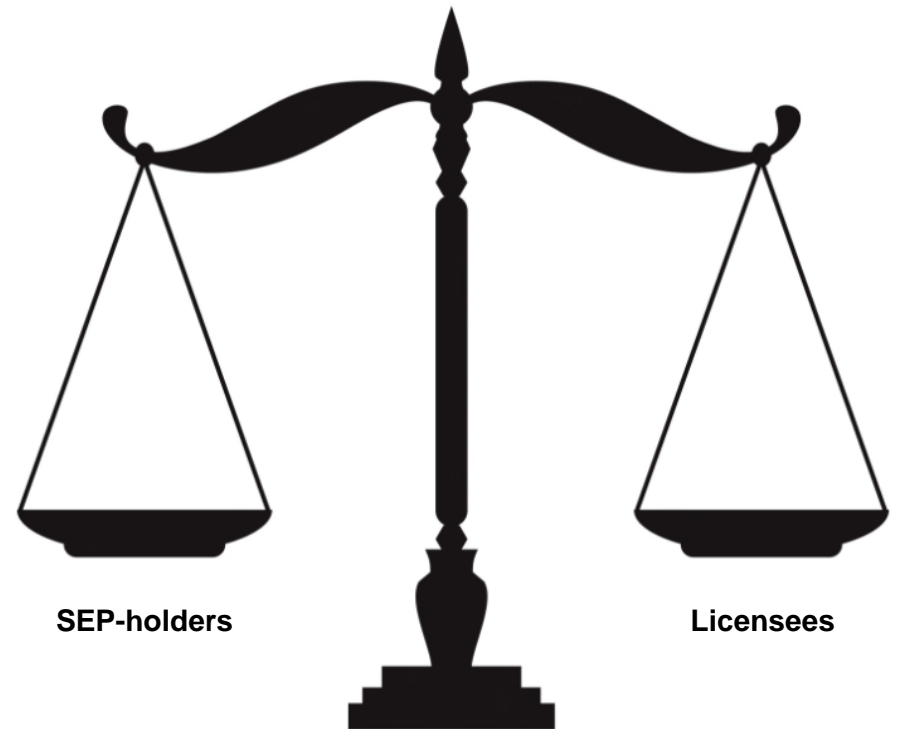
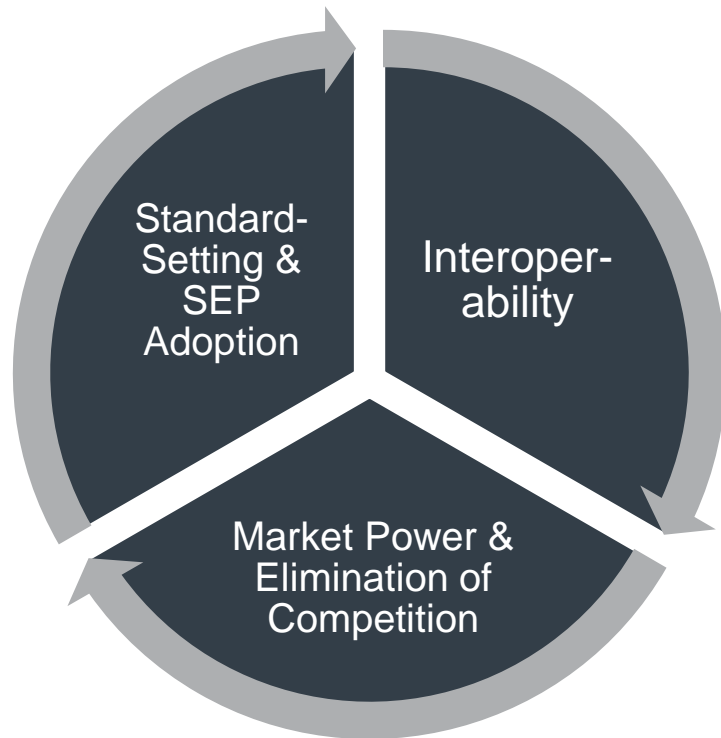


Overview on Standard Essential Patents Licensing Practices

Presentation for Joint NGMN/ITU Conference

John (“Jay”) Jurata, Jr.
Leader, Orrick Antitrust & Competition Group
January 29, 2019

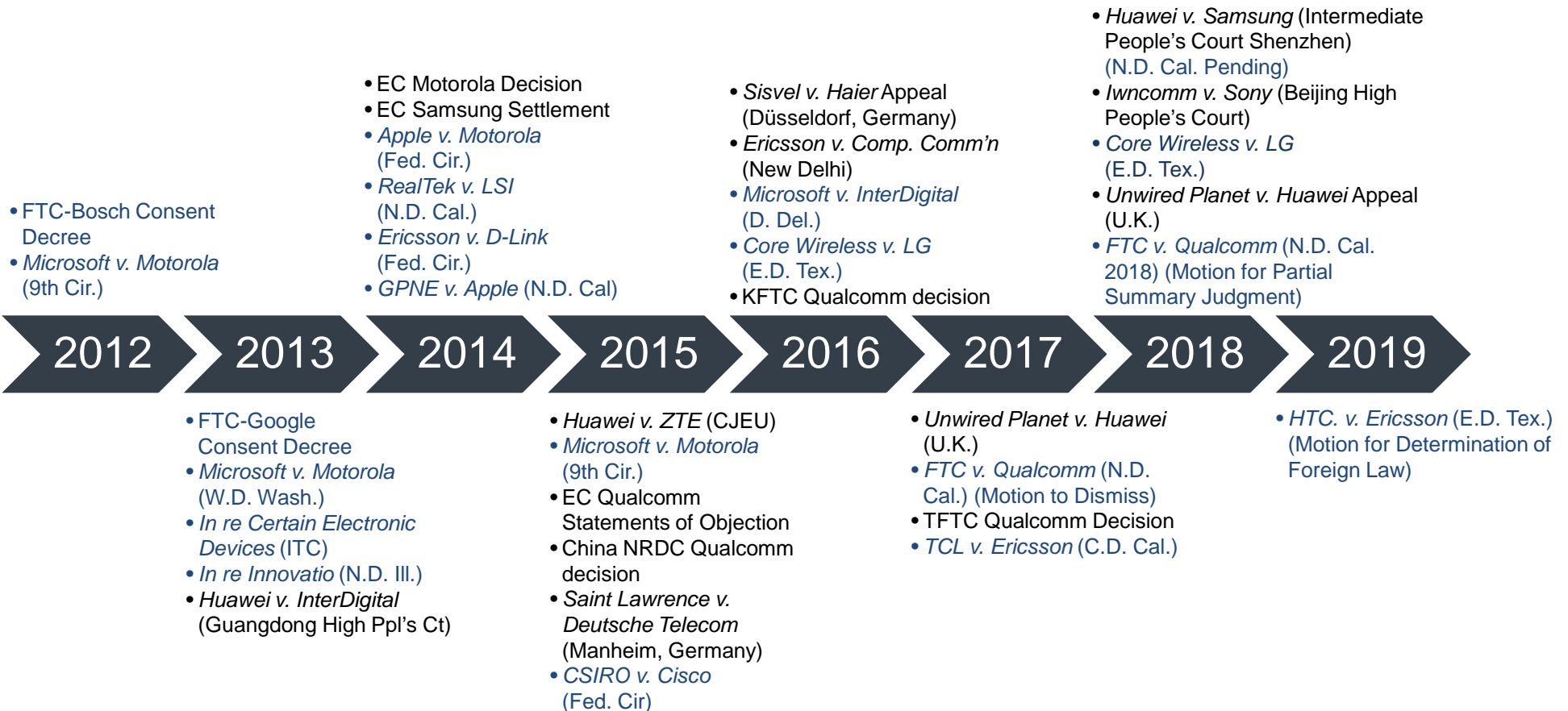




SEP-holders

Licensees

Major FRAND Cases & Enforcement Actions





FRAND promise

- Irrevocable
- Travels with the patent
- Enforceable by third parties under contract law

Injunctions for SEPs should be rare

- But no *per se* ban

FRAND royalties

- Should exclude any value added by fact of the standard's adoption
- Should factor in evidence of royalty stacking

“Good faith” behavior expected from both sides

- But challenging infringement and validity ≠ “unwilling” licensee

Reciprocity permissible, but limited to SEPs for same standard



Scope of “non-discriminatory” prong?

- What are “similarly situated” licensees?
- Refusal to license upstream component manufacturers?
- Authorizing Licensing Agents to license only end products?

Must license offer comply with FRAND, or only final license terms?

- And is FRAND a single rate, or a range?

Geographic scope for assessing “willing licensee” status?

- Limited to territorial jurisdiction of adjudicating court/agency, or worldwide?

SEP portfolio un-bundling as a mechanism to evade FRAND?

- Partial transfers to Patent Assertion Entities?
- Partial transfers to Patent Pool Licensing Agents?

Options for Resolving SEP Disputes



- FRAND adjudication litigation
- FRAND adjudication arbitration
 - International Chamber of Commerce
 - American Arbitration Association International Centre for Dispute Resolution
 - Japan Commercial Association of Arbitration
- Formal complaint to competition authorities

Contact Information



- John (“Jay”) Jurata, Jr.
- Practice Group Leader: Antitrust & Competition
- Washington, D.C.
- tel: 202.339.8504
- email: jjurata@orrick.com



Back-up slides



SEP Adjudication, 2009 – 2013



	Asserted	Invalid	Not Infringed	Withdrawn	Dismissed	Valid & Infringed
InterDigital	8	3	4	0	1	0
Motorola	16	2	4	6	1	3
Samsung	34	13	9	8	0	4
TOTAL	58	18	17	14	2	7

Source: Jurata & Smith, "Apples and Oranges: Comparing Assertions of SEPs and Differentiating Patents from an Antitrust Perspective," *CPI Antitrust Chronicle* (Mar. 2015)

SEP Adjudication, 2013 – 2017



SEP Owner	Asserted	Invalid	Not Infringed	Withdrawn	Dismissed	Valid & Infringed
Core Wireless	29	0	5	20	0	4
CSIRO	1	0	0	0	0	1
Ericsson	9	2	3	4	0	0
Golden Bridge Technology	1	0	1	0	0	0
GPNE	2	0	2	0	0	0
InterDigital	15	1	8	3	0	3
LSI, Agere	4	1	1	2	0	0
NXP	6	3	0	0	3	0
Samsung	3	0	1	0	2	0
Wi-LAN	1	1	0	0	0	0
TOTAL	71	8	21	29	5	8

Source: Jurata, Luken & Rose, “Between a Rock and a Hard Place”: Unwired Planet v. Huawei and the Dangerous Implications of Worldwide FRAND Licenses, *Concurrences* (Aug. 2017)



orrick

The logo features the word "orrick" in a white, lowercase, sans-serif font. The letter "o" is replaced by a stylized green circular graphic composed of two overlapping, slightly offset rings, creating a sense of motion or a globe. The entire logo is centered on a dark blue background.