting loss of sales is therefore not sufficient for a cessation of enforcement, because this is the normal consequence of practically any enforcement of an injunction and therefore not an "irreplaceable disadvantage". In this respect, no special features apply to the field of patent law; in particular, an irreplaceable disadvantage threatened by enforcement of the injunction is not to be presumed or assumed under conditions facilitated in comparison to general civil law (cf. Düsseldorf Higher Regional Court [2nd ZS], decision of June 17, 2020 - I-2 U 20/20 with further references). The danger of a special damage, which clearly goes beyond the general enforcement effects, is in principle only to be affirmed if extraordinary, practically irreparable disadvantages are threatened, as in the case of a threatened destruction of the defendant's existence by the enforcement (see Federal Supreme Court (BGH), GRUR 2019, 1215 para. 8 - Dampfdruckverringderung; Düsseldorf Higher Regional Court, loc. cit.). In this context, the infringing defendant must present all facts substantiating its claim and make them credible (Düsseldorf Higher Regional Court, loc. cit.).

In the case in dispute, the defendants have already failed to provide sufficient factual information. The general assertion that they are threatened with irreparable damage to their customer relationships is insufficient.

c) Finally, a discontinuation order cannot be considered on the basis of a weighing of interests in favor of the defendant. In this context, it is irrelevant whether a further (comprehensive) weighing of interests should be carried out at all beyond the above examination and whether a discontinuation order would be possible in the case of overriding protective interests of the defendant. The mere fact that the parties are not in a competitive relationship is in any case not sufficient in this respect; it cannot in itself lead to the discontinuation of enforcement. There is no reason to treat a patent exploitation company per se differently than a competitor (Senate, BeckRS 2016, 1679 recital 12 with further references).

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