

知产财经全媒体  
IP ECONOMY MEDIA

专业专注，更深一度

PROFESSIONAL FOCUS, DEEPER DEGREE

联系我们 Contact us

☎ 010-82896122

✉ IPE@ipeconomy.cn

✓ 知产财经原创精选

✓ 知产财经网站

✓ 知产财经微信公众号

✓ 知产财经线下会议

## 日本专利局标准必要专利许可谈判指南征求意见稿（译文版）

### GUIDE TO LICENSING NEGOTIATIONS INVOLVING

翻译人员（暨南大学法学院/知识产权学院研究生）：倪晓微、李旭仪、徐语秋、张燕（澳门科技大学硕士）、张雅宁、黎梁安琪、陈钜炜、邱静思、关佩仪、陈梦豪

指导教师：仲春（暨南大学知识产权研究院）

背景介绍：为了应对司法判例的难题积累和行业纠纷的问题凸现，2018年6月，日本专利局颁布了《标准必要专利许可谈判指南》，并根据专利现状发展不断进行审查改进。东京时间2022年5月9日，日本专利局在其官网上征求公众对《标准必要专利许可谈判指南》草案的意见，征集各方意见以完善该草案，并呼吁各方在2022年6月8日（日本时间）18:00之前提交。这次主要是对2018年日本专利局所发布的谈判指南的修改方案进行意见征集。

为了让读者更详实地了解“征求意见稿”的内容，知产财经联合暨南大学就“征求意见稿”英文版进行了翻译，以飨读者。

## TABLE OF CONTENTS / 目录

<b>I. Purpose of the Guide / 一、指南的目的</b> .....	<b>4</b>
A. SEP Issues and Background / A. SEP 问题和背景 .....	4
B. Nature of this Guide / B. 本指南的性质 .....	10
<b>II. Licensing Negotiation Methods / II. 授权许可谈判方法</b> .....	<b>16</b>
A. Good Faith / 善意 .....	16
1. Step 1: Licensing Negotiation Offer from Rights Holder / 第一步: 专利权人提出的许可谈判要约 .....	21
2. Step 2: Expression from Implementer of Willingness to Obtain a License / 第 2 步: 实施者对取得授权表达意愿 .....	28
3. Step 3: Specific Offer from Rights Holder on FRAND Terms / 3.第 3 步: 专利权人根据 FRAND 承诺提出特定要约 .....	36
4. Step 4: Specific Counteroffer from Implementer on FRAND Terms / 4.第 4 步: 实施者基于 FRAND 承诺提出的反要约 .....	40
5. Step 5: Rejection by Rights Holder of Counteroffer/Settlement of Disputes in Courts or through ADR / 5.第 5 步: 专利权人拒绝反要约/透过法院或 ADR 的争议协议 .....	43
B. Efficiency / B.效率性 .....	50
1. Notification of a Timeframe / 1.通知谈判期程 .....	51
2. Parties to Negotiation in Supply Chain / 2.供应链谈判之主体 .....	53
3. Protecting Confidential Information / 保护机密信息 .....	62
4. Choice of Patents Subject to Negotiation / 作为谈判对象专利的选择 .....	66
5. Geographic Scope of Licensing Agreement / 许可协议的地域范围 .....	68
6. Patent Pool Licensing / 专利池授权 .....	72
7. Greater Transparency of SEPs / 提升标准必要专利的透明性 .....	74

<b>III. Royalty Calculation Methods / 1. 利润计算方法</b> .....	<b>75</b>
A. Reasonable Royalties / A.合理的许可许可费 .....	76
1. Basic Approach / 1.基本方法 .....	76
2. Royalty Base (Calculation Base) / 2.计费基数（计算基数） .....	78
3.Royalty Rate / 3.许可费费率(费率).....	84
4.Other Factors to Consider in Determining Rates / 4.决定费率的其他考虑因素	
91	
B. Non-discriminatory Royalties / 无歧视许可费 .....	95
1. Concept of Non-Discrimination / 无歧视的思考方法 .....	96
2. Royalties for Different Uses / 不同用途的许可费 .....	97
C. Other / 其他 .....	98
1. Fixed Rate and Fixed Amount / 固定利率和固定金额 .....	98
2. Lump-Sum Payment and Running Royalty Payments / 总额型许可费和浮动	
型许可费 .....	99
3. Past Component and Future Component / 过去的组成和未来的组成 .....	100
4. Volume Discounts and Cap (Paid-up) / 数量折扣和上限（已缴"paid-up"）	
101	
<b>Postscript / 附录</b> .....	<b>101</b>
<b>Reference / 参考内容</b> .....	<b>103</b>

## I. Purpose of the Guide / 一、指南的目的（翻译人员：倪晓微）

### A. SEP Issues and Background / A. SEP 问题和背景

*(Changes in Relation to Standards and Patents) / (关于标准和专利的变化)*

The Guide to Licensing Negotiations involving Standard Essential Patents (“this Guide”) aims to enhance transparency and predictability, facilitate negotiations between rights holders and implementers, and help prevent or quickly resolve disputes concerning the licensing of standard essential patents (“SEPs”), which are the patents essential in implementing standards in the field of wireless communications and the like.

涉及标准必要专利的许可谈判指南（“本指南”）旨在提高透明度和可预测性，促进专利权人和实施者之间的谈判，并帮助预防或快速解决有关标准必要专利（“SEPs”）许可的争议，这些专利主要是在无线通信等领域实施标准所必需的专利。

While a patent granting exclusive rights to a technology as compensation for disclosing an invention and a standard designed to spread a technology as widely as possible both help to promote innovation, the seeming contradiction between them also often gives rise to tension. That tension first became evident in the 1990s when telecommunications technologies started shifting to digital formats, accompanied by a trend toward standardizing the latest technologies even while protecting them with patents, resulting in SEP disputes.

作为公开发明的补偿而对技术授予排他权之「专利」，与让技术尽可能广泛地普及之「标准」，都对促进创新有所贡献，虽然「专利」与「标准」看似矛盾，但两者之间也常存在紧张关系。自 1990 年代电信技术开始转向数字化以来，这种紧张关系开始明显，“用专利保护最新技术的同时使得最新技术标准化”这一趋势导致了有关 SEP 的争议。

With respect to SEP disputes, two issues which many are concerned about are

“hold-up” and “hold-out,” and there is controversy between rights holders and implementers over which of the two is more serious.

关于 SEP 争议，许多人关心的两个问题是“劫持(hold-up)”和“反向劫持(hold-out)”，从专利权人和实施者从各自的立场来看，两个问题哪一个较为严重存在争议。

“Hold-up” is a situation whereby businesses using SEPs are forced to accept disadvantageous terms of license due to the threat of injunction for infringement of patent rights after the companies are locked into using a standard. Legal precedents across the world seem to be converging toward permitting injunctions concerning FRAND-encumbered SEPs (i.e., SEPs for which a FRAND declaration has been made) only in limited situations. However, in cases when either party negotiates in bad faith, courts have continued to grant injunctions, and it can be said that hold-up remains an issue for implementers. Nonetheless, some doubt whether there is any hold-up.

“劫持”是指使用 SEPs 的企业在为了企业发展而不得使用某一标准之后，因侵犯专利权的禁令威胁而被迫接受不利许可条款。世界各国的判决先例似乎正在趋向只有在有限的情况下才准许已作出 FRAND 宣告的 SEP（即有 FRAND 声明的 SEPs）的禁令的核发。但是，在任何一方恶意谈判的情况下，法院会继续发布禁令，对于实施者来说，劫持仍然是一个问题。尽管如此，有些人仍怀疑劫持是否真的存在。

On the other hand, rights holders point to the issue of “hold-out,” whereby the rights holder makes an offer for licensing negotiations to the implementer, but the implementer fails to engage in negotiations in good faith by rejecting or delaying licensing negotiations, in anticipation that an injunction will be denied on SEPs.

另一方面，专利权人指出了“反向劫持”的问题，即专利权人向实施者提出许可谈判的要约，但实施者通过拒绝或延迟许可谈判而未能善意地参与谈判，因为其预计专利权人要求核发 SEPs 的禁令会被拒绝。

Standards setting organizations (“SSOs”) have formulated policies concerning

SEPs (“IPR policy”) designed to prevent disputes and promote the widespread use of the SEPs necessary for implementing technical standards. SSOs have endeavored to develop policies to ensure that SEP licenses are “fair, reasonable and non-discriminatory” (“FRAND”). This policy has encouraged companies and other parties participating in standardization to propose high-quality technologies to SSOs and has made a substantial contribution to the widespread adoption of standard technologies.

标准制定组织（“SSOs”）制定了 SEPs 规则（“知识产权政策”），旨在防止争议及促进广泛使用实施技术标准所必需的 SEPs。SSOs 努力制定规则以确保 SEP 许可是“公平、合理和非歧视性的”（“FRAND”）。这促进参与标准化的公司和其他各方向 SSOs 提出高质量的技术，并为标准技术的广泛采用做出了重大贡献。

At the same time, there is a strong call for enhancing transparency in relation to the essentiality and validity of SEPs. For some SSOs,<sup>1</sup> if rights holders consider their patents are SEPs during the standardization process, they need to declare their patents as SEPs to SSOs, but in such cases, some might overdeclare their patents as SEPs, including patents that are not actually essential. It is normal to declare patents as essential when they are still in the application phase and when the standard is not itself settled. A certain amount of overdeclaration is therefore inevitable.. Some point out that such overdeclaration has been encouraged at least partly by the industry practice of determining royalties at least partly in proportion to the number of SEPs out of the total number held in relation to a certain standard.

同时，也有强烈的呼声呼吁提高 SEPs 的必要性和有效性相关的透明度。如果专利权人在标准化过程中认为他们的专利是 SEPs，他们需要向 SSOs 对此进行声明，但一些专利权人可能会故意将他们的实际上并不是必要的专利，作为 SEPs 声明给 SSOs。<sup>2</sup>在申请阶段和标准尚未确定时，将专利声明为必要专利是很普遍的。因此，一定程度的过度声明是不可避免的。有人指出，依据持有的 SEPs 在

---

<sup>1</sup> For example, the International Telecommunication Union (ITU).

<sup>2</sup> 例如，国际电信联盟 (ITU)。

整个标准包含的所有 SEPs 中所占的数量比例来决定专利许可费的行业惯例在一定程度上助长了这种过度声明。

SSOs typically do not check whether the patents declared by the rights holder as essential are in fact essential, or whether changes made to technical specifications during the standard creation process have made a patent inessential. In addition, there is no routine third-party review process at the stage of listing the declared patents.

SSOs 通常不会检查专利权人宣布为必要的专利是否实际上是必要的，或者在标准创建过程中对技术规范所做的更改是否使专利变得无关紧要。此外，在宣称标准必要专利的过程中没有常规的第三方审查程序。

*(Paradigm Shift in Licensing Negotiations)* (许可谈判的变化)

The spread of the Internet of Things (“IoT”) in recent years has spurred a fourth industrial revolution across the world whereby various types of infrastructure and devices are connected via the Internet, and this trend is transforming licensing negotiations for the SEPs required to implement standards related to wireless communication among devices.

近年来物联网 (“IoT”) 的普及，推动了全球第四次工业革命，各种类型的基础设施和设备通过互联网连接，这一趋势正在改变实施与设备间无线通信相关的标准所需的 SEPs 的许可谈判。

SEP licensing negotiations in the Information and Communication Technology (“ICT”) field traditionally took place chiefly among ICT companies. Therefore, issues were commonly resolved through cross-licensing, and the practice was to conduct negotiations as necessary after the start of a service. In addition, coming from the same industry made it easier for the parties to assess the scope, essentiality, and value of each other’s patents, so they tended to share a similar perspective on reasonable license rates.

由于信息和通信技术 (“ICT”) 领域的 SEP 授权谈判，传统上主要在 ICT 公司之间进行，因此，通常通过交叉许可来解决问题，惯例是在开始进行服务之后



必要时再进行谈判。此外，来自同一行业的双方更容易评估彼此专利的范围、必要性和价值，因此他们往往对合理的许可费率有相似的看法。

With the spread of IoT, however, companies from a whole spectrum of different industries have begun using ICT standards, and more companies have been brought to the negotiating table. Also, some companies that do not hold SEPs are entering the market. For example, in addition to those telecommunications companies holding SEPs, negotiations may now involve end-product manufacturers, such as automobile makers, , as a main implementer of standard technology. In the future, companies from other industries may be involved in SEP licensing negotiations.

然而，随着物联网的普及，各行各业的公司都开始使用 ICT 标准，越来越多的公司被带到了谈判桌前。此外，一些不持有 SEPs 的公司正在进入市场。例如，除了那些持有 SEPs 的电信公司，谈判现在可能涉及终端产品制造商，如作为标准技术主要实施者的汽车制造商。未来，其他行业的公司可能会参与 SEP 许可谈判。

Further, there are now cases in which Patent Assertion Entities (“PAEs”) that are not engaged in business operations but rather generate revenue solely by asserting patents also become party to negotiations and disputes concerning SEPs.

此外，现在有些情况下，不从事业务运营而是仅通过主张专利来产生收入的专利主张实体（“PAEs”）也成为有关标准必要专利的谈判和争议的一方。

As the parties to licensing negotiations become more diverse, various aspects of those negotiations too are changing. As noted above, with licensing negotiations now taking place between ICT companies and companies in other industries, it is becoming harder to resolve disputes through cross-licensing. In addition, divergent perspectives on essentiality and licensing rates are fostering unease over SEP-related negotiations and disputes.

随着许可谈判的各方变得更加多样化，这些谈判的各个方面也在发生变化。如上所述，现在 ICT 公司与其他行业的公司之间正在进行许可谈判，通过交叉许可解决争议变得越来越困难。此外，对必要性和许可费率的分歧观点正在加剧

SEP 相关谈判和争议的不安。

*(Motivations for Creating this Guide)* (创建本指南的动机)

With companies from a broad spectrum of industries now finding themselves involved in SEP licensing negotiations, there is a call for appropriate information to be provided to enable businesses not familiar with such negotiations to feel confident taking a seat at the negotiating table.

由于各行各业的公司现在都参与了标准必要专利许可谈判, 因此需要提供适当的信息, 以使不熟悉此类谈判的企业能够安心地进行谈判。

A considerable body of domestic and international legal precedents has begun to be accumulated in relation to SEP disputes, and government agencies around the world are developing guidelines and policy documents.<sup>3</sup>The concept of FRAND royalties too has been examined in a number of legal cases.

随着国内和国际与 SEP 争议有关的案例不断累积, 世界各地的政府机构正在制定指导方针和政策文件。<sup>4</sup>有关以 FRAND 承诺支付许可费的思维方式也在一些司法案例中被检验。

It would be useful to analyze these developments and identify elements that should be considered to achieve a balance between the interests of rights holders and implementers with respect to negotiation procedures and methods of calculating royalty rates.

分析这样的演进过程, 并在谈判程序和计算专利许可费的过程中, 找出为衡

---

3 In November 2017, the European Commission announced the European Commission Communication on Standard Essential Patent (SEP) Licensing (below, European Communication), urging SSOs to increase SEP transparency and indicating general principles in relation to FRAND licensing terms for SEPs. In February 2022, the European Commission commenced public consultation for the new initiative named “new framework for standard-essential patents”, which will build upon three policy pillars, i.e., “enhancing transparency on SEPs”, “providing clarity on various aspects of FRAND” and “improving effectiveness and efficiency of enforcement”.

4 2017 年 11 月, 欧盟委员会公布了关于 SEP 许可的欧盟委员会通讯(以下, 欧洲通讯), 敦促 SSO 提高 SEP 的透明度, 并说明与 SEP 的 FRAND 许可条款相关的一般原则。2022 年 2 月, 欧盟委员会开始对名为“SEP 新框架”的新倡议进行公众咨询, 该倡议将建立在三个政策支柱之上, 即“提高标准必要专利的透明度”、“明确 FRAND 的各个方面”和“提高执法的有效性和效率”。

平专利权人和实施者之间的利益所应考虑的因素，对整体发展来说是有益的。

## **B. Nature of this Guide / B. 本指南的性质**

The SEPs addressed in this Guide are those which the current or original rights holder has presented to an SSO as a FRAND-encumbered SEP.

本指南中涉及的 SEPs 是当前或原始专利权人对 SSO 已作 FRAND 承诺的专利。

This Guide is not intended to be prescriptive, is in no way legally binding, and does not forejudge future judicial rulings. It is intended to summarize issues concerning licensing negotiations as objectively as possible based on the current state of court rulings, the judgment of competition authorities, and licensing practices, etc.

本指南的目的不是设定规范，绝不具有法律约束力，也不预判未来的司法裁决。旨在根据法院判决现状、竞争当局的判断、许可实践等，尽可能客观地总结许可谈判的各种论点。

When an injunction concerning a FRAND-encumbered SEP due to the infringement is limited, the legal basis varies from country to country according to their respective legal systems. Meanwhile, in many cases, it seems to have been different factual situations that have led courts in different countries to reach different conclusions. Recent years have seen increasing cross-border convergence in case law as to how parties should behave in SEP licensing negotiations based on the dedication to a factual inquiry into good faith negotiations.

当因侵权而使受 FRAND 保护的 SEP 的禁令受到限制时，其法律依据因国家/地区而异，这具体取决于其各自的法律制度。同时，在一些情况下，似乎是不同的事实情况导致不同国家的法院得出不同的结论。近年来以彻底探究是否善意谈判的事实情况作为基础，当事人应该如何就 SEP 授权进行谈判的观点，国内外的法院判决都有接近的趋势。

In these circumstances, this Guide aims to offer an explanation of what actions companies can take to make it more likely for them to be recognized as “negotiating

in good faith,” helping implementers to avoid an injunction and rights holders to secure appropriate compensation. This Guide also discusses how to engage in such negotiations efficiently.

在这些情况下，本指南试着说明关于采取哪些措施，可以被认为是“善意谈判(negotiating in good faith)”，以便实施者可以回避禁令，且专利权人可以获得适当的补偿对价，此外，本指南还讨论如何有效率地进行此类谈判。

In addition, this Guide presents factors to be considered when determining a reasonable royalty, but it is not “recipes” which can be used to automatically calculate an appropriate royalty. In other words, a solution cannot mechanically be produced by simply following this Guide. Given the diversity of SEP licensing negotiations and of the circumstances in which the parties to such negotiations are placed, a solution has to be worked out in each particular case. Not all the issues noted in this Guide will apply to all negotiations.

此外，本指南提出了在确定合理的专利权许可费时需要考虑的因素，而不是可自动计算许可费的“配方”。换句话说，仅仅遵循本指南无法机械地产出解决方案。因为 SEP 授权谈判的多样性以及谈判各方的情况不同，每个特定案例都必须要有各自的解决方案，本指南中提到的所有问题并非都适用于所有谈判。

### **C. Recent Developments in SEPs and Background to Revision / C. 标准必要专利的最新发展和修订背景**

At the time when this guide was first developed in 2018, attention was focused on the preliminary ruling by the European Court of Justice (CJEU) in the case of Huawei v. ZTE, which provided a framework for good faith negotiations.<sup>5</sup> This guideline is also based on that framework for good faith (see II.A.).

在 2018 年首次制定本指南时，关注的焦点是欧洲法院 (CJEU) 对华为诉中兴案的初步裁决，该裁决为善意谈判提供了框架。<sup>6</sup> 本指南也是基于该善意的框架（见 II.A.）。

---

<sup>5</sup> Huawei v. ZTE (EU, CJEU, 2015).

<sup>6</sup> 华为诉中兴（欧盟，欧洲法院，2015 年）。

However, since this framework did not specify issues such as the scope of information to be provided by the parties at each stage of negotiations and the response period, there have been various discussions to date. For example, the European Court of Justice has not explicitly held, within the framework of good faith negotiations, whether the rights holder should provide a claim chart (see II.A.1.) to the implementer who is a party to the license negotiation.

然而，这个框架并没有提供关于谈判的具体细节，例如双方在谈判的每个阶段应该提出的信息包含哪些内容，以及作出回应的期间。迄今为止已经进行了各种讨论。例如，欧洲法院并未在善意谈判的框架内明确裁定专利权人是否应向作为许可谈判当事方的实施者提供侵权对照表（见 II.A.1.）。

On the other hand, the German Federal Supreme Court recognized, in its *Sisvel v. Haier* decision in 2020, that the provision of claim charts is sufficient as the information that a rights holder provides at the stage of licensing negotiation offer from rights holder, but not mandatory, at least in that case.<sup>7</sup> Also, in 2021, it was proposed in a report by the SEP Expert Group organized by the European Commission that high-level claim charts should be provided (without requiring the implementer to first sign a non-disclosure agreement (“NDA”)).<sup>8</sup>

另一方面，德国联邦最高法院在其 2020 年 *Sisvel* 诉 *Haier* 案的判决中承认，在许可谈判阶段，专利权人提供侵权对照表就足够了，但不是强制性的，至少在该案中是这样<sup>9</sup>。此外，2021 年，欧盟委员会组织的 SEP 专家组的一份报告中提出，应提供高级别侵权对照表（无需要求实施者首先签署保密协议（“NDA”））。<sup>10</sup>

---

7 *Sisvel v Haier* (Germany, Supreme Court, 2020).

8 This proposal was made in the report “Contribution to the Debate on SEPs”, which was published in 2021 by SEPs Expert Group in the EU. It is clearly indicated that the report does not bind the European Commission and not all the members of the expert group agree on each proposal. Nevertheless, this proposal was rated 4.5, when they voted their degree of support rating from one to five.

9 *Sisvel v Haier* (德国，最高法院，2020 年)。

10 该提议由欧盟 SEP 专家组于 2021 年发布的报告“对 SEP 辩论的贡献”提出。该报告明确指出，其对欧盟委员会没有约束力，并非专家组的所有成员都同意每项提案。尽管如此，当他们投票支持从 1 到 5 时，该提案的评分为 4.5。

Under such circumstances, in 2022, Ministry of Economy, Trade and Industry of Japan (METI) established the "Good Faith Negotiation Guidelines for Standard Essential Patent Licenses", which set forth the norms of good faith negotiations to be followed by the rights holders and the implementers.<sup>11</sup> METI established this Guidelines, based on hearings and opinions solicited from domestic and foreign companies, as well as the results of the discussion at the study group attended by representatives from the industry and experts on intellectual property law and competition law, so that good faith negotiations between the parties may encourage early settlements and avoidance of unnecessary disputes, leading to the development of Japanese industries.

在这种情况下，日本经济产业省（METI）于 2022 年制定了《SEP 许可善意谈判指南》，其中规定了专利权人和实施者应遵循的善意谈判准则，<sup>12</sup> METI 根据国内外企业的听证会和征求意见，以及由行业代表和知识产权法和竞争法专家参加的研究小组讨论的结果，制定了本指南，双方之间的善意谈判可能会鼓励早日达成解决方案和避免不必要的争端，从而促进日本产业的发展。

In addition, governments have been engaging in various activities related to the SEPs, e.g., a series of public consultations on policy statements and new initiatives were conducted by the U.S.<sup>13</sup> U.K.<sup>14</sup> and EU<sup>15</sup> since the end of 2021.

---

11 Good Faith Negotiation Guidelines for Standard Essential Patent Licenses (METI, Japan, 2022)

12 标准必要专利许可善意谈判指南（日本经济产业省，2022 年）。

13 In the U.S., based on the Executive Order on Promoting Competition in the American Economy issued on July 9, 2021, after a change of the administration, in order to avoid the possibility of widening anti-competitive market power beyond the scope of patent rights and prevent the abuse of standards-setting process, the intersection of the intellectual property laws and anti-trust laws would be reviewed, including discussion on possible revisions to the past Policy Statements on SEPs. In December 2021, new draft Policy Statement was jointly released by U.S. DOJ, USPTO, and the National Institute of Standards and Technology (NIST) and public comments were requested.

14 In December 2021, UK Intellectual Property Office conducted consultation seeking views as to whether the SEPs framework is functioning efficiently and strikes the right balance for all entities involved.

15 After the publication of the report "Pilot study for essentiality assessment of Standard Essential Patents" in November 2020 and "Contribution to the Debate on SEPs" by SEPs Expert Group in February 2021, the European Commission commenced public consultation for the new initiative named "new framework for standard-essential patents" in February 2022, which will build upon three policy pillars, i.e., "enhancing transparency on SEPs", "providing clarity on various aspects of FRAND" and "improving effectiveness and efficiency of enforcement".

此外，各国政府一直在参与与 SEP 相关的各种活动，例如，自 2021 年底以来，美国<sup>16</sup>、英国<sup>17</sup>和欧盟<sup>18</sup>就政策声明和新举措进行了一系列公众咨询。

Furthermore, in the first edition of this Guide published in 2018, it was pointed out that there was the “possibility” that whole spectrum of industries will be brought to SEP license negotiations. However, disputes over SEP license negotiations between different industries have surfaced, and litigation outcomes have accumulated (see II.B. 2.). The case, which was newly referred to the CJEU for a cross-industry dispute related to the issue of the bargaining subject in the supply chain, also drew attention, although it was withdrawn later due to a settlement.<sup>19</sup>

此外，在 2018 年发布的第一版《指南》中，指出所有行业都“有可能”将被纳入 SEP 许可谈判。然而，不同行业之间关于 SEP 许可谈判的争议已经浮出水面，诉讼结果不断积累（见 II.B. 2.）。有一个涉及供应链谈判主体问题的跨行业纠纷案件新提交至欧盟法院，也引起关注，但后来因和解而被撤回。<sup>20</sup>

In view of the increasingly active discussions on SEPs, including not only the companies which are potential parties to license negotiations, but also governments of various countries, it was decided to revise this Guide to ensure that the "appropriate information" provided by this Guide is up-to-date at this stage.

---

16 在美国，根据 2021 年 7 月 9 日颁布的《促进美国经济竞争的行政命令》，在换届后，为了避免扩大反竞争市场力量超出专利权范围的可能性，防止滥用标准制定过程，将审查知识产权法和反垄断法的交叉点，包括讨论对过去标准必要专利政策声明的可能修订。2021 年 12 月，美国司法部、美国专利商标局和美国国家标准与技术研究院 (NIST) 联合发布了新的政策声明草案，征求公众意见。

17 2021 年 12 月，英国知识产权局就 SEP 框架是否有效运作以及是否为所有相关实体取得适当平衡进行了磋商，征求意见。

18 在 2020 年 11 月和 2021 年 2 月 SEP 专家组发布“SEP 的必要性评估试点研究”报告和“对 SEP 辩论的贡献”报告后，欧盟委员会于 2022 年 2 月开始对名为“SEP 新框架”的新倡议进行公众咨询，该框架将建立在三个政策支柱之上，即“提高标准必要专利的透明度”、“明确 FRAND 的各个方面”和“提高执法的有效性和效率”。

19 In *Nokia v Daimler* (EU, CJEU, 2021), the referral was made to the CJEU as to whether there is an obligation to license suppliers on a priority basis, but the referral was withdrawn later.

20 在诺基亚诉戴姆勒案 (EU, CJEU, 2021) 中，向 CJEU 提交了关于是否有义务优先许可供应商的案件，但该提交后来被撤回。

鉴于 SEP 的讨论日益活跃，不仅包括可能参与许可谈判的公司，还包括各国政府，故决定对本指南进行修订，以确保本指南提供的“适当信息”是本阶段中最新的。

#### **D. Measures toward Transparent Guide / D. 确保指南透明性所采取的措施**

In formulating this Guide in 2018, we invited the submission of proposals in autumn 2017, receiving around 50 responses from Japan and abroad. We also called for public comments for about one month in spring 2018, receiving around 50 comments from Japan and abroad. In addition, we engaged in discussions with experts from industry, academia and law, who offered many valuable comments and insights. The content of this Guide owes much to these inputs.

*(Public Consultation Process in 2022 will be additionally explained here.)*

在 2018 年制定本指南时，我们邀请各界于 2017 年秋季提交提案，收到了来自日本国内外的约 50 份回复。我们还在 2018 年春季公开征询公众意见约一个月，收到了来自日本内外的大约 50 条意见。此外，我们还与来自工业界、学术界和法律界的专家进行了讨论，他们提出了许多宝贵的意见和见解。本指南的内容，很大程度上归功于以上这些意见和见解。

*(这里将另外说明 2022 年的公众咨询过程。)*

With the environment surrounding SEP licensing negotiations continuing to transform, we continuously review and revise this Guide as appropriate in an open and transparent process so that it continues to evolve and remains “living.”

随着围绕 SEP 许可谈判的环境不断变化，我们在公开透明的过程中不断审查和修订本指南，使其继续发展并保持“活力”。



## II. Licensing Negotiation Methods / II. 授权许可谈判方法

### A. Good Faith / 善意（翻译人员：李旭仪）

Although FRAND means “fair, reasonable and non-discriminatory”, there are two aspects to FRAND: (1) the negotiation process itself and (2) the terms of the resulting license. While the purpose of licensing negotiations is to determine whether a license is necessary, and, if so, the appropriate licensing terms, it is the negotiation process that impacts on whether or not an injunction is justified. Therefore, this chapter will address the first aspect of FRAND.

FRAND 内涵是“公平、合理和无歧视”，包括两个方面：(1)谈判过程本身和(2)由此产生的授权许可条件。虽然授权许可谈判的目的是确定许可是否必要，如果必要的话，还需确定适当合理的授权许可条款，但因谈判的过程会影响禁令是否会被认可，因此，本章将论述 FRAND 的第一个方面。

When patent rights are infringed, rights holders may in principle exercise their right to seek an injunction. When implementers intend to obtain a license on FRAND terms in good faith, however, court decisions around the world are consistent in imposing limitations on granting injunctions to owners of FRAND-encumbered SEPs.<sup>21</sup> There are independent and overlapping legal mechanisms by which this is achieved.

当专利权被侵犯时，专利权人原则上可以行使禁令请求权。然而，当善意实施者有意接受 FRAND 承诺而取得授权时，世界各地法院的判决都一致地对做出 FRAND 承诺的 SEPs 的专利权人申请禁令的救济施加了许多限制<sup>22</sup>，有一些独立

---

21 However, as the result of considering the negotiation process, some court rulings have allowed an injunction (St. Lawrence v. Deutsche Telekom and HTC (Germany, district court, 2015), NTT DoCoMo v. HTC (Germany, district court, 2016), St. Lawrence v. Vodafone and HTC (Germany, district court, 2016), Unwired Planet v. Huawei (UK, Supreme court, 2020)).

22 然而，由于考虑到谈判过程，一些法院的裁决允许发布禁令（St. Lawrence 诉德国电信和 HTC（德国，地区法院，2015 年），NTT DoCoMo 诉 HTC（德国，地区法院，2016 年），St. Lawrence 诉沃达丰和 HTC（德国，地区法院，2016 年），Unwired Planet 诉华为（英国，最高法院，2020 年））。

和重叠的法律机制可以实现这一目标。

One is contracts. The rights holder gives a commitment to the SSO to grant licenses on FRAND terms. In some countries, that commitment, is contractually binding between the SSO and the rights holder, and the contract will be governed by a particular law (e.g. French law in the case of a contract with ETSI<sup>23</sup>). The laws of those countries permit a third party to enforce a contract where it is for the benefit of that party, so a third-party implementer can insist upon a rights holder granting it a license on FRAND terms. If the rights holder does not do so, or does not offer FRAND terms, it is in breach of contract, and it will be prevented from enforcing its patent accordingly.

第一个法律机制是合同。专利权人向 SSO 承诺专利权将依 FRAND 承诺予以许可。在某些国家，该承诺在 SSO 与专利权人之间具有合同约束力，合同将由特定法律(例如，法国法律中关于 ETSI 签订合同的规定<sup>24</sup>)进行规范。这些国家的法律允许第三方为其利益而实施合同，因此第三方实施者可以坚持让专利权人根据 FRAND 承诺对其授权。如果专利权人不这样做，或者不提供 FRAND 承诺，那么他就违反了合同，因此将无法实施其专利。

Another is competition law. Where it is found that a rights holder has abused a dominant position, this constitutes a violation of competition law.

另一个法律机制是竞争法。凡发现专利权人滥用了支配地位，这就构成了对竞争法的违反。

There is also a mechanism that draws on the legal principle of the abuse of rights.<sup>25</sup>

---

23 European Telecommunications Standards Institute.

24 欧洲电信标准学会

25 In Japan, a FRAND declaration made by an SEP rights holder to an SSO is not regarded as a contract for a third-party beneficiary (i.e., an implementer), and the rights holder is regarded as having the obligation to negotiate in good faith with the third party (the implementer) under the principle of good faith prescribed by civil law. If this obligation is not met, the exercise of injunction rights may be restricted as an abuse of rights (Apple v. Samsung (Japan, IP high court, 2014)).

还有一种法律机制借鉴了禁止权利滥用的法律原则<sup>26</sup>。

What, then, is regarded as a demonstration of good faith? While the way in which licensing negotiations are progressed needs to be determined among the parties on a case by case basis and with regard to the laws and rulings of the country or countries in which the patent will be implemented, the 2015 decision by the Court of Justice of the European Union (“CJEU”) in the case between Huawei and ZTE<sup>27</sup> in particular has attracted wide attention. It provided a “framework for good faith negotiations” between rights holders and implementers by identifying actions which each of the parties should take at each stage of the licensing negotiations. This framework details the rules of negotiations from the perspective of competition law in Europe, and not every court decision in each country follows this framework. In fact, some court decisions<sup>28</sup> determined that this framework was not mandatory, but just a guidance. Nevertheless, the framework is still considered to be a useful approach in terms of encouraging good faith negotiations whereby rights holders may fulfill their FRAND obligations and implementers may minimize their risk of an injunction, regardless of the differences among jurisdictions in the legal bases for stipulating the negotiation rules for FRAND-encumbered SEPs. Referencing this framework, the Ministry of Economy, Trade and Industry of Japan (METI) established the Good Faith Negotiation Guidelines as the norms to be followed by the rights holders and implementers.<sup>29</sup>

那么，什么被看作是善意的体现？虽然许可谈判的进展方式需要由各方根据具体情况，以及专利实施国家或地区的法律和裁决而决定，但欧盟法院（“CJEU”）于 2015 年就华为与中兴通讯案所做的判决引起了广泛的关注<sup>30</sup>。它通过确定各

---

26 在日本，SEP 专利权人对 SSO 所作的 FRAND 声明不视为第三方受益人的合同（即实施者），专利权人被视为在民法规定的诚实信用原则下有义务与第三方（实施者）进行善意协商。如果不履行这一义务，禁止令权利的行使就可能被限制为权利的滥用（苹果 v. 三星（日本，知识产权高等法院，2014））。

27 Huawei v. ZTE (EU, CJEU, 2015).

28 Sisvel v Haier (Germany, Supreme Court, 2020), Unwired Planet v. Huawei (U.K., Supreme Court, 2020).

29 Good Faith Negotiation Guidelines for Standard Essential Patent Licenses (METI, Japan, 2022)

30 华为 v 中兴（欧盟，欧盟法院，2015 年）。

当事方在许可谈判的每个阶段应采取的行动，为专利权人和实施者之间的善意谈判提供了一个框架。这一框架从欧洲竞争法的角度详细阐述了谈判规则，但并非每个国家的法院判决都遵循这一框架。事实上，有的法院判决<sup>31</sup>认定这一框架并不是强制性的，而只是指导性的。尽管如此，在鼓励善意谈判方面，该框架仍然被认为是一个有用的办法，即专利权人可以履行其 FRAND 义务，而实施者可以将禁令的风险降到最低，而不用考虑各国法律对 FRAND 承诺的 SEP 谈判规定的差异。在此框架下，日本经济、贸易和工业部(METI)确立了善意谈判指南作为专利权人和实施者遵循的准则<sup>32</sup>。

The framework, however, does not provide specific details about negotiations, such as the scope of information that the parties should submit at each stage of the negotiation and the period given to make a response. In recent years, some court decisions in each country determined some specific details, but there are still unclear parts.<sup>33</sup> While some parties regard the lack of specific detail as increasing the flexibility of negotiations, others suggest that it undermines the predictability of licensing negotiations.

然而，该框架没有提供关于谈判的具体细节，例如当事方在谈判的每个阶段应提交的资料范围和作出答复的期限。近年来，各国法院的一些判决确定了一些具体的细节，但仍有不明确的部分<sup>34</sup>。虽然有些缔约方将缺乏具体细节视为谈判灵活性的增加，但另一些缔约方则认为这破坏了许可谈判的可预测性。

---

31 意大利息思维有限责任公司 V 海尔（德国，最高法院，2020 年），无线星球 V 华为（英国，最高法院，2020 年）。

32 标准基本专利许可证善意谈判准则（METI，日本，2022 年）

33 In *Sisvel v Haier* (Germany, Supreme Court, 2020), the court made judgment based on the framework presented by the CJEU. The court stated that when a rights holder offered a licensing negotiation, but if it took several months for an implementer to express its willingness to obtain a license, such silence would mean no interest in the license. Based on this, the court ruled that an implementer who did not respond to licensing negotiation offer for one year did not have intention to obtain a license. Nonetheless, the court did not clarify specifically how long a period to respond to the offer should be allowed.

34 在 *Sisvel 诉海尔案* (德国,最高法院,2020 年)中，法院根据 CJEU 提出的框架作出判决。法院指出，当专利权人提出许可证谈判时，但如果实施者用了几个月的时间才表示愿意取得许可证，那么这种沉默就意味着对许可证没有兴趣。基于此，法院裁定，一年内未对许可谈判要约作出答复的执行人无意取得许可。尽管如此，法院并未具体说明应允许对要约作出多长时间回应。

More specific details about a “framework for good faith negotiations” may be determined through the accumulation of court rulings over the coming years, but under these circumstances, this Guide has drawn on the framework presented by the CJEU and informed by court decisions in various countries, actual practices in SEP disputes and the norms established by the governments in listing more specific issues relating to actions that parties may take at each stage of licensing negotiations.

关于“善意谈判框架”的更具体细节，可以通过未来几年法院裁决的经验积累来确定，在当前背景下，本指南借鉴了CJEU提出的框架，参考各国法院的裁决、SEP争端解决的实践处理，以及各国政府列出的当事人在许可谈判的各个阶段所采取的可能的行动等更具体问题的规则。

It should be noted that simply satisfying the various elements noted in this Guide provides no guarantee of recognition of good faith. Rather, a comprehensive assessment of the negotiating process as a whole needs to be made in each case.

需要指出的是，单纯满足本指南所指出的各种要素并不能保证为善意的行为。相反，需要在个案中对整个谈判过程进行全面评估。

The manner in which negotiations are progressed should be determined among the parties on a case by case basis. Nonetheless, one example is as follows:

谈判的进展方式应由各方根据具体情况确定。尽管如此，有一个例子如下：

[Steps of the Licensing Negotiation Process]<sup>35</sup> / [许可谈判过程的步骤]<sup>36</sup>

Step 1: Licensing Negotiation Offer from Rights Holder

Step 2: Expression from Implementer of Willingness to Obtain a License

Step 3: Specific Offer from Rights Holder on FRAND Terms

Step 4: Specific Counteroffer from Implementer on FRAND Terms

Step 5: Rejection by Rights Holder of Counteroffer/Settlement of Dispute in

---

35 It is not intended to suggest that each of the five steps is necessarily mandatory in every case. Steps may vary according to the particular case.

36 这并不是要暗示，在每一种情况下，这五个步骤中的每一个都必须是强制性的。步骤可能因具体情况而异。

## Court or through ADR

- 第一步：专利权人提出的许可谈判要约
- 第二步：实施者对获得授权许可表达意愿
- 第三步：专利权人基于 FRAND 承诺提出特定要约
- 第四步：实施者基于 FRAND 承诺提出反要约
- 第五步：专利权人拒绝反要约/通过法院或 ADR 解决纠纷

### **1. Step 1: Licensing Negotiation Offer from Rights Holder / 第一步：专利权人提出许可谈判要约**

#### *(Overview) (概述)*

In general, if an implementer is suspected to have infringed patent rights, the rights holder may initiate negotiations with the implementer by specifying the relevant patents and identifying how those patents were or are being infringed.<sup>37 38</sup>In some cases, an entity that manages a framework enabling patents held by multiple rights holders to be licensed efficiently in a single transaction (“patent pool”) may negotiate in place of the rights holder.

一般来说，如果实施者被怀疑侵犯了专利权，专利权人可以通过指定相关专利并查明这些专利是如何被侵犯的，进而与实施者展开谈判<sup>39 40</sup>。在某些情况下，管理多个专利权人在单一交易（“专利池”）中得到有效授权的框架管理实体可以代替专利权人进行谈判。

It is common for the rights holder to substantiate the grounds for the

---

<sup>37</sup> The framework in *Huawei v. ZTE* (EU, CJEU, 2015) suggests that the rights holder first alerts the alleged infringer of their infringement by identifying the patents and specifying the way they have been infringed.

<sup>38</sup> In the field of telecommunications, although implementers often start a negotiation only after receiving an invitation to license from a rights holder, because of the large number of SEPs and/or patentees, it may be useful for parties to refer to the framework of this Guide even if such negotiations are initiated by the implementer before it launches business operations.

<sup>39</sup> 华为 V 中兴的框架。中兴通讯（欧盟，欧盟法院，2015 年）建议，权利持有人首先通过识别专利并指明其被侵犯的方式，提醒被指控的侵权人注意其侵权行为。

<sup>40</sup> 在电信领域，虽然执行者往往只有在收到权利持有人的许可证邀请后才开始谈判，但由于 SEP 和/或专利权人众多，即使这种谈判是由执行者在开始业务活动之前发起的，缔约方也可以参考本指南的框架。

infringement by providing to the implementer, among other things:<sup>41 42</sup>

- (1) Documents identifying the SEPs (list of patent numbers, the names of the standards at issue, the geographical scope of patents, etc.); and
- (2) Documentation mapping claims of the SEPs to the standards and/or products (claim charts, etc.).

When a rights holder holds large numbers of SEPs, the parties sometimes discuss limiting the negotiations to key patents so as to rationalize the negotiation process (refer to II.B.4.).

专利权人通常通过向实施者等提供证据来证实侵权行为的理由<sup>43 44</sup>：

- (1) SEP 确认文件（专利号列表、待授权的标准技术名称、专利效力所及地域范围等）；以及
- (2) SEP 专利范围与标准规格及或产品之对照表（侵权对照表等）。

当专利权人持有大量 SEPs 时，双方有时会讨论将谈判限制在关键专利上，以便使谈判过程合理化（参考 II.B.4.）。

*(Documentation Mapping Claims of the SEPs to the Standards and/or Products) /  
(SEP 与技术标准和/或产品的对照)*

Rights holders provide documentation to implementers at the start of negotiations so that implementers can see how the SEP claims map to standards and/or their own products. It is common for rights holders to use claim charts to indicate the correlation between products that are actually manufactured and patent claims.

---

41 Besides these, there is a view that rights holders may demonstrate their good faith by, for example, presenting evaluations by third-party experts and examples from past cases, etc.

42 In some cases including where the SEP has a substantial licensing history, the implementer may decide that such substantiation for the patent infringement is unnecessary.

43 除此之外，还有一种观点认为，权利持有人可以通过第三方专家的评价和过去案例中的例子等方式来自己的善意。

44 在某些情况下，包括在 SEP 有重大许可证发放历史的情况下，实施者可以决定，对专利侵权的这种证据是不必要的。

专利权人在谈判开始时向实施者提供文件，以便实施者能够了解 SEP 如何对应到技术标准和/或他们自己的产品。专利权人通常使用侵权对照表来表明实际生产的产品与专利之间的相关性。

Claim charts may be useful for implementers in analyzing whether they are infringing the SEPs. Meanwhile, by presenting claim charts, the rights holders may demonstrate that they are providing information in good faith to implementers.

侵权对照表可能有助于实施者分析他们是否侵犯了 SEP。同时，专利权人也藉由提供侵权对照表来表达愿意提供善意的信息给实施者。

When patents are SEPs and the details of patent claims are consistent with standards documents, and if the implementers advertise that their products conform to the applicable standards, the act of indicating the correspondence between patent claims and standards may be sufficient. Thus, mapping patent claims to actual products may not always be necessary.<sup>45 46</sup> “Good Faith Negotiation Guidelines for Standard Essential Patent Licenses” of METI provides, as the norms to be followed by rights holders and implementers, that when a SEP holder makes the licensing offer, the SEP holder should provide, either voluntarily or at the implementer’s request, information indicating that the implementer’s products comply with the standard and claim charts mapping patent claims to that standards element by element (When there is a large number of the subject patents, the claim charts are made for representative patents.).<sup>47</sup>

当专利为 SEPs 且专利主张的细节与标准文件一致时，如果实施者宣传其产

---

45 In *Fujitsu v. Netgear* (U.S., CAFC, 2010), the court stated that if an accused product operates in accordance with the standards, then comparing the claims to the standard is the same as comparing the claims to the accused product. The court also stated that if the relevant section of the standard is optional, standards compliance alone would not establish that the accused infringer chooses to implement the optional section.

46 In *Sisvel v. Haier* (Germany, Supreme Court, 2020), the court stated that it would be sufficient to identify infringed patents and how these patents have been infringed and that it would not be necessary to give a detailed explanation about alleged infringement. The court also stated that claim charts would be sufficient as documentation to be presented but not mandatory. This indicates that in some court decisions, the act of not presenting claim charts might not be perceived immediately as acting in bad faith.

47 Good Faith Negotiation Guidelines for Standard Essential Patent Licenses (METI, Japan, 2022)



品符合技术标准,则表明专利请求项与技术标准本身之间的对应关系可能是充分的。因此,将专利主张映射到实际产品可能并不总是必要的<sup>48 49</sup>。METI的《标准必要专利许可的诚实信用谈判指南》规定,作为专利权人和实施者应遵循的准则,当SEP持有人提出许可要约时,SEP持有人应自愿或应实施者的要求提供信息,表明实施者的产品符合标准,并按要素将专利主张映射到该标准要素(当目标专利数量较多时,对制作代表性专利侵权对照表)<sup>50</sup>。

Some claim charts explain the connection between claim terminology and the corresponding features of the standards documents or products. In some cases, rights holders may claim that the explanation includes confidential information. In such situations, the parties may conclude a confidentiality agreement (non-disclosure agreement) in licensing negotiations. (Refer to II.B.3.)

一些侵权对照表解释了权利要求术语与标准规格书或产品的相应特征之间的联系。在某些情况下,专利权人可能声称解释包括机密信息。在这种情况下,当事人可以在许可谈判中缔结保密协议(不披露协议)。(见 II.B.3.)

While both claims and standards documents are made public and are not in themselves confidential, rights holders tend to require the conclusion of confidentiality agreements as a condition for providing claims charts on the grounds that the correspondence between claim terminology and standards documents and the interpretation thereof constitute confidential information. Implementers, on the other hand, tend to argue that in cases where claim charts only provide a simple comparison between claim terminology and standards documents, the charts do not constitute

---

48 在富士通和美国网件公司案中(美国,联邦巡回上诉法院,2010年),法院表示,如果被告产品按照标准运作,那么将索赔与标准进行比较,就等于将索赔与被告产品进行比较。法院还指出,如果标准的相关章节是可选的,仅有标准的遵守并不能确立被告侵权人选择执行可选章节。

49 在意大利息思维有限责任公司和海尔公司案中(德国,最高法院,2020年)法院表示,将足以查明被侵犯的专利以及这些专利是如何被侵犯的,并不需要对所指称的侵权行为作出详细解释。法院还指出,索赔图表将足以作为文件呈现,但不具有强制性。这表明,在某些法院判决中,不出示索赔表的行为不可能立即被视为恶意行为。

50 标准基本专利许可证善意谈判准则(METI,日本,2022年)

confidential information and should not be subject to a confidentiality agreement.

虽然专利范围和标准文件都是公开的，本身并不具有机密性，但专利权人往往以专利范围和标准文件之间的对应关系及其解释系机密信息为由，要求缔结保密协议作为侵权对照表的条件。另一方面，实施者倾向于认为，在侵权对照表只提供权利要求术语和标准文件之间简单比较的情况下，侵权对照表不构成机密信息，不应受保密协议的约束。

If a rights holder demands that an implementer enter into a confidentiality agreement as a condition for providing claim charts even when the rights holder can prepare claim charts that do not include confidential information, this may increase the likelihood of the rights holder being perceived as acting in bad faith. On the other hand, if an implementer demands that a rights holder provide detailed claim charts that do include confidential information while refusing to conclude a confidentiality agreement, this may increase the likelihood of the implementer being perceived as acting in bad faith.<sup>51</sup>

如果专利权人要求实施者以订立保密协议作为提供侵权对照表的条件，而专利权人提供的侵权对照表本身却不含机密事实，这可能会增加专利权人的行为被视为非善意的可能性。另一方面，如果实施者要求专利权人在拒绝缔结保密协议的同时提供确实包含机密信息的详细侵权对照表，这可能会增加实施者的行为被视为恶意的可能性<sup>52</sup>。

*(Documents Demonstrating the Essentiality of SEPs)* / (SEP 必要性证明文件)

When a rights holder and an implementer cannot agree on the essentiality of a patent, they may obtain an analysis from an independent evaluator (an independent

---

51“Good Faith Negotiation Guidelines for Standard Essential Patent Licenses” of METI provides, when the rights holder provides the claim charts mapping patent claims to standards element by element, it is desirable that the rights holder does not include them in the scope of a non-disclosure agreement if requested by the implementer, while it also provides this shall not apply when the claim charts include non-public information.

52 METI 的《标准必要专利许可的诚实信用谈判指南》规定，当专利权人提供按要素将专利权利要求映射到标准要素的请求权图时，如果实施者要求，专利权人不将其列入不披露协议的范围，但当请求权图包含非公开信息时，也不适用。

company or organization that provides the service of reviewing patents for essentiality). In April 2018, the JPO started a system, in which a panel in the Trial and Appeal Department provides an advisory opinion with no legally binding force on the essentiality of a patented invention (advisory-opinion system to determine the essentiality of SEPs). In July 2019, the system was revised so that the system would be more useful for the users.

当专利权人和实施者不能就专利的重要性达成一致时，他们可以从独立评价者（提供必要专利审查服务的独立公司或组织）获得分析。2018年4月，日本专利局启动了一项制度，在该制度中，审判和上诉部的一个小组就一项专利发明的必要性（确定 SEP 必要性的咨询意见系统）提供了没有法律约束力的咨询意见。2019年7月该系统进行了修订，使该系统对用户更有用。

Declaration documents, in which rights holders made a FRAND declaration to SSOs, are based on the rights holders' technical assessment that the patents are essential, but not assessment by a neutral third party.

专利权人根据自己分析判断而做出对 SSO 的 FRAND 承诺的声明文件是基于专利权人对专利是必要的技术评估，而不是中立第三方的评估。

*(Notes on Rights Holders' Actions)* / (专利权人行动应注意之处)

The following are examples of actions by a rights holder that may increase the likelihood of the rights holder being perceived as acting in bad faith:

- (1) Demanding injunctive relief before or immediately after sending a warning letter to the implementer, or immediately after opening a negotiation;
- (2) Not clarifying how SEPs are being infringed, such as documents identifying the SEPs and the standards, when offering licensing negotiations to an implementer<sup>53</sup>;
- (3) Claiming that it will not provide documentation mapping SEP claims to the

---

<sup>53</sup> In *Sisvel v. Haier* (Germany, Supreme Court, 2020), the court held that presenting claim charts would not be mandatory. However, it must be noted that it was a court decision in Germany.

standards and/or products to the implementer unless the implementer concludes a confidentiality agreement, even though the documentation does not include confidential information;

(4) Making an offer that sets a time limit that does not allow a reasonable period of time for consideration; or

(5) Not disclosing the content of a portfolio to the implementer (the technologies, number of patents, regions, etc., covered by the portfolio).

以下是专利权人采取行动的例子，这些行动可能增加专利权人被视为恶意行为的可能性：

- (1) 在对实施者发出警告信之前或者发出警告信之后立即，或者在开启谈判之后立即提出禁令要求；
- (2) 在向实施者提供许可谈判时，不澄清 SEP 是怎样被侵犯的，如不指明 SEP 和技术标准的文件<sup>54</sup>；
- (3) 声称除非实施者缔结保密协议，否则它不会向实施者提供标准和/或产品的 SEP 侵权对照表，即使文件中不包含机密信息；
- (4) 要约时提出规定时间限制，不允许合理时间考虑；
- (5) 不向实施者披露专利组合的内容（组合涵盖的技术、专利数量、地区等）。

Some argue that the information which the rights holder needs to provide additionally so that the implementer can garner the necessary information for negotiations is less extensive in the case of a patent license once granted to the implementer that has since expired than in the case of concluding a new licensing agreement.<sup>5556</sup>

---

54 在意大利息思维有限责任公司和海尔公司案中（德国，最高法院，2020年），法院认为提交索赔图表不会具有强制性。但是，必须指出，这是德国的一项法院判决。

55 In *Unwired Planet v. Huawei* (UK, high court, 2017), the high court ruled that the details of necessary notifications and prior discussions would depend on the conditions of each case. This was supported also by the decision of the U.K. Supreme Court in 2020.

56 There is a view, however, that it may require attention because the patent portfolio of the SEP licensor

有些人认为，在专利许可一经授予实施者的情况下，专利权人需要提供额外的信息，以便实施者能够获取谈判所需的信息，而在此后专利权到期时，该信息不如缔结新的许可协议中的信息广泛<sup>57 58</sup>。

## Step 2: Expression from Implementer of Willingness to Obtain a License (翻译

人员：徐语秋)

### 2. / 第 2 步：实施者对取得授权表达善意意愿

(Overview) / (概述)

When an implementer receives an offer from a rights holder for licensing negotiations, it may help to mitigate risk for the implementer not to leave that offer unanswered even if it does not agree with the rights holder's offer, but instead to respond in good faith.<sup>59 60</sup>

当实施者收到专利权人的许可谈判要约时，实施者即使不同意专利权人的要约，也不要对该要约置之不理，而是要善意地作出回应，这可能有助于降低实施者的风险。<sup>61 62</sup>

---

may have changed significantly (e.g., patents have been added to the portfolio or have expired).

57 在无线星球公司和华为案中（英国，高等法院，2017），高等法院裁定，必要通报和事先讨论的细节将视每个案件的情况而定。这也得到了英国最高法院 2020 年的判决的支持。

58 然而，有观点认为可能需要注意，因为 SEP 许可方的专利组合可能发生了明显的变化（例如，专利已经被添加到投资组合中或者已经到期）。

59 In Huawei v. ZTE (EU, CJEU, 2015), the court stated that the alleged infringer should diligently respond to the SEP holder's offer, in accordance with recognized commercial practices in the field and in good faith, this being a matter that must be established on the basis of objective factors and which implies, in particular, that there are no delaying tactics.

60 In Sisvel v. Haier (Germany, Supreme Court, 2020), the court determined that an obligation at the stage of specific offer from rights holder on FRAND terms (refer to II.A.3) would not arise until an implementer clearly expresses its willingness to obtain a license.。

61 在 Huawei v. ZTE（欧盟，CJEU，2015 年）中，法院指出，被指控的侵权人应根据该领域公认的商业惯例，本着诚意对 SEP 持有人的要约作出积极回应，这是一个必须根据客观因素来确定的问题，特别是其中不存在拖延战术时。

After receiving documents including those identifying the SEPs and claim charts from the rights holder, if the implementer concludes that it needs to obtain a license for the SEPs, it may express its willingness to conclude a licensing agreement with (that is, to obtain a license from) the rights holder. Some court held that this willingness should be gauged by the implementer's actions rather than words—in other words, not just the expression of willingness but evidence of this in the way that the implementer approaches negotiations.<sup>63</sup>

在收到专利权人提供的 SEP 清单及侵权对照表后，如果实施者得出结论认为其需要获得 SEPs 的许可，可以表示与专利权人签订许可协议（即从专利权人那里获得许可）的善意。一些法院认为，这种善意意愿应该由实施者的行动而不是言语来衡量--换句话说，不仅仅是表达意愿，还要有实施者对待谈判的方式来证明这一点。<sup>64</sup>

Some hold the view that, when an implementer receives an offer from a rights holder for licensing negotiations, the implementer should promptly express its willingness to obtain a license even if discussions are still being conducted about essentiality, validity, and infringement, reserving the right to challenge these issues.<sup>65</sup> Others take the view, however, that parties should first conduct discussions about essentiality, validity, and infringement before the implementer expresses its willingness to obtain a license.

有些人认为，当实施者收到专利权人提出的许可谈判要约时，即使仍在讨论标准必要性、有效性和侵权问题，实施者也应迅速表达希望获得许可的意愿，并

---

62 在 *Sisvel 诉 Haier 案*（德国，最高法院，2020 年）中，法院裁定，在实施者明确表示愿意获得许可之前，不会产生专利权人按 FRAND 承诺提出具体要约阶段的义务（参考 II.A.3）。

63 In *Sisvel v. Haier (Germany, Supreme Court, 2020)*, the court stated that the implementer needs to clearly express its willingness to conclude a licensing agreement on FRAND terms and to cooperate with the rights holder for a licensing negotiation.

64 在 *Sisvel 诉 Haier 案*（德国，最高法院，2020 年）中，法院指出，实施者需要明确表达其愿意以 FRAND 条款缔结许可协议，并配合专利权人进行许可谈判。

65 In *Unwired Planet v. Huawei (U.K., High Court, 2017)* and *Sisvel v. Haier (Germany, Supreme Court, 2020)*, a licensee having willingness to obtain a license should be a person having willingness to obtain a FRAND license regardless of whatever actual FRAND terms are.

保留对这些问题提出质疑的权利。<sup>66</sup>但也有人认为，在实施者表达获得许可的意愿之前，各方应首先就标准必要性、有效性和侵权性进行讨论。

*(Countermeasures by Implementers)* / (实施者的对策)

In practice, a rights holder and an implementer in licensing negotiations may not see eye-to-eye, and may fail to reach an agreement on essentiality, validity or infringement. In such cases, the implementer can express its willingness to obtain a license without waiving its right to challenge these issues.<sup>67</sup> <sup>68</sup> Also, “Good Faith Negotiation Guidelines for Standard Essential Patent Licenses” of METI provides, as the norms to be followed by rights holders and implementers, that even if the implementer expresses the willingness to obtain a license under FRAND terms while reserving to challenge the essentiality, validity, or infringement of the subject patents in the negotiation process as appropriate, its willingness to obtain a license under FRAND terms in good faith is not denied.<sup>69</sup>

在实践中，专利权人和实施者在许可谈判中可能意见不一致，可能无法就标准必要性、有效性或侵权问题达成协议。在这种情况下，实施者可以表示愿意获得许可，但不放弃对这些问题提出质疑的权利。<sup>70</sup> <sup>71</sup>另外，METI 提供的《标准必要专利许可的善意谈判指南》规定，作为专利权人和实施者应遵循的规范，即

---

66 在 *Unwired Planet 诉华为案*（英国，高等法院，2017 年）和 *Sisvel 诉海尔案*（德国，最高法院，2020 年）中，有意愿的被许可人应该是有意愿获得 FRAND 许可的人，无论实际的 FRAND 条款是什么。

67 In *Huawei v. ZTE* (EU, CJEU, 2015), the court stated that an implementer “cannot be criticized either for challenging, in parallel to the negotiations relating to the grant of licenses, the validity of those patents and/or the essential nature of those patents to the standard ... or for reserving the right to do so in the future” and the court did not cause implementers to waive their defenses, even while indicating their willingness to take a license.。

68 In *Apple v. Samsung* (Japan, IP high court, 2014), although the implementer Apple insisted that its product did not infringe and argued that the patent was invalid, the court found Apple to be willing to obtain a license.。

69 Good Faith Negotiation Guidelines for Standard Essential Patent Licenses (METI, Japan, 2022)

70 在 *Huawei v. ZTE*（欧盟，CJEU，2015 年）中，法院指出，实施者“既不能因为在与授予许可有关的谈判的同时挑战这些专利的有效性和/或这些专利对标准的必要性而受到指责.....也不能因为保留将来这样做的权利而受到指责”，法院没有使实施者放弃其抗辩，即使在实施者表示愿意接受许可时。

71 在 *苹果诉三星案*（日本，知识产权高等法院，2014 年）中，尽管实施者苹果公司坚持认为其产品没有侵权，并认为涉案专利无效，但法院认为苹果公司愿意获得许可。

使实施者表示愿意按照 FRAND 承诺获得许可，同时保留在谈判过程中对标的专利的标准必要性、有效性或侵权性提出质疑的权利，其按照 FRAND 承诺善意获得许可的事实也不会被否认<sup>72</sup>。

Some argue that an implementer may still challenge, for example, the following issues on patent rights for which it intends to obtain a license:

一些人认为，实施者仍然可以对其打算获得许可的专利权的下列问题提出质疑，例如：

- (1) Whether the patents are truly essential;
  - (2) Whether the patents are valid;
  - (3) Whether the implementer has infringed these patents;
  - (4) Whether the patent rights are enforceable<sup>73</sup>;
  - (5) Whether the entity who has exercised its rights is the true holder of the patents; and
  - (6) Whether the patents have not been exhausted.<sup>74</sup>
- (1) 专利是否真正对实施标准是必要的；
  - (2) 专利是否有效；
  - (3) 实施者是否侵犯了这些专利；
  - (4) 专利权是否可执行<sup>75</sup>；
  - (5) 行使权利的企业是否是专利的真正持有人；

---

72 《标准必要专利许可的善意谈判指南》（经济产业省，日本，2022）

73 Under U.S. law, patents can be held unenforceable if the rights holder engages in inequitable conduct before the United States Patent and Trademark Office by, for example, withholding material information with the intent to deceive (*Therasense v. Becton* (U.S., CAFC, 2011)).

74 Nonetheless, in *LG v. TCL* (Germany, District Court of Mannheim, 2021), the implementer presented a counteroffer of licensing terms including a condition to exclude products, for which the patents were exhausted, from the calculation of the license fees, but the court held that the counteroffer would reserve a right to be exempted from the payment of the license fees by raising the issue of patent exhaustion and thus not satisfy FRAND terms.

75 根据美国法律，如果专利权人在美国专利和商标局从事不公平的行为，例如隐瞒重要信息意图欺骗，则专利可以被认定为无法实施的。（*Therasense 诉 Becton 案*（美国，CAFC，2011））。



(6) 以及专利是否没有用尽。<sup>76</sup>

When implementers challenge the issues identified above, as specific grounds of such positions, for example, it is useful for them to provide, among other things:

当实施者对上述问题提出质疑时，作为这种立场的具体理由，例如，除其他外，提供以下内容对他们是有利的：

- (1) Documents that provide the basis for the implementers' refutation that they do not infringe the subject patents;
- (2) Prior art that serves as grounds for invalidating the patents;
- (3) Technical information that provides the basis for the argument that patents are not essential; and
- (4) Documentation that provides the basis for the argument that patent rights are not enforceable.

- (1) 实施者反驳其不侵犯标的专利提供依据的文件；
- (2) 作为专利无效理由的现有技术；
- (3) 为论证专利不是标准必要的技术信息；
- (4) 为论证专利权不可实施提供依据的文件。

*(Reasonable Amount of Time for Response)* / (作出回应的合理时间)

When reference materials provided by rights holders to implementers are not sufficient, it may serve to mitigate risk for the implementers to promptly request the rights holders to provide such materials.

当专利权人向实施者提供的参考材料不充分时，实施者及时要求专利权人提供这些材料，可能有助于降低风险。

The reasonable amount of time needed for the implementer to express its

---

<sup>76</sup> 尽管，在 LG 诉 TCL 案（德国，曼海姆地区法院，2021 年）中，实施者提出了许可条款的反要约，其中包括将专利已用尽的产品排除在许可费计算之外的条件，但法院认为，反要约将保留通过提出专利用尽问题而免于支付许可费的权利，因此不满足 FRAND 条款。

willingness to obtain a license after receiving such information from the rights holder may vary depending on various factors, such as the number of patents at issue, the complexity of the technology, the level of knowledge the implementer may have about the technology, any prior relationship, business transactions, and the state of a dispute on essentiality, validity, and infringement between the parties.

实施者在收到专利权人提供的此类信息后表示愿意获得许可所需的合理时间可能会因各种因素而有所不同，如有争议的专利数量、技术的复杂性、实施者可能对技术的了解程度、任何先前的关系、商业交易、以及双方在标准必要性、有效性和侵权方面的争议状况。

If there are relatively few patents at issue and the implementer is familiar with the technology, it may be reasonable, in some cases, for the implementer to express its willingness to obtain a license in a relatively short period of time.

如果有争议的专利相对较少，而且实施者熟悉该技术，在某些情况下，实施者在相对较短的时间内表示愿意获得许可可能是合理的。

On the other hand, if there are a significant number of patents at issue and the implementer is unfamiliar with the technology, several months or more may be a more reasonable time frame. For example, when a SEP-implementing component supplied by a third party is used in an end product, the end product manufacturer, if involved in the negotiations on the implementers' side, may need to obtain technical details about that component from the third-party supplier and thus may need more time to respond. If the initial substantive response requires more time, it may help to mitigate risk for the implementer to notify the rights holder and explain the specific reasons for the extra time needed so that it is not perceived as a deliberate delay (refer to II.B.1.).

另一方面，如果有大量的专利有争议，而且实施者对技术不熟悉，几个月或更长时间可能是一个更合理的时间范畴。例如，当第三方提供的实施 SEP 的部件被用于终端产品时，终端产品制造商如果作为实施者一方参与谈判，可能需要从第三方供应商那里获得关于该部件的技术细节，因此可能需要更多的时间来回应。如果最初的实质性回应需要更多的时间，对于实施者，这可能有助于其在通

知专利权人、并以具体原因解释需要额外时间而不被视为故意拖延方面降低风险。（参考 II.B.1.）。

*(Notes on Implementers' Actions) / (实施者行为的注意事项)*

The following are examples of actions by an implementer that may increase the likelihood of the implementer being perceived as acting in bad faith:

以下是可能增加实施者行为被认为是恶意的实例：

- (1) Not giving any reason for a very late reply or refusing to negotiate at all, even while continuing to use the infringing (or potentially infringing) technology<sup>77</sup>;
- (2) Claiming it will not start negotiation unless all grounds for essentiality and validity of the SEPs are first provided;
- (3) Unreasonably delaying negotiations by, for example, persistently demanding that the rights holder provide information that cannot be disclosed due to a confidentiality agreement(s) with others;
- (4) Refusing to conclude a confidentiality agreement, while demanding that the rights holders provide claim charts, including detailed claim interpretations containing confidential information,<sup>78</sup> or making repeated revisions to confidentiality agreement conditions to delay negotiations;
- (5) Repeatedly making meaningless responses; or
- (6) Colluding with multiple other implementers in obstinately refusing to obtain a license on the grounds that others have not obtained it.

---

<sup>77</sup> U.S. Dept of Justice and U.S. Patent and Trademark Office, Policy Statement (2013); In *Apple v. Motorola* (U.S., CAFC, 2014), the court stated that an injunction may be justified where an infringer unilaterally refuses a FRAND royalty or unreasonably delays negotiations to the same effect. After that, the Policy Statement (2013) was withdrawn, and new Policy Statement (2019) was jointly released by U.S. DOJ, USPTO, and the National Institute of Standards and Technology (NIST). As in the case of the Statement (2013), in this new Statement (2019), an injunction can be justified.

<sup>78</sup> In *Sisvel v. Wiko* (Germany, District Court of Mannheim, 2019), the court stated that the fact of the implementer's refusing to conclude a confidentiality agreement with the rights holder was a sign that the implementer had no intention to negotiate a licensing agreement with the rights holder. Also, the court held that this response of the implementer fell under the act of delaying tactics and that the implementer was a bad faith licensee. .

- (1) 对非常晚的答复不给任何理由，或根本拒绝谈判，甚至继续使用侵权（或潜在的侵权）技术<sup>79</sup>；
- (2) 声称除非首先提供所有关于 SEP 的标准必要性和有效性的理由，否则不会开始谈判；
- (3) 不合理地拖延谈判，例如，坚持要求专利权人提供由于与他人的保密协议而不能披露的信息。
- (4) 拒绝缔结保密协议，同时要求专利权人提供权利要求书，包括包含保密信息的详细权利要求解释，<sup>80</sup>或反复修改保密协议条件以拖延谈判；
- (5) 反复做出无意义的答复；或者
- (6) 与其他多个实施者勾结，以他人未获得许可为由，顽固地拒绝获得许可。

Even when the implementer deems that the reference materials provided by the rights holder are insufficient, making no response at all may increase the likelihood of the implementer being viewed as acting in bad faith. In such a case, it may help to mitigate risk for the implementer to respond to the rights holder at least by, for example, requesting specific and necessary reference materials.

即使实施者认为专利权人提供的参考材料不充分，但其完全不做回应的行为也会增加实施者被视为恶意的可能性。在这种情况下，实施者至少通过要求权利人提供具体和必要的参考材料来回应，如此可能会有助于降低风险。

When discussions about essentiality, validity, and infringement of the SEPs are still ongoing, it may not necessarily be viewed as acting in bad faith if an implementer

---

79 美国司法部和美国专利商标局，政策声明（2013 年）；在苹果诉摩托罗拉案（美国，CAFC，2014 年）中，法院指出，如果侵权者单方面拒绝 FRAND 许可费或不合理地拖延相同效果的谈判，则禁令可能是合理的。此后，《政策声明（2013）》被撤销，新的《政策声明（2019）》由美国司法部、美国专利商标局和美国国家标准与技术研究所（NIST）联合发布。与《声明（2013）》的情况一样，在这个新的《声明（2019）》中，禁令可以被证明是合理的。

80 在 *Sisvel 诉 Wiko* 案（德国，曼海姆地区法院，2019 年）中，法院表示，实施者拒绝与专利权人签订保密协议的事实表明，实施者无意与专利权人谈判许可协议。同时，法院认为，实施者的这种反应属于拖延战术的行为，实施者是一个恶意的被许可人。

does not promptly express its willingness to obtain a license. On the other hand, some courts have ruled that implementers should promptly express their willingness to obtain a license while reserving their right to challenge issues of essentiality, validity, and infringement of SEPs.<sup>81 82</sup> Thus, from the perspective of minimizing the risk of injunction, it would be safer for an implementer to express its willingness to obtain a license at an early stage of the negotiations while reserving its right to challenge issues of SEP essentiality, validity, and infringement.

当关于 SEPs 的标准必要性、有效性和侵权的讨论还在进行时，如果实施者没有及时表达其获得许可的意愿，不一定会被视为恶意行为。另一方面，一些法院已经裁定，实施者应该及时表达其获得许可的意愿，同时保留其对 SEP 标准必要性、有效性和侵权问题提出质疑的权利。<sup>83 84</sup>因此，从最小化禁令风险的角度来看，实施者在谈判的早期阶段表达其获得许可的意愿，同时保留其对 SEP 标准必要性、有效性和侵权问题提出质疑的权利，会更加安全。

### 3. Step 3: Specific Offer from Rights Holder on FRAND Terms /

#### 3. 第 3 步：专利权人根据 FRAND 承诺提出特定要约

(Overview) / (概述)

If an implementer has expressed its willingness to obtain a license, the rights holder may promptly present to the implementer a written offer for a license on FRAND terms. In addition to indicating its royalty calculation method (refer to

---

81 In *Sisvel v. Haier* (Germany, Supreme Court, 2020), the implementer responded to a licensing offer by the rights holder after one year passed from the offer. The court stated that if the implementer did not reply for several months, this would mean no interest in the license and that the implementer had no intention to obtain a license. Also, in the ruling, the court stated that the implementer needs to express its willingness to obtain a license without claiming any conditions, such as a condition that it would obtain a license only when the court recognizes the validity of patents and the fact of patent infringement.

82 *Huawei v. ZTE* (EU, CJEU, 2015).

83 在 *Sisvel 诉 Haier* 案（德国，最高法院，2020 年）中，实施者在专利权人提出许可要约一年后对其作出回应。法院指出，如果实施者在几个月内没有回复，这就意味着对许可没有兴趣，实施者没有获得许可的意图。另外，法院在裁决中指出，实施者需要在不主张任何条件的情况下表达其希望获得许可的意愿，例如，只有在法院承认专利的有效性和专利侵权的事实时才会获得许可的条件。

84 *Huawei 诉 ZTE*（欧盟，CJEU，2015 年）

III.), the rights holder normally presents specific grounds explaining why the offer is on FRAND terms. This is done for an implementer to determine whether the presented terms are reasonable and non-discriminatory.<sup>85 86</sup> Nonetheless, in some court decisions, the court stated that such obligation would not arise until an implementer clearly expresses its willingness to obtain a license.<sup>87</sup>

如果实施者表示愿意获得许可，专利权人可以立即向实施者提出根据 FRAND 承诺获得许可的书面要约。除了说明其许可费的计算方法外（参见第三部分），专利权人通常会提出具体的理由，解释为什么该要约是以 FRAND 承诺为根据进行许可的。这样做是为了让实施者确定所提出的条款是否合理和非歧视。<sup>88 89</sup> 尽管在一些法院判决中，法院表示，在实施者明确表示愿意获得许可之前，不会产生这种义务。<sup>90</sup>

For portfolios containing a large number of SEPs, even in cases where a rights holder presents a royalty offer based on comparable licensing terms accepted by the market, it may still be helpful for that rights holder to provide an explanation with specific grounds sufficient for the implementer to determine whether the terms are reasonable and non-discriminatory.

对于包含大量 SEP 的授权组合，即使专利权人以市场接受的可比较的许可条款提出许可条件，该专利权人仍应提供有具体理由的解释，足以让实施者确定

---

85 “Good Faith Negotiation Guidelines for Standard Essential Patent Licenses” of METI provides that the rights holder should provide specific license terms, including royalties, to the implementer and that, in addition to explaining how the royalties are calculated, the rights holder should explain that the license terms are FRAND by using appropriate information such as information concerning third-party licenses, royalty rates of patent pools, and court cases so that the implementer can objectively understand that the license terms are FRAND.

86 In *Philips v. Archos* (Germany, district court, 2016), since the royalty calculation method was not included in the FRAND offer, the right to seek injunctive relief was not upheld.

87 *Sisvel v. Haier* (Germany, Supreme Court, 2020).

88 经济产业省的“标准必要专利许可的善意谈判指南”规定，专利权人应向实施者提供具体的许可条款，包括许可费，除了解释许可费的计算方法外，专利权人应通过适当的信息，如有关第三方许可的信息、专利池的许可费率和法院案例，解释许可条款是 FRAND 的，以便实施者能够客观地理解许可条款是 FRAND 的。

89 在飞利浦诉 Archos 案（德国，地区法院，2016 年）中，由于许可许可费的计算方法没有包括在 FRAND 要约中，所以寻求禁令救济的权利没有得到支持。

90 *Sisvel v. Haier* 案（德国，最高法院，2020 年）

这些条款是否合理和非歧视。

Such specific grounds may include<sup>91</sup>:

这种具体的理由可能包括<sup>92</sup>:

- (1) An explanation of how the rights holder calculates royalties<sup>93</sup> (sufficient for the implementer to objectively understand that the terms presented satisfy the FRAND obligation.<sup>94</sup>); or
  - (2) A list of comparable licenses and their terms, if any,<sup>95</sup> (including royalties paid to, or received from, other companies for equivalent technologies, royalties by patent pool, etc., which may or may not be disclosed depending on the terms of confidentiality in licensing agreements with other companies) (refer to II.B.3. and III.A.3.a.).
- (1) 对专利权人如何计算许可费的解释<sup>96</sup> (足以让实施者客观地理解所提出的条款符合 FRAND 义务。<sup>97</sup>); 或者
- (2) 可比较的许可及其条款清单 (如果有的话)<sup>98</sup> (包括向其他公司支付的

---

91 For example, rights holders may also be able to present prices of products or components that are used as the basis of the royalty calculation, the ownership ratio of the rights holders relative to the total number of SEPs related to the standard, and the date of expiration of patents.

92 例如, 专利权人也可以提出作为许可费计算基础的产品或部件的价格, 专利权人相对于与标准相关的 SEP 总数的所有权比例, 以及专利到期的日期。

93 In *Sisvel v. Haier* (Germany, high court, 2016), the court stated that the rights holder needed to show the factors that formed the basis of its royalty calculation. (Although this ruling itself was reversed by the Supreme Court in 2020, this part was not denied.)

94 In *NTT DoCoMo v. HTC* (Germany, district court, 2016), the court stated that the rights holder needed to make it possible for the implementer to understand that the offer satisfied FRAND terms based on objective criteria.

95 In *Sisvel v. Haier* (Germany, high court, 2016), the court stated that if there is a license program of the same quality and scope as the portfolio, it is necessary to make a comparison with that program. (Although this ruling itself was reversed by the Supreme Court in 2020, this part was not denied.)

96 在 *Sisvel 诉海尔案* (德国, 高等法院, 2016 年) 中, 法院表示, 专利权人需要展示构成其许可费计算基础的因素。(尽管这一裁决本身在 2020 年被最高法院推翻, 但这一部分没有被否定)。

97 在 *NTT DoCoMo 诉 HTC 案* (德国, 地方法院, 2016 年) 中, 法院表示, 专利权人需要使实施者能够理解, 该要约符合基于客观标准的 FRAND 条款。

98 在 *Sisvel 诉海尔案* (德国, 高等法院, 2016 年) 中, 法院表示, 如果有一个与组合相同质量和范围的许可项目, 就有必要与该项目进行比较。(虽然这一裁决本身在 2020 年被最高法院推翻, 但这一部分

或从其他公司收到的同等技术的许可费，专利池的许可费等，根据与其他公司的许可协议中的保密条款，可以披露也可以不披露）（参考 II.B.3. 和 III.A.3.a）。

*(Notes on Rights Holders' Actions)* / 《专利权人行为的事项》

The following are examples of actions by a rights holder that may increase the likelihood of the rights holder being perceived as acting in bad faith:

以下是可能增加专利权人行为被视为恶意的例子：

- ( 1 ) Seeking an injunction against an implementer who has expressed its willingness to obtain a license on FRAND terms before offering a license on those terms, for the purpose of gaining leverage in the licensing negotiations;<sup>99 100</sup>
- ( 2 ) Sending letters warning that the rights holder will seek injunctive relief (cease-and-desist letters) to business partners of an implementer who has expressed its willingness to obtain a license on FRAND terms, despite ongoing negotiations<sup>101</sup>;
- ( 3 ) Presenting an initial offer that is clearly unreasonable given court rulings and comparable licensing terms, and sticking to that offer during the negotiation process<sup>102</sup>; or

---

并没有被否定）。

99 In *Realtek v. LSI* (U.S., federal district court, 2013), the court stated that seeking injunctive relief before offering a license on FRAND terms is a breach of contractual obligations.。

100 In *Microsoft v. Motorola* (U.S., court of appeals for the ninth circuit, 2012), the court stated that seeking injunctive relief in a related case in Germany before the decision of the U.S. court is “vexatious or oppressive”。

101 In *Imation v. One-Blue* (Japan, district court, 2015), the court stated that it is an announcement of a falsehood and falls under unfair competition to notify a customer of the implementer who expresses its willingness to obtain a license on FRAND terms that the rights holder can seek injunctive relief.。

102 Nonetheless, in *Microsoft v. Motorola* (U.S., federal district court, 2012), the court stated that since a FRAND declaration anticipates that the parties will negotiate toward a FRAND license, it logically does not follow that the initial offers must be on FRAND terms but must comport with the implied duty of good faith and fair dealing inherent in every contract. Also, in *Unwired Planet v. Huawei* (UK, high court, 2017), the court stated that offers in a negotiation that involve rates higher or lower than the FRAND rate, but do not disrupt or prejudice the negotiation, are legitimate.。



- (4) Not explaining how the royalty is calculated or not demonstrating that the license offer is on FRAND terms.
- (1) 在提供 FRAND 许可条件之前，寻求针对善意实施人的禁令，目的是在许可谈判中获得筹码；<sup>103 104</sup>
  - (2) 向已经表达了在 FRAND 基础上获得许可意愿的实施者的商业伙伴发送警告信，表示专利权人将寻求禁令救济（停止和阻止信），尽管谈判正在进行<sup>105</sup>。
  - (3) 提出一个相对于法院的裁决和类似的许可条款明显不合理的初始报价，并在谈判过程中坚持这一报价<sup>106</sup>；或
  - (4) 不解释许可费是如何计算的，或不证明许可报价是按 FRAND 承诺提出的。

#### 4.Step 4: Specific Counteroffer from Implementer on FRAND Terms / 4.第 4

步：实施者基于 FRAND 承诺提出的反要约（翻译人员：张燕）

(Overview) / (总论)

If an implementer disagrees with the proposed FRAND terms presented by a rights holder, the implementer may provide a FRAND counteroffer. When presenting such a counteroffer, in addition to indicating the royalty calculation method (refer to III.), the implementer normally indicates specific grounds demonstrating that its counteroffer is on FRAND terms. This is done for a rights holder to determine

---

103 在 Realtek 诉 LSI 案（美国，联邦地区法院，2013 年）中，法院指出，在按 FRAND 条款提供许可之前寻求禁令救济是对合同义务的违反。

104 在微软诉摩托罗拉案（美国，第九巡回上诉法院，2012 年）中，法院表示，在美国法院作出裁决之前，在德国的一个相关案件中寻求禁令救济是“无理取闹或压迫”。

105 在 Imation 诉 One-Blue 案（日本，地方法院，2015 年）中，法院指出，通知表示愿意以 FRAND 条款获得许可的实施者的客户：专利权人可以寻求禁令救济，这是宣布虚假信息，属于不公平竞争。

106 然而，在微软诉摩托罗拉案（美国，联邦地区法院，2012 年）中，法院表示，由于 FRAND 声明预计双方将通过谈判达成 FRAND 许可，因此从逻辑上讲，最初的提议不一定是 FRAND 条款，但必须符合每份合同中固有的善意和公平交易的隐含义务。另外，在 Unwired Planet 诉华为案（英国高等法院，2017 年）中，法院指出，谈判中涉及高于或低于 FRAND 费率但没有扰乱或损害谈判的要约，是合法的。

whether the presented terms are reasonable and non- discriminatory.<sup>107</sup>

如果实施者不同意专利权人提出的 FRAND 承诺，则实施者可进行符合 FRAND 承诺下的反要约。在提出反要约时，除了说明许可费的计算方法（参见第 III 节）外，实施者还应指出具体根据，证明其反要约是以 FRAND 承诺进行的，这样做是为了让专利权人确定所提出的条款是否合理且非歧视。<sup>108</sup>

Such specific grounds may include:

这些具体根据包括：

- (1) An explanation of how the royalty presented by the implementer is calculated (sufficient that the rights holder can objectively understand that the terms presented satisfy the FRAND obligation); and
- (1) 解释实施者提出的许可费是如何计算的（足以使专利权人能够客观地理解其所提交的条款符合 FRAND 承诺）；及
- (2) A list of comparable licenses and their terms, if any (including royalties paid to, or received from, other companies for equivalent technologies, royalties by patent pool, etc. which may or may not be disclosed depending on the terms of confidentiality agreements) (refer to II.B.3. and III.A.3.a.)
- (2) 如果有的话，提供可比较许可及其条款（根据保密条款而可能揭露或不揭露的内容，包括同等技术支付给其他公司或从其他公司获得的使用费、专利池使用费等）（参见 II.B.3. 和 III.A.3.a.）。

*(Reasonable Amount of Time for Response)* / （合理的回应时间）

107 “Good Faith Negotiation Guidelines for Standard Essential Patent Licenses” of METI provides that the implementer should provide specific license terms, including royalties, as a counteroffer to the rights holder and that, in addition to explaining how the royalties are calculated, the implementer should explain that the license terms are FRAND by using appropriate information such as information concerning third-party licenses<sup>15</sup>, royalty rates of patent pools, and court cases so that the rights holder can objectively understand that the license terms are FRAND.

108 METI 的“标准必要专利许可的善意谈判指南”规定，实施者应提供具体的许可条款，包括许可费，作为对专利权人的还价，并且除了解释如何计算特许权许可费外，实施者还应通过使用有关第三方许可的信息<sup>15</sup>、专利池的许可费率和法院案件等适当信息来解释许可条款是 FRAND，以便专利权人能够客观地理解许可条款是 FRAND

The reasonable time period from when an implementer receives an offer on FRAND terms from a rights holder until the implementer presents a counteroffer is determined on a case by case basis. When the technologies of the SEPs are not complicated, the implementer may present its counteroffer in a relatively short period of time. When technological complexity or other issues require a certain amount of work to prepare a response, it may be deemed reasonable for an implementer to respond in several months or more.

当实施者收到专利权人基于 FRAND 承诺的授权要约后，实施者提出反要约的合理时间段将根据具体情况确定。在 SEP 技术不复杂的情况下，实施者可以在相对较短的时间内提出反要约。当技术复杂或其他问题需要一定的作业时间来回应时，实施者在数月或更长时间内做出回应也可能是合理的。

Factors that may determine what constitutes a reasonable amount of time to provide a counteroffer include: the number of patents at issue, the complexity of the technology, the number and type of products at issue, whether any comparable royalty rate exists, and whether the parties are negotiating a worldwide license or regional license (refer to II.B.1).

决定提出反要约的合理时间的可能因素包括：涉及的专利数量、技术的复杂程度、涉及的产品数量和类型、是否存在任何可提供比较的专利许可费以及双方谈判是全球还是区域的专利授权（参见 II.B.1）。

*(Notes on Implementers' Actions)* / (实施者行为的注意事项)

The following are examples of actions by an implementer that may increase the likelihood of the implementer being perceived as acting in bad faith:

以下是实施者行为的示例，这些行为可能会增加实施者被视为恶意行为的可能性：

- (1) Not providing any counteroffer on FRAND terms after a rights holder has presented specific grounds showing that its proposed licensing terms are

FRAND<sup>109</sup>;

- (1) 在专利权人提出基于 FRAND 承诺的授权要约后，不以 FRAND 承诺提供任何反要约；
- (2) Presenting an initial counteroffer that is clearly unreasonable given court rulings and comparable licensing terms, and sticking to that counteroffer during the negotiation process<sup>110</sup>; or
- (2) 与法院判决和可比较的授权案例之条件相比，提出明显不合理的反要约，并在谈判过程中坚持该反要约<sup>111</sup>；或
- (3) Not explaining how a proposed royalty is calculated or not demonstrating that the counteroffer is on FRAND terms.
- (3) 没有解释提出反要约的许可费是如何计算的，也没有说明反要约是否符合 FRAND 承诺。

An implementer who does not provide a counteroffer on FRAND terms may not immediately be viewed as being in bad faith when further discussions are needed to determine the technical relationship between the subject patents and the standards as well as the validity of the patents, or when a rights holder does not provide any specific offer on FRAND terms or the basis thereof.

当需要进一步讨论以确定待许可专利和标准之间的技术关连性以及专利的有效性时，或者专利权人没有具体的 FRAND 承诺提案时，实施者未提供 FRAND 承诺的反要约不会立即被视为恶意行为。

### **5.Step 5: Rejection by Rights Holder of Counteroffer/Settlement of Disputes in Courts or through ADR / 5.第 5 步：专利权人拒绝反要约/透过法院或 ADR**

---

109 In *Apple v. Motorola* (U.S., CAFC, 2014), the court stated that an injunction may be justified when an implementer unilaterally refuses a FRAND royalty or unreasonably delays negotiations to the same effect. In *NTT DoCoMo v. HTC* (Germany, district court, 2016), the court granted injunctive relief where the implementer did not respond or make a counteroffer for 1.5 years after receiving the FRAND offer and six months after the filing of the court action.

110 See Footnote 53.

111 见脚注 53。

## 的争议协议

*(Overview) / (概述)*

Generally, negotiations proceed through a process of offer and counteroffer between rights holders and implementers, but if a rights holder rejects a counteroffer from the implementer and the parties fail to reach an agreement, and if one or both parties does not wish for time to go by without agreement being reached, they may be able to address their dispute in court.<sup>112</sup>

一般来说，谈判通过专利权人和实施者之间的要约和反要约进行，如果专利权人拒绝接受经由实施者提出的反要约并且各方未能达成协议时，且如果一方或双方不希望在未达成协议的情况下浪费时间，当事人会想要经由诉讼来解决<sup>113</sup>

As an alternative to litigation, the parties may agree to settle their disputes through Alternative Dispute Resolution (ADR), such as mediation or arbitration.

当事人可能同意经由 ADR（例如调解或仲裁等）作为诉讼的替代选择方案来解决争议。

*(Utilization of ADR) / (ADR 的利用)*

Since it may be unrealistic for a court to determine the essentiality, validity, and infringement of dozens, or potentially even hundreds, of SEPs, a rights holder may choose several of its important patent rights to bring to court. Some argue that the greater procedural flexibility of ADR such as mediation and arbitration makes it more effective in terms of promptly settling SEP disputes over a large number of domestic and international patents.

由于通过法院来确定数十个甚至数百个 SEPs 的必要性、有效性和侵权可能性是不现实的，因此专利权人通常会选择数件重要的专利来提起诉讼。一些人认

---

<sup>112</sup> In *Realtek v. LSI* (U.S., federal district court, 2013), the court stated that if a putative implementer refuses to pay what has been determined to be a FRAND royalty, or refuses to engage in a negotiation to determine FRAND terms, an injunction could be appropriate.

<sup>113</sup> 在 *Realtek 诉 LSI* 案（美国，联邦地区法院，2013 年）中，法院指出，如果推定实施者拒绝支付已确定为 FRAND 特许权许可费，或拒绝参与确定 FRAND 条款的谈判，禁令可能是适当的。

为，调解和仲裁等 ADR 具有更大程度的程序灵活性，这使其在更多的国内和国际专利上迅速解决 SEP 争议更为有效。

Unless used as a tool to intentionally delay negotiations or increase cost, ADR may be a more prompt and more cost-effective approach, compared to a lawsuit.<sup>114</sup>  
<sup>115</sup>In addition, parties have more flexibility in setting their own rules and procedures. As an example, parties can agree that arbitrators will make decisions only on royalties for SEPs on FRAND terms, without considering the essentiality and validity of the SEPs.<sup>116</sup>

除非以故意延迟谈判或增加谈判成本为目的外，跟诉讼相比，ADR 可能是更迅速更节省成本的解决方法<sup>117 118</sup>此外，当事人可以更有弹性地设定规则及程序，例如，当事人可以同意仲裁员不考虑 SEPs 必要性及有效性，只决定在 FRAND 承诺下的许可费<sup>119</sup>。

In particular, an international arbitration process may be used to reach a single settlement globally as arbitral awards overseas are recognized and enforced under the New York Convention.

特别是可以利用国际仲裁来达成全球性问题的一次解决，因为海外仲裁裁决可以根据《纽约公约》得到承认和执行。

---

114 Although forms of ADR such as arbitration may not be quicker and more cost effective than litigation in every case, there is a view that arbitration has numerous benefits over litigation with respect to efficiency (Benefits of Arbitration for Commercial Disputes, American Bar Association).

115 For example, in the International Arbitration Center in Tokyo (IACT: established in 2018), arbitrators and mediators selected from major jurisdictions around the world will resolve international disputes over IP rights within one year from the official start of the arbitration procedure, unless otherwise agreed by concerned parties.

116 There are many ways parties can structure ADR, including authorizing a neutral (or panel of neutrals) to decide certain discrete issues or make non-binding recommendations as to those issues.

117 尽管在每种情况下，仲裁等 ADR 形式可能并不比诉讼更快、更具成本效益，但有一种观点认为，在效率方面，仲裁比诉讼有许多好处（商业纠纷仲裁的好处，美国律师协会）。

118 例如，在东京国际仲裁中心（IACT：成立于 2018 年），除非另有规定，否则从世界主要司法管辖区挑选的仲裁员和调解员将在仲裁程序正式启动后一年内解决知识产权国际争议。经有关各方同意。

119 当事人可以通过多种方式构建 ADR，包括授权中立人（或中立人小组）决定某些离散问题或就这些问题提出不具约束力的建议。

Some consider, however, that there are demerits to the use of ADR. For example, ADR requires prior agreement between the disputing parties, which means that disagreements over procedures can become protracted; it is difficult to determine the validity of patent rights through ADR; and the content of ADR is undisclosed and thus lacking transparency.

然而，有些人认为 ADR 的使用存在缺陷。例如，ADR 要求争议双方事先达成协议，这意味着程序上的分歧可能会造成拖延；通过 ADR 难以确定专利权的有效性；且 ADR 的内容未公开，缺乏透明度。

Some argue that proposing or accepting the use of ADR could be considered as evidence of good faith in negotiations, while others regard it as a rather weak indicator of good or bad faith in most cases. Either way, while the refusal of ADR options may not immediately be viewed as bad faith, continuing to do so may be seen as bad faith in some cases.<sup>120</sup>

一些人认为，提议或接受 ADR 的使用可以被视为善意谈判的证据，而另一些人则认为在大多数情况下，它是一个相当弱的善意或恶意指标。无论哪种方式，虽然拒绝选择 ADR 程序可能不会立即被视为恶意，但在某些情况下继续这样做可能会被视为恶意。<sup>121</sup>

(Security Offered by Implementers) / (由实施者所提供担保)

Under the framework presented in the CJEU decision in the case between Huawei v. ZTE, the court stated that when an alleged infringer has used SEPs before concluding any licensing agreements, from the time its counteroffer is refused, the alleged infringer is required to provide appropriate security in accordance with recognized commercial practices in Europe, for example by providing a bank guarantee or by placing the necessary amounts on deposit. It also stated that “[t]he calculation of that security must include, inter alia, the number of the past act of use of the SEP, and the alleged infringer must be able to render an account in respect of

<sup>120</sup> In Huawei v. Samsung (China, Shenzhen intermediate court, 2018).

<sup>121</sup> 华为诉三星案（中国，深圳中级法院，2018 年）。

those acts of use.” This is based on the idea that it would be contradictory and therefore unfair for the implementer to assert its willingness to pay the license fee but actually fail to do so even while using the product.

根据欧盟法院对华为诉中兴案裁决中所提出的框架，法院表示，当被诉侵权人在签订许可协议前就使用了标准必要专利且反要约被拒绝时，被诉侵权人必须提出符合欧洲商业实务认可的适当担保，例如提供银行担保或存入必要担保金。它还表示，“这种担保的计算必须包括过去使用 SEP 行为的数量，并且被指控的侵权人必须能够就这些使用行为进行说明。”这是基于这样一种想法：如果实施人声称愿意支付许可费用，但实际上却在使用产品时没有这样做，这将是矛盾的，因此是不公平的。

Although providing such security may be a factor in considering good faith, an implementer's failure to offer security may not necessarily increase the likelihood of being viewed as bad faith in regions outside Europe, such as Japan and the United States. There is a view, however, that where an implementer lacks the financial capability to meet its financial obligations under a license ultimately to be concluded, the implementer could be viewed as acting in bad faith for not providing appropriate security.

尽管提供该担保可能会被认为是善意的考虑因素，但在欧洲以外的区域，如日本或美国，实施者不提供担保也不一定就会被认为恶意。然而，有一种观点认为，如果实施者缺乏财务能力来履行其最终要签订的授权契约下的财务义务，那么实施者可能会因无法提供适当担保而被视为恶意。

There is also a view that the provision of security gives both parties the incentive to negotiate in good faith.

还有一种观点认为，提供担保会激励双方进行善意谈判。

*(Exercise of Right to Seek Injunction)* / (禁令请求权的行使)

Around the world, there has been an accumulation of legal precedents concerning SEP-related injunctions. Most courts have imposed limitations on the



exercise of the right to seek an injunction against implementers who have responded in good faith, and have determined that it would be appropriate for a rights holder to be allowed to exercise its right to seek an injunction when implementers have responded in bad faith during the negotiation process.

世界范围内，各个国家已经累积了许多 SEP 禁令相关的判例。在这些判例中，大多数法院已对做出善意回应的实施者行使禁令请求权施加了限制，对于谈判态度非善意之实施者，认为允许专利权人行使禁制令请求权是适当的。

Nonetheless, grounds for restricting the rights of SEP owners to seek injunctions vary by country. For example, there have been cases in which the exercise of the right to seek an injunction was restricted based on, in the United States, the requirements for seeking injunction, as detailed in the decision by the Supreme Court in the eBay case and the contractual effects of FRAND declarations to SSOs on third parties<sup>122</sup>; in the U.K., the contractual effects of FRAND declarations to SSOs on third parties<sup>123</sup>; in Europe, a violation of the Competition Law by the rights holder's abuse of its dominant position<sup>124</sup>; and in Japan, the rights holder's abuse of patent rights.<sup>125</sup>

---

122 In the United States, in general, an injunction (35 U.S.C. 283) takes into account the four requirements identified in *eBay v. MercExchange* (U.S., Supreme Court, 2006). A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available under the common law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction. Regarding SEPs, in both *Microsoft v. Motorola* (U.S., federal district court, 2013) and *Apple v. Motorola* (U.S., CAFC, 2014), the court regarded the FRAND commitments to the SSO as a contract between the rights holder and the SSO for a third-party beneficiary, and did not grant injunctive relief because the rights holder did not satisfy one of the factors in *eBay* (U.S., Supreme Court, 2006), namely “that it has suffered an irreparable injury,” because the contract between the two parties enabled the rights holder to obtain relief via the royalty paid by the implementer. In *Apple v. Motorola*, parties' attitudes toward negotiations are also considered as a factor.

123 In *Unwired Planet v. Huawei* (U.K., high court, 2017), the court stated that the contractual effect of the FRAND declaration to an SSO will extend to third parties. This was supported also by the decision of the Supreme Court in 2020.

124 In *Huawei v. ZTE* (EU, CJEU, 2015), the court identified the steps that the rights holder must take before seeking injunctive relief, such as alerting the implementer or presenting a specific, written offer for a license on FRAND terms. The court held that if the implementer improperly delays after these steps are taken by the rights holder, an injunction will not violate competition law and seeking injunctive relief will be justified.

125 In Japan, there is no provision that limits an injunction in general, but regarding FRAND encumbered SEPs, in *Apple v. Samsung* (Japan, IP high court, 2014), seeking injunctive relief against a person who is willing to

然而，各个国家限制 SEP 专利权人禁令请求权的理由不尽相同。例如，美国最高法院在 eBay 案中判决详细说明了 SSO 的 FRAND 承诺对第三人以及契约上的效果作为禁止要点；<sup>126</sup>英国 SSO 的 FRAND 承诺对第三人合同上的效果；<sup>127</sup>欧洲因专利权人滥用其支配地位而违反竞争法；日本是专利权人对专利权的滥用。<sup>128</sup>

Also, competition authorities in Japan and Europe suggest that demanding an injunction against an entity that is willing to obtain a license on FRAND terms may be a violation of competition law.<sup>129</sup>The competition authority in the United States does not agree that this conduct comprises the basis for a competition violation,<sup>130</sup> although it might be reviewed after the change of administration.<sup>131</sup> Attention must be

---

obtain a license was deemed to be an abuse of rights.

126 在美国，禁令（35 U.S.C. 283）一般会考虑 eBay 诉 MercExchange（美国，最高法院，2006 年）中确定的四项要求。原告必须证明：（1）其遭受了无法弥补的伤害；（2）普通法下可用的补救措施，例如金钱赔偿，不足以补偿该损害；（3）考虑到原告和被告之间的困难平衡，衡平法救济是正当的；（4）永久禁令不会损害公共利益。关于标准必要专利，在 Microsoft 诉摩托罗拉（美国，联邦地区法院，2013）和 Apple 诉摩托罗拉（美国，CAFC，2014）中，法院均将 FRAND 对 SSO 的承诺视为专利权人与 SSO 之间的合同为第三方受益人，并且没有授予禁令救济，因为专利权人不满足 eBay（美国，最高法院，2006 年）中的一个因素，即“它遭受了无法弥补的伤害”，因为之间的合同双方当事人使专利权人能够通过实施者支付的特许权许可费获得救济。在苹果诉摩托罗拉案中，当事人对谈判的态度也是一个因素。

127 在 Unwired Planet 诉华为案（英国，高等法院，2017 年）中，法院指出，FRAND 声明对 SSO 的合同效力将延伸至第三方。最高法院在 2020 年的决定也支持这一点。

128 在日本，一般没有限制禁令的条款，但关于 FRAND 设保的标准必要专利，在 Apple 诉三星案（日本，IP 高等法院，2014 年）中，对愿意获得许可的人寻求禁令救济是视为滥用权利。

129 See, for example, *Motorola v. Apple* (EU, EC, 2014); *Samsung v. Apple* (EU, EC, 2014); “Guidelines for the Use of Intellectual Property under the Antimonopoly Act” (The Japan Fair Trade Commission, 2016).

130 Makan Delrahim, then Assistant Attorney General (2017-2021), Antitrust Division, U.S. Department of Justice (DOJ), stated as a view of the DOJ that “it is just as important to recognize that a violation by a patent holder of an SSO rule that restricts a patent-holder’s right to seek injunctive relief should be appropriately the subject of a contract or fraud action, and rarely if ever should be an antitrust violation.”

131 For example, in the U.S., based on the Executive Order on Promoting Competition in the American Economy issued on July 9, 2021 after a change of the administration, in order to avoid the possibility of widening anti-competitive market power beyond the scope of patent rights and prevent the abuse of standards-setting process, the intersection of the intellectual property laws and anti-trust laws would be reviewed, including discussion on possible revisions to the past Policy Statements on SEPs. In December 2021, new draft Policy Statement was jointly released by U.S. DOJ, USPTO, and the National Institute of Standards and Technology (NIST) and public

paid to the future trends of how the authorities in each country respond to this situation.

此外，日本和欧洲主管公平竞争的当局表示，对愿意获得 FRAND 授权的实体行使禁令请求权可能会违反竞争法。<sup>132</sup>美国主管公平竞争的当局则不同意这种行为会构成违反竞争法的基础，尽管它可能会在主管变更后进行审查。<sup>133</sup>各国当局必须关注这种情况的未来趋势应当如何应对。

## **B. Efficiency / B.效率性**

To conduct licensing negotiations smoothly, it is also important to consider efficiency along with good faith. The following sections address key points that should be considered for the efficient conduct of FRAND-based negotiations.

为使谈判顺利进行，除善意性之观点外，效率性之观点也是十分重要。以下段落说明在 FRAND 承诺下，有效率进行谈判应该注意的重点。

*[Factors for Efficient Negotiation] / [有效率谈判之重要因素]*

1. Notification of a Timeframe
2. Parties to Negotiation in Supply Chain
3. Protecting Confidential Information
4. Choice of Patents subject to Negotiation
5. Geographic Scope of License Agreement
6. Patent Pool Licensing
7. Greater Transparency of SEPs

1.通知谈判期程；

---

comments were requested.

132 例如，参见摩托罗拉诉苹果案（欧盟、欧共体，2014 年）；三星诉苹果案（欧盟、欧共体，2014 年）；“根据反垄断法使用知识产权的指南”（日本公平贸易委员会，2016 年）。

133 例如，在美国，根据政府换届后 2021 年 7 月 9 日颁布的《促进美国经济竞争的行政命令》，以避免将反竞争市场力量扩大到超出专利权和防止滥用标准制定过程，将审查知识产权法和反垄断法的交叉点，包括讨论对过去标准必要专利政策声明的可能修订。2021 年 12 月，美国司法部、美国专利商标局和美国国家标准与技术研究院 (NIST) 联合发布了新的政策声明草案，征求公众意见。

- 2.供应链谈判之主体;
- 3.保护机密信息;
- 4.作为谈判对象专利之选择;
- 5.许可协议之地域范围;
- 6.专利池授权;
- 7.提升 SEPs 透明性。

## 1. Notification of a Timeframe / 1.通知谈判期程 (翻译人员: 张雅宁)

For negotiations to proceed smoothly, it is desirable for the parties to notify each other of the overall expected timeframe as well as the timeframe required for each of the stages identified in II.A above.

为使谈判顺利进行, 当事者最好能通知对方于本文 II .A 段落中所述之各阶段全部期望时程表。

The negotiation timeframe may vary widely. Factors that may be considered in setting reasonable expectations for a timeframe may include, but are not limited to: the number of patents at issue, the complexity of the technology, the number of different products and types/nature of the products at issue, matters pending in the courts or patent offices that relate to issues underlying the negotiation (e.g., essentiality and validity), and the number of licenses the patent owner has already granted for the SEPs.

每一案件的必要谈判时限可能会有极大差异, 有关合理预设谈判期间之考虑要素, 包括但不限于: 作为谈判对象专利的数量、技术的复杂度、不同产品的数量及作为谈判对象产品的种类、产品的种类及性质、是否存在系属于法院或知识产权局中之必要性或专利有效性争讼的相同案件以及专利权人已经授权 SEPs 的数量等。

In the case that an implementer seeks to secure a relatively long negotiation timeframe, there is a view that the specific grounds need to be explained to the rights

holder to gain their understanding.

在实施者欲确保相对较长谈判期程时，有意见认为有必要向专利权人说明具体理由并获得理解。

Naturally, as discussions proceed, there may be events that require the timeframe to be changed. Nonetheless, discussing and clarifying the expected timeframe early on can enable both parties develop a shared sense of the likely negotiation timeframe.<sup>134</sup>

当然，随着谈判的进展，可能发生中途变更谈判期程的情形。然而，尽早讨论及厘清预设之谈判期程可以使双方能够就可能的谈判期程达成共识。<sup>135</sup>

In particular, with product lifecycles becoming shorter, there is some concern that prolonged negotiations could prevent the timely recovery of the investment that would allow for investment in next-generation technologies. Some argue that protracted negotiations may also lead to engineers and other resources that should have been channeled into R&D instead being used for negotiations, creating a major burden.

特别是当产品生命周期变短时，谈判期间过长可能会造成产品技术过时，以致于专利权人无法及时回收下一代技术开发投资成本。再者，也有人认为，长期的谈判也可能导致工程师和其他本来应该被用于研发的资源被用于谈判，从而造成重大负担。

Meanwhile, when the negotiation timeframe is unreasonably short, there is some concern that due to the lack of sufficient time to appropriately evaluate the essentiality and validity of patents and the terms of license, implementers are forced to agree

---

134 While the overall negotiation timeframe will vary by case, some suggest as a rough reference to what timeframe needed for prompt completion might look like that complex cross licenses with vast portfolios might complete in 12 months, one-way licenses with fewer SEP families at stake in 9-12 months, and simple one-way licenses with a few patents in 6-9 months. Others, however, do not like the idea of any numerical benchmark for negotiation timeframes.

135 虽然全部谈判时间会因个案而异，有人建议迅速完成谈判所需时间框架的粗略参考如下，例如，包含多个专利组合的交互授权这种复杂的案例可能在 12 个月内完成，较少 SEP 家族的单向授权在 9-12 个月内完成，以及少量专利的简单单向授权在 6-9 个月内完成，另一方面，也有不喜欢任何关于谈判时间表的数字基准的概念。

licensing terms one-sidedly claimed by rights holders. Also, some argue that certain licensing terms may cause price hike of products and negatively impact the adoption and use of standard technologies.

同时，当谈判时间不合理地缩短时，有人担心由于缺乏足够的时间来适当地评估专利和许可条款的重要性和有效性，实施者会被迫同意权利持有人单方面要求的许可条款。另外，也有人指出，某些许可条款可能会导致产品价格上涨，并对标准技术的采用和使用产生负面影响。

While some consider that notifying the estimated length of time for licensing negotiations may increase the likelihood of that party being perceived as acting in good faith, others suggest that not doing so will not necessarily be perceived as bad faith.

虽然有人认为通知授权谈判的时限可能会增加被视为善意行为的可能性，但也有其他人认为不通知预估时间并不一定会被视为恶意行为。

## **2. Parties to Negotiation in Supply Chain / 2.供应链谈判之主体**

*(Overview) / (概述)*

With the spread of IoT, the use of standards has become more common. One issue often arising during negotiations is which entities in the manufacturing supply chain should be parties to licensing negotiations (e.g., component suppliers versus end-product manufacturers). There may not be a problem in selecting the parties to a negotiation as long as the parties can agree based on industry practices. Problems may arise, however, if, for example, a component installed in the end product implements a SEP.

随着物联网的普及，标准的利用更为常见。在谈判中经常出现的一个议题，是制造供应链中的哪一个主体才应该是授权契约的缔约主体(例如零件供货商或最终产品制造商)。有关授权谈判的主体依业界惯例，只要当事者同意就没问题，然而，例如在装置于最终产品中的零件实施 SEP 时便会产生问题。

While the level of the main parties to negotiations should be determined on a

case by case basis, in the interests of, for example, making license management easier, rights holders generally tend to want to conclude license agreements with the end-product manufacturer.<sup>136</sup> On the other hand, the end-product manufacturer tends to want the supplier that has the most technical knowledge on the subject component to be the party involved in negotiating and concluding the licensing agreement. This tendency is especially evident in industries where the general practice is for the supplier to accept a patent indemnification agreement that puts the burden of licensing fees on the supplier.

虽然授权谈判主体的层级应该根据实际案例决定, 但为专利权人容易管理授权, 专利权人倾向和最终产品制造商签订授权契约。<sup>137</sup>另一方面, 也可见最终产品制造商希望在主题零件方面拥有更多技术知识的供货商作为授权和缔结许可协议的趋势, 在一些行业, 这种趋势尤其明显, 因为一般做法是供应商接受专利赔偿协议, 使供应商承担许可费的负担。。

*(Implementer Who Will be the Party to Licensing Negotiations) / (谁是参与授权谈判的实施者)*

In general, the rights holder is in the position to decide with which party in the supply chain it signs an agreement, e.g., end-product manufacturer, component manufacturer, or sub-component manufacturer.

一般而言, 由专利权人决定与供应链中的哪一个供货商缔结授权契约, 例如: 最终产品制造商、零件制造商、附属零件制造商等。

---

<sup>136</sup> While some argue that the reason that rights holders want to negotiate with end-product manufacturers is that they hope they will be able to gain more royalties that way, just as licensing rates change according to the basis of calculation (refer to III.A.2.), licensing rates too change according to where the main parties to the negotiation stand in the supply chain (lower for end-product manufacturers and higher for component suppliers), leading some parties to suggest that negotiating with end-product manufacturers does not necessarily produce more royalties.

<sup>137</sup> 虽然有些人认为专利权人希望与最终产品制造商谈判的原因是, 他们希望他们能够以这种方式获得更多的许可费, 就像根据计算基础而改变许可费率一样(参见 III.A.2), 授权费率也会根据谈判主要参与方在供应链中的位置(最终产品制造商较低而零件供货商较高价格)而变化, 导致一些缔约方建议与最终产品制造商进行谈判不必然会产生更多的许可费。

Meanwhile, there is some debate globally on whether FRAND-encumbered SEPs should be licensed to anyone who desires to obtain such a license.<sup>138 139</sup>

另一方面，有关已做出 FRAND 承诺的 SEP，是否应该授权给任何想得到授权的人，在国际上是有争议的。<sup>140 141</sup>

There are some end-product manufacturers that consider it discriminatory and contrary to FRAND commitments if the rights holder refuses to grant a license to the supplier manufacturing the component when it requests a license. On the other hand, some consider it inappropriate for the end-product manufacturer to refuse negotiations when the rights holder requests it to obtain a license. In recent years, in some countries, the court recognized cases in which rights holders may negotiate with end-product manufactures as the party to the licensing negotiations.<sup>142 143</sup>In one of

---

138 The idea that rights holders must license all entities wishing to obtain licenses regardless of the level in the supply chain is commonly referred as “license to all.” On the other hand, the idea that the FRAND declaration is not a requirement for licensing to all parties using standard technology but is rather a mechanism to ensure that those who want to use standard technology can access that technology is commonly referred as “access for all.” Further, some argue that “access for all” means that it is enough to ensure access to standard technologies and does not require access to a license. This opinion is said to conflict with the idea of “license to all.”

139 In 2015, the Institute of Electrical and Electronics Engineers (IEEE) amended its patent policy to state that rights holders should be willing to make licenses available to anyone who requests a license. Objections to this amendment have been made by rights holders (IEEE-SA Standards Board Bylaws (2015)). Also, in *Apple v. Samsung (Japan, IP High Court, 2014)*, the court held, regarding the language of the ETSI’s IPR policy, that the FRAND declaration is not literally deemed a firm license grant because, compared with other possible wordings, the expression is not definitive and contemplates further actions by the declarant.

140 专利权人必须授权给所有想得到授权的实体不论是供应链中的哪一个层级的这种想法一般被称为“license to all”。另一方面，FRAND 宣言被认为是并非要求授权给所有利用标准技术的当事者，而是确保想利用标准技术的人可以使用该技术的机制，一般称为“access for all”。此外，一些人认为“所有人都可以访问”意味着确保对标准技术的访问就足够了，并且不需要获得许可证。据说这种观点与“向所有人许可”的想法相冲突。

141 再者，2015 年美国电机电子学会(IEEE)修改专利政策，叙述专利权人对要求授权的所有人必须有授权意愿，关于这种见解，SEP 所有权人提出反对的意见。(IEEE-SA Standard Board Bylaws 2015)。此外，在 *苹果诉三星案（日本，知识产权高等法院，2014 年）*中，法院认为，关于 ETSI 知识产权政策的措辞，FRAND 声明并未从字面上视为确定的许可授予，因为与其他可能的措辞相比，该表达不是确定的，并考虑了声明人的进一步行动。

142 Examples include *Nokia v. Daimler (Germany, District Court of Munich, 2020)* and *Sharp v. Daimler (Germany, District Court of Munich, 2020)*, and *Conversant v. Daimler (Germany, District Court of Munich, 2020)*. For example, in *Sharp v. Daimler*, since the end- product manufacture claimed that the rights holder should grant a



these cases, the referral was made to the CJEU, seeking preliminary ruling as to whether they had an obligation to license suppliers on a priority basis.<sup>144</sup> Nonetheless, since the initial litigations reached settlement, the referral was withdrawn, and the CJEU did not provide any views in this regard. Meanwhile, there are some cases in which suppliers conducted negotiations as the party and obtained a license.<sup>145</sup>

一些最终产品制造商认为,如果专利权人拒绝向制造组件的供应商颁发许可证,是歧视且违反 FRAND 承诺。另一方面,一些人认为,专利权人要求最终产品制造商获得许可时,最终产品制造商拒绝谈判是不适当的。近年来,在一些国家,法院承认了专利权人可以作为许可谈判的一方与最终产品制造商进行谈判的案件。<sup>146</sup><sup>147</sup>在其中一个案件中,向欧盟法院提交了转介,要求初步裁定他们是否有义务优先向供应商发放许可证。<sup>148</sup>尽管如此,自从最初的诉讼达成和解后,转介被撤回,欧盟法院没有就此提出任何意见。同时,也有供应商作为一方进行谈

---

license to the supplier manufacturing the component, the court determined that the end-product manufacture had no intention to obtain a license. Also, the court stated that the rights holder had no obligation to grant a license to all of the component manufactures and that it would be enough to set so-called have-made rights to ensure access to the patented technologies.

143 In *Continental v. Avanci* (U.S. District Court of Northern Texas, 2020), it was claimed that the patent pool violated the antitrust laws because it granted a license only to the end-product manufacturer. The court held that the patent pool did not violate the antitrust laws because each company that joined the pool was allowed to grant a license individually.

144 In *Nokia v Daimler* (EU, CJEU, 2021), the referral was made to the CJEU as to whether there is an obligation to license suppliers on a priority basis, but the referral was withdrawn later.

145 In July 2020, for a portfolio covering automobile parts, Huawei was reported to obtain a license from Sharp. Also, in September 2020, it was released that u-blox obtained a license from Sisvel.

146 案例包括诺基亚诉戴姆勒(德国,慕尼黑地方法院,2020年)和夏普诉戴姆勒(德国,慕尼黑地方法院,2020年)和 *Conversant* 诉戴姆勒(德国,慕尼黑地方法院,2020年)。例如,在夏普诉戴姆勒案中,由于最终产品制造商声称专利权人应向制造该组件的供应商授予许可,法院认定最终产品制造商无意获得许可。此外,法院还指出,专利权人没有义务向所有组件制造商授予许可,只需设置所谓的已完成权利以确保获得专利技术。

147 在 *Continental* 诉 *Avanci* 案(美国,德克萨斯州北部地区法院,2020年)中,声称专利池违反了反垄断法,因为它仅向最终产品制造商授予许可。法院认为,专利池不违反反垄断法,因为每个加入专利池的公司都可以单独授予许可。

148 在诺基亚诉戴姆勒案(欧盟,欧洲法院,2021)中,向欧洲法院提交了关于是否有义务优先许可供应商的案件,但该案件后来被撤回。

判并获得许可的案例。<sup>149</sup>

In addition, some argue that if the essential part of the patented invention is used only in the components provided by the supplier, it is appropriate for the supplier to be the party to the licensing negotiations. Others argue that if the standards are for the end product, and when the essential part of the patented invention contributes to the end product, it is appropriate for the end-product manufacturer to be the party in licensing negotiations.

再者,有意见认为如果专利发明的重要本质部分只使用在由供货商提供的零件上时,由供货商作为授权谈判的主体是适当的,同时,也有意见认为如果专利发明的重要本质部份对最终产品有贡献的话,由最终产品制造商作为授权谈判的主体也是适当的。

In any case, since there is a risk that injunctive relief against infringement may be granted against entities regardless of whether they are suppliers or end-product manufacturers if no entity in the supply chain obtains the license, all supply chain entities need to be aware of the status of conclusion of licensing agreements.

不管如何,必须注意如果供应链中有一个实体未得到授权时,不论是供货商或是最终产品制造商都会有针对侵权行为而被颁发禁令的风险存在,所有供应链实体都必须留意有关授权契约的签署状态。

*(Arguments from the Standpoint of Number of Players) / (被授权谈判对象之观点说明)*

Some argue that having the end-product manufacturer involved in negotiations is most efficient, in that the licensing negotiations can then cover all the components contained in a product and consequently minimize the number of necessary negotiations as well as reduce negotiation costs, while also avoiding issues such as discrepancies in the licensing terms between suppliers.<sup>150</sup>

<sup>149</sup> 2020年7月,据报道,华为在汽车零部件产品组合方面获得了夏普的许可。此外,2020年9月,u-blox获得了Sisvel的许可。

<sup>150</sup> One view is that where SEPs are not limited to a component (i.e., a portfolio of SEPs covering more than

有意见认为由最终产品制造商进行授权谈判是最有效率的，授权谈判可以包括产品所有零件，因而最小化必要谈判的数量，也同时减少谈判成本、也可以避免供货商间授权条件差异等议题。<sup>151</sup>

On the other hand, others suggest that there may also be cases in which including suppliers in the negotiations is more efficient, such as when a small number of suppliers are supplying components to a large number of end-product manufacturers, and the rights holders can minimize the number of negotiations by conducting licensing negotiations with such suppliers.<sup>152</sup>

另一方面，其他一些人认为，在谈判中供货商做为谈判的当事者会更有效，例如少数供货商向大量最终产品制造商供应零件时，专利权人可以通过与这些供货商进行授权谈判来尽量减少谈判次数。<sup>153</sup>

*(Arguments from the Standpoint of Exhaustion and Double Earnings) / (权利耗尽及许可费重复收取的观点之说明)*

It is generally considered that when a product that is protected by a patent is placed legitimately on the market by a rights holder or a licensed implementer, the patent is exhausted, so the rights holder may not exercise its rights against someone who has purchased the product.<sup>154</sup> In this connection, if a rights holder concludes

---

just one component), it may be unnecessarily complicating to include component suppliers in negotiations because that will result in splitting up or sub-categorizing the portfolio.

151 有一种观点是，如果 SEP 不限于一个零件（即一个 SEP 组合不仅仅包含一个零件），那么在谈判中包含零件供货商可能会将谈判不必要地复杂化，因为这会导致将 SEP 组合分割或分成子归类。

152 When standard technologies are incorporated in components provided by supplier, some argue that conducting licensing negotiations with the supplier can reduce the transaction costs from the perspective of the number of players. That is because the entire portfolio can be comprehensively licensed to the supplier.

153 当供应商提供的组件中包含标准技术时，有人认为从参与者数量的角度来看，与供应商进行许可谈判可以降低交易成本。这是因为整个产品组合都可以全面授权给供应商。

154 In the United States, when a component manufacturer has a patent license and an end product incorporating the licensed component is sold, it may not be possible to obtain a royalty from the end-product manufacturer because the patent is exhausted by the first sale of the component (Quanta v. LG (U.S., Supreme Court, 2008)). That is, a sold component may exhaust patents to a larger product when the component “substantially embod[ies] the essential features of the patent when the only reasonable and intended use [of the component] is to practice the patent [in the larger product].” On the other hand, in Apple v. Samsung (Japan, IP

licensing agreements with multiple suppliers within a single supply chain, some are concerned that it may become unclear which right has been exhausted, and could more readily lead to the issue of double earnings by the rights holder or underpayment to the rights holder. Others argue that such issues may be avoided by conducting licensing negotiations with the end-product manufacturer.<sup>155</sup>

一般都认为受专利保护之产品，由专利权人或其授权实施者合法销售进入市场后，专利权即已用尽，专利权人对于购入该物之人无法行使权利。<sup>156</sup>因此，专利权人于一个供应链中，与复数供货商缔结授权契约时，哪一个权利耗尽变得不清楚，也可能容易产生专利权人重复收取许可费或对专利权人支付过少的问题，也有意见认为由最终产品制造商来进行授权谈判，便可以避免这些问题。<sup>157</sup>

Another view, however, is that end-product manufacturers face difficulties in ascertaining the status of licensing agreements concluded upstream and in identifying a double-earnings issue, and therefore that the involvement in negotiations of those parties manufacturing components included in the technical scope of patent rights is valuable in terms of avoiding the double-earnings issue.

---

High Court, 2014), the court stated that when rights holders sell components (indirectly-infringed goods) used only for manufacturing the end product (a patented product), the patent is exhausted while when a third party is manufacturing the end-product using that component, the patent is not exhausted for the act of the manufacture and the use and assignment of the patented product, and the patent rights are enforceable, other than a case in which an implied license is allowed.

155 In *Sharp v. Daimler* (Germany, District Court of Munich, 2020), the component manufacture did not use all the patents, and all patents of the portfolio were not exhausted at the level of the component manufacture. Therefore, from the perspective of using the license fees more effectively, granting a license to the end-product manufacture is said to be supported.

156 在美国，当零件制造商拥有专利授权并且包含该授权零件的最终产品被出售时，可能无法从最终产品制造商处获得许可费，因为该专利已被该零件第一次销售时耗尽(*Quanta v. LG*, USA Supreme Court 2008)，也就是说，当“实质上实现专利的基本特征的零件只有合理及预期的使用到较大产品中实施该专利时”，已售出的该零件可能会将专利耗尽到更大的产品。另一方面，在 *Apple 诉三星案*（日本，IP 高等法院，2014 年）中，法院指出，当专利权人出售仅用于制造最终产品（专利产品）的组件（间接侵权商品）时，当第三方使用该部件制造最终产品时，专利权不因制造以及专利产品的使用和转让而用尽，专利权可以强制执行，但在默示许可是允许的。

157 在 *Sharp v. Daimler*（德国，慕尼黑地方法院，2020 年）一案中，组件制造商并未使用所有专利，并且该组合的所有专利并未在组件制造层面用尽。因此，从更有效地使用许可费的角度来看，据说支持向最终产品制造商授予许可。

另一方面，也有意见认为因为最终产品制造商在确定上游签订的授权协议状态和确定许可费重复收取问题方面会有困难，因此，在供应链中，将制造包含在专利技术范围内的零件的各方作为授权谈判的主体，在避免许可费重复收取问题方面是有价值的。

*(Arguments from the Standpoint of Technical Knowledge) / (从技术内容观点之整理)*

Some argue that where an end-product manufacturer without detailed knowledge of the technologies involved is the main party to the negotiation, they will need to coordinate with all their suppliers throughout the negotiation process, which may lengthen the process and also push up the cost. Accordingly, they argue that it may be more efficient for those suppliers of technologies that fall within the scope of the patent claims, who consequently have the necessary technical knowledge, to be party to licensing negotiations.

有些人认为，如果不具有所涉及技术的详细知识的最终产品制造商是谈判的主要参与方，那么在整个谈判过程中，他们将需要与其所有供货商进行协调，这可能会延长谈判过程并增加成本。因此，他们认为，对于那些落在专利请求项范围内的技术供货商，具有必要的技术知识，来参与授权谈判可能会更有效。

Conversely, there is also a suggestion from the perspective of rights holders wishing to negotiate with end-product manufacturers that it is possible to acquire information on the technical content from the suppliers without involving them in the negotiations.

相反，从专利权人的角度来看，还有一个建议是希望与最终产品制造商进行谈判，因为就算不让供货商参与谈判，也有可能从供货商那里获得有关技术内容的信息。

*(Sharing the Burden of Licensing Fees) / (许可费负担之分配)*

When the rights holder requests payment of licensing fees after the product is sold, how this payment burden should be distributed within the supply chain sometimes becomes an issue.

在产品销售后，专利权人要求支付许可费时，于供应链内如何分摊授权费用便成为一个议题。

There are certain industries in which a patent indemnification agreement may be concluded whereby the supplier shoulders the payment of licensing fees. In such situations, even when the license fee negotiated by the end-product manufacturer as the party is excessive and disproportionate to the price of the component, the supplier may be requested to bear the burden.<sup>158</sup>

也有一些业者签定专利赔偿协议时，要求供货商支付许可费，在这种情况下，假如是由最终产品制造商作为主体所谈判的许可费，有可能与零件贩卖价格相比过大而要求供货商支付的情形发生。<sup>159</sup>

To avoid such a situation, some patent indemnification agreements exempt SEPs.

---

158 There has been a ruling that where suppliers party to patent indemnification agreements do not meet their obligation to provide end-product manufacturers with the necessary documents, etc., they should shoulder part of the licensing fee paid by the end-product manufacturer to the rights holder. In *Softbank v. Kanematsu* (Japan, IP High Court, 2015), the terms of the sales contract between the supplier and the end-product manufacture stipulated a provision that “when a dispute arises between the supplier and a third party due to IP rights infringement on goods, the supplier will settle the dispute at its expense and by its own responsibility, or will cooperate with the end-product manufacturer not to cause any inconvenience to the manufacture. The court found that there was a reasonable causal relationship between the supplier's violation of this provision and the amount of damages equivalent to the license fee paid by the end-product manufacturer to the patentee. However, at the time when the end-product manufacturer paid the license fee, while there was no immediate risk of a lawsuit including an injunction demand, the end-product manufacturer neither confirmed the existence of infringement, nor asked the basis of calculation of the license fee and did not consider restraining the supplier. As a result, the end-product manufacturer was found to be at fault with regard to the occurrence of damages. As a result of offsetting the fault, the supplier's burden was limited to a part of the payment amount which the end-product manufacturer paid to the patentee.

159 有法院判决认为，如果供货商对专利赔偿契约的缔约方不履行向最终产品制造商提供必要文件等的义务，则他们应该承担最终产品制造商支付的部分授权费用（*Softbank v. Kanematsu*（日本智慧财产高等法院，2015））。供应商与最终产品制造商之间的销售合同条款规定：“供应商与第三方因侵犯商品知识产权而发生争议时，供应商将自费解决争议，并由自行负责，或将配合最终产品制造商不给制造造成任何不便。法院认为，供应商违反该规定与最终产品制造商向专利权人支付的相当于许可费的损害赔偿金额之间存在合理的因果关系。然而，在最终产品制造商支付许可费时，虽然不存在包括禁令要求在内的直接诉讼风险，但最终产品制造商既没有确认侵权的存在，也没有询问计算的依据。许可费，并没有考虑限制供应商。因此，最终产品制造商被认定在损害的发生方面有过错。由于抵消了过错，供应商的负担仅限于最终产品制造商支付给专利权人的部分付款金额。

Some argue that, in order to avoid an excessive burden on suppliers, licensing fees should be apportioned out across the supply chain according to the essential parts of the invention within the scope of the patent claim.

为避免这种情况，实务上常见将 SEPs 排除在专利赔偿契约的对象之外。有人认为，为了避免给供货商造成过大的负担，应根据专利请求项范围内的发明的主要部分，在整个供应链中分配授权费用。

Others suggest that it may be reasonable to incorporate in a patent indemnification agreement a provision to exempt the supplier from responsibility to pay the licensing fee if the supplier was not given the chance to be involved in the licensing negotiations. Some have also suggested that it might be reasonable to include a provision that exempts suppliers from the responsibility to pay more than an amount corresponding to the price of the component. Another opinion is that if suppliers are required to shoulder licensing fees, the price for their components should reflect the technical value of the SEP.

也有一些意见指出，在专利赔偿契约中，加入如果供货商没有获得参与授权谈判的机会时，免除供货商支付许可费责任的条文也是合理的。有些人还建议，可以合理地列入一项规定，免除供货商承担超零件价格相应金额的责任。另一种观点是，如果供货商被要求承担授权费，那么他们的零件价格应该反映 SEP 的技术价值。

### **3.Protecting Confidential Information / 保护机密信息（翻译人员：黎梁安琪）**

*(Overview) / (概述)*

A confidentiality agreement (non-disclosure agreement) ensures that information that is sensitive from a business or technical perspective and that is disclosed during negotiations is not disclosed in turn to a third party. By concluding a confidentiality agreement, the parties may find it easier to disclose sensitive information, thus leading to a more efficient licensing negotiation.

所谓保密协议即是(非公开协议)确保在谈判期间所披露的商业或技术层面的敏感信息不会被泄露给第三方。通过缔结保密协议,各方当事人会发现在谈判期间敏感信息更容易被披露,从而使得许可谈判更为有效。

On the other hand, a party should take care in the wording of a confidentiality agreement to avoid the risk of being prevented from presenting information later in court as proof of good faith negotiations.

另一方面,当事人在签订保密协议时,应注意保密协议的措辞,以避免未来在法庭上作为善意谈判提供证据时被阻止的风险。

*(Confidential Information of the Implementers)* / (实施者的机密信息)

Potentially confidential implementer information might include business- related information (e.g. market forecasts and sales information, etc.), and technical information about the implementer's products that is not publicly available.

实施者潜在的机密信息可能包括与业务相关的信息(如市场预测和销售信息等),以及关于实施者产品的未公开的技术信息。

If the rights holder exercises SEPs over products or methods of manufacture not open to the public, an implementer may want to consider whether to disclose proprietary technical information (such as blueprints of semiconductors or software source code) in order to counter effectively the specific grounds for infringement presented by the rights holder.

如果标准必要专利持有人就未向公众开放的产品或制造方法行使标准必要专利权,实施者可能希望考虑是否披露机密技术信息(如半导体设计图或软件源代码),以便有效反驳专利持有人提出的具体侵权理由。

By contrast, if the allegedly infringing product which is the subject of the negotiations is one which the rights holder can obtain to assess whether there is an infringement of its patents, such as a general-purpose mechanical invention, it may be apparent from inspection of the product whether it practices the patent(s), and the disclosure of confidential technical information by the implementer may not be



required.

相比之下，如果作为谈判对象的涉嫌侵权产品是类似通用机械发明，专利持有人可以通过检查产品是否实施专利，进而评估其专利是否侵权的产品，那么实施者可能不需要披露机密技术信息。

When the subjects of discussion are centered on the correspondence between patent claims and the standard documents, there may be cases where the implementer does not need to disclose confidential technical information regarding the product.

当讨论的主题集中在专利权利要求和标准文件之间的对应关系上时，实施者就不再需要披露产品机密技术信息。

*(Confidential Information of Rights Holders) / 专利权人的机密信息*

Potentially confidential rights holder information might include an explanation of claim terminology and the corresponding sections in the standard documents (refer to II.A.1.), and the terms of comparable licenses, such as the rate or the amount used to explain and support a FRAND offer.

潜在标准必要专利持有人的机密信息可能包括对权利要求术语的解释和标准文件中的相应部分（请参阅 II.A.1.）、用于解释和支持费率或金额的类似 FRAND 许可条款。

*(Provisions for a Confidentiality Agreement) / 保密协议的规定*

When concluding a confidentiality agreement, the following are examples of provisions that may be discussed depending on the circumstances of each negotiation:

在签订保密协议时，以下是可以根据每次谈判的情况讨论的条款示例：

- (1) Which information needs to be kept confidential
- (2) Who will receive confidential information
- (3) How will confidential information be marked
- (4) Whether orally communicated information will be covered
- (5) The duration of the agreement

- (6) Whether information can later be used in litigation as a defense
- (7) The duration of the confidentiality obligation
- (8) Information exempted from confidentiality (information within the public domain and legitimately acquired information, etc.)

- (1) 哪些信息需要保密
- (2) 谁将收到机密信息
- (3) 机密信息的表示方法
- (4) 是否涵盖口头传达的信息
- (5) 协议期限
- (6) 信息以后能否在诉讼中用作抗辩
- (7) 保密义务的期限
- (8) 非保密的信息（公共领域内的信息和合法获取的信息等）

“Good Faith Negotiation Guidelines for Standard Essential Patent Licenses” of METI provides, as the norms to be followed by rights holders and implementers, that the rights holder should not preclude the implementer from disclosing the information provided by the rights holder to the suppliers, attorneys, patent attorneys, etc., if the implementer needs their knowledge to proceed with its own licensing negotiations.<sup>160</sup>

METI 的《标准必要专利许可善意谈判指南》规定，作为专利权人和实施者应遵循的规范，专利权人不应阻止实施者将专利权人提供的信息披露给供应商、律师、专利代理人等，如果实施者需要他们的知识来进行自己的许可谈判。<sup>161</sup>

*(Maintaining Confidentiality of the Process, Content, and Result of the Licensing Negotiations)* / (对许可谈判的过程、内容和结果保密)

The parties may also consider setting forth confidentiality provisions applicable to the process, content, and result of the licensing negotiations. On the one hand, facts such as what kind of information has been disclosed at what point in a series of

---

<sup>160</sup> Good Faith Negotiation Guidelines for Standard Essential Patent Licenses (METI, Japan, 2022)

<sup>161</sup> 标准必要专利许可善意谈判指南（日本经济产业，2022 年）

negotiations is often important in reading other parties' thinking on and approach to business and to patents, and parties often want complete confidentiality, to the extent that even the existence of a resulting license agreement is confidential, so as to ensure against, for example the deliberate choice of only certain parts of the negotiation proceedings for disclosure.

双方当事人还可以考虑制定适用于许可谈判过程、内容和结果的保密条款。一方面，一些事实，诸如在一系列谈判中的哪个阶段披露了何种信息，对于解读其他各方对商业和专利的想法和看法往往很重要，而且双方往往希望完全保密，对于最终的许可协议的存在也是保密的，以确保不会出现故意选择谈判程序的某些部分进行披露的情形。

On the other hand, often the existence and the content of the licensing agreement are not treated as confidential so that the agreement may be assessed as a “comparable license” in the future. The parties may want to consider, in view of the above, for example, whether all terms and the existence of an agreement will be confidential, whether only its monetary terms will be confidential, or whether only sales volume information (e.g., past sales) will be confidential, etc.

另一方面，许可协议的存在和授权内容通常不被视为机密，因此该协议可能在未来被评估为“可比协议”。鉴于上述情况，各方当事人可能需要考虑，例如，是否所有条款和协议的存在都是保密的，是否只有金额条款是保密的，或者是否只有销量信息（例如，过去的销售额）保密等。

#### **4.Choice of Patents Subject to Negotiation / 作为谈判对象专利的选择**

Whether licensing negotiations are conducted on a portfolio basis or by patent is determined by the parties on a case by case basis. SEP licensing negotiations are often conducted as portfolio negotiations from the standpoint of a comprehensive settlement.

许可谈判是以专利组合为基础还是以各个专利单独为基础进行，由双方根据具体情况确定。从全面解决的角度来看，标准必要专利许可谈判通常以专利组合开展。

When rights holders possess a large number of SEPs, however, the parties may discuss limiting the subject of the negotiation to “representative” patents so as to streamline the negotiation process. When doing so, there is a view that it may be desirable for the parties to explain the reason for selecting the patents as representative.

但是，当专利权人拥有大量标准必要专利时，双方可以讨论将谈判的主题限制在“代表性”专利上，以简化谈判过程。在这样做时，有一种观点认为，双方可能需要解释选择这些专利作为代表性的原因。

As an example, in a case involving several hundred SEPs, the parties may hold discussions on just part of those patents deemed the most valuable, or select random samples to efficiently assess the total value. They might also independently categorize the patents into tiers, analyze the top few from each tier to get an idea of the topology of the overall portfolio’s quality, and get together to compare results. In such cases, one view is that concluding all licensing agreements, including those SEPs that were not the subject of discussion, as a single package is an efficient approach in terms of administration.

例如，在涉及数百个标准必要专利的案件中，当事人可以只讨论那些被认为最有价值的那部分专利，或者选择随机取样以便有效地评估总价值。双方当事人还可以将标准必要专利组合内的专利以价值高低为标准进行分类，分析每一组立最有价值的前几项专利，以判断整组专利的价值，最终汇总比较结果。在这种情况下，一种观点认为，缔结所有许可协议（包括那些尚未讨论的标准必要专利），作为一个单一的包是一种有效的管理方法。

The parties may also discuss whether the negotiations will include non-SEPs in addition to SEPs.<sup>162</sup> While it is up to the parties to choose which particular patents

---

162 It should be kept in mind that licensing negotiations where rights holders seek to cover non-SEPs in addition to SEPs do not conflict with the “tying” of competition law, provided that rights holders do not use their market power to coerce payment for non-SEPs. There is a view that portfolio licensing can be efficient under competition law principles and that such licensing efficiencies have the potential to outweigh competition concerns associated with tying. (U.S. Dep’t of Justice and Federal Trade Commission, Antitrust Guidelines (2017))

will be included, it may, for example, be efficient to include in the negotiation a commercially essential patent (a patent for which there exists a technical alternative but which is practically inescapable due to cost/performance issues)<sup>163</sup> or non-SEPs. There are also cases of licensing through frameworks whereby implementers can choose which SEPs they wish to license.<sup>164</sup>

双方还可以讨论谈判是否将包括标准必要专利之外的非标准必要专利。<sup>165</sup> 因为是由双方选择将包括哪些特定专利，所以在谈判中包括商业上的必要专利（存在技术替代方案但由于成本/性能问题实际上不可避免的专利）<sup>166</sup>或非标准必要专利也可能是有效的。此外，也有通过特殊框架进行许可的情况，实施者可以选择他们希望许可的标准必要专利。<sup>167</sup>

## 5. Geographic Scope of Licensing Agreement<sup>168</sup> / 许可协议的地域范围<sup>169</sup>

With regard to the geographic scope of a license, parties generally consider whether a license will be limited to particular regions or globally applicable. When

---

163 Certain SSOs explicitly rule out the concept of commercial essentiality in their IPR policies, defining essentiality solely on a technical basis (patents covering a technology must a technical or engineering matter).

164 For example, in some patent pools, SEPs are divided into basic functions and options, and the implementer can choose the scope of the SEP which they wish to license.

165 应当记住，专利权人寻求在标准必要专利之外涵盖非标准必要专利的许可谈判不与竞争法的“捆绑”相冲突，前提是专利权人不利用其市场力量强制支付非标准必要专利。标准必要专利。有一种观点认为，根据竞争法原则，组合许可可以是有效的，并且这种许可效率有可能超过与搭售相关的竞争问题。（美国司法部和联邦贸易委员会，反垄断指南（2017年））

166 某些 SSO 在其知识产权政策中明确排除了商业必要性的概念，仅在技术基础上定义必要性（涵盖技术的专利必须是技术或工程事项）。

167 例如，在一些专利池中，标准必要专利被划分为基本功能和选项，实施者可以选择他们希望许可的标准必要专利的范围。

168 There are various discussions about courts setting licensing terms globally. In *Unwired Planet v. Huawei* (U.K., Supreme Court, 2020), since the ETSI's IPR Policy assumes global licensing terms, the U.K. court stated that it has jurisdiction to set FRAND licensing terms globally. Meanwhile, in *TCL v. Ericsson* (U.S., federal district court, 2017), the court set the licensing terms globally, because of the fact that the TCL, the implementer, had already agreed to allow the court to set global licensing terms.

169 关于法院在全球范围内设置许可条款的讨论多种多样。在 *Unwired Planet* 诉华为案（英国，最高法院，2020年）中，由于 ETSI 的知识产权政策采用全球许可条款，因此英国法院声明其有权在全球范围内设定 FRAND 许可条款。同时，在 *TCL* 诉爱立信案（美国，联邦地区法院，2017年）中，法院在全球范围内设定了许可条款，因为实施者 TCL 已经同意允许法院设定全球许可条款。

setting the geographic scope, the parties may want to consider on a case by case basis whether the implementer is producing or selling products in multiple regions throughout the world, as well as how many patents the rights holder holds and the strength thereof, in those jurisdictions.

关于许可的地域范围，各方通常会考虑许可是仅限于特定地区还是全球适用。当事人在设定地域范围时，可能要根据具体情况考虑实施者是否在全球多个地区生产或销售产品，以及专利权人在这些地区拥有专利的数量及质量。

Some argue that, given the international distribution of ICT and other standard technologies, it would be more efficient to address SEPs in all countries and regions in which an implementer may produce and/or sell its products in future in addition to those countries and regions where it currently does so.<sup>170</sup> There is also a view that global licensing agreements allow easier and more efficient license management, as, for example, they do not require agreements to be amended if the implementer expands its business geographically. Others argue that an implementer may well conclude a licensing agreement covering only those countries or regions where it is operating or has a concrete plan to operate.

有观点指出，鉴于 ICT 和其他标准技术的国际分布，实施者仅会以现在和未来可能生产或销售其产品的国家和地区所需的标准必要专利作为谈判对象。<sup>171</sup> 还有一种观点认为，全球许可协议允许更轻松和更有效的许可管理，例如，如果实施者在其他国家或地区扩展其业务，它们不需要修改协议。另一方面，也有观点指出实施者很可能会签订仅涵盖其运营或有具体运营计划的国家或地区的许可协议。

Also, there are some cases of global licenses granted on different licensing terms

---

<sup>170</sup> In *Unwired Planet v. Huawei* (U.K., high court, 2017), the court found it reasonable to address SEPs in all countries and regions in which the implementers currently produce and/or sell and/or may do so in future. This was supported also by the decision of the Supreme Court in 2020.

<sup>171</sup> 在 *Unwired Planet* 诉华为（英国，高等法院，2017 年）一案中，法院认为在实施者目前生产和/或销售和/或将来可能这样做的所有国家和地区处理标准必要专利是合理的。最高法院在 2020 年的决定也支持这一点。

for different regions.<sup>172</sup>

此外，还有一些全球许可在不同地区以不同许可条款授予的情况。<sup>173</sup>

If the implementer is producing and/or selling its product in multiple regions, there is a view that where the implementer requests a licensing agreement for patent rights only in such specific countries/regions with consideration to the specific circumstances of the patents in each, care should be taken to prevent this from turning into a delaying tactic in the negotiations.

如果实施者在多个地区生产或销售其产品，实施者就这些特定国家和地区的专利签订许可协议时，要求考虑到这些国家和地区每个专利的具体情况，应注意应采取措施防止变成谈判中的拖延战术。

*(Reference: International Jurisdiction) / 参考：国际管辖*

Regarding the geographical scope of licensing agreements, we will introduce a jurisdiction of international litigations of SEPs.

关于许可协议的地域范围，我们将介绍标准必要专利国际诉讼的管辖权。

Patent rights are independent in each country, and in applying the Patent Law to patent rights, the principle of territoriality may be appropriate. For jurisdiction of international litigations, whether or not the jurisdiction is appropriate shall be determined, apart from the territoriality principle. In this regard, for example, in the EU, the courts in each country must determine the validity and infringement of patent

---

<sup>172</sup> In *Unwired Planet v. Huawei* (UK, high court, 2017), the court found that licenses granted on FRAND terms are global, while taking regional differences into consideration, it showed different royalty rates among different markets. In *TCL v. Ericsson* (U.S., federal district court, 2017), the court divided regions into the United States, Europe, and the rest of the world and set the royalty rates globally. It should be noted that certain entities disagree with the authority of a court to set license terms outside of its jurisdiction when one of the parties questions whether it is within the court's authority to set such terms.

<sup>173</sup> 在 *Unwired Planet v. Huawei*（英国，高等法院，2017 年）一案中，法院认定以 FRAND 条款授予的许可是全球性的，在考虑到地区差异的同时，它显示出不同市场之间的不同特许权许可费率。在 *TCL 诉爱立信*（美国，联邦地方法院，2017 年）一案中，法院将地区划分为美国、欧洲和世界其他地区，并在全球范围内设定特许权许可费率。应该注意的是，当其中一方质疑法院是否有权设定此类条款时，某些实体不同意法院有权在其管辖范围之外设定许可条款。

rights in an EU country.<sup>174</sup> Meanwhile, in some court rulings, the court in a country can decide licensing fees for SEP portfolios, even though the portfolios contain foreign patents.<sup>175</sup> 91

专利权在每个国家都是独立的，因此在对专利权适用专利法时，地域性原则可能是合适的。对于国际诉讼的管辖权，除属地原则外，应确定管辖权是否适当。在这方面，例如在欧盟，每个国家的法院都必须确定欧盟国家专利权的有效性和侵权情况。<sup>176</sup><sup>177</sup>同时，在某些法院裁决中，一个国家的法院可以决定标准必要专利组合的许可费用，即使这个组合还包含外国专利。<sup>178</sup><sup>179</sup>

Meanwhile, when the results of litigations and the enforcement of court ruling in foreign countries are recognized to have certain impacts on litigations in other countries, orders to prohibit launching and continuing litigations and enforcing judgments in foreign countries (Anti-Suit Injunction) are issued in some cases.<sup>180</sup> 181

同时，当认定外国诉讼结果和法院裁决的执行对其他国家的诉讼有一定影响时，在某些情况下会下达禁止在外国提起和继续诉讼和执行判决的命令。<sup>182</sup><sup>183</sup>

---

174 For example, in the EU, based on Article 24 (4) of the EU Rule 1215/2012, the courts in the registered countries are said to have jurisdiction on the validity of patents. Since this is also applied to defenses of patent invalidation in infringement litigations (GAT v. Luk (EU, CJEU, 2006)), infringement litigations are to be conducted in countries where the patent rights were registered.

175 Unwired Planet v. Huawei (U.K. Supreme Court, 2020).

176 例如，在欧盟，根据欧盟规则 1215/2012 的第 24 条第 (4) 款，据说注册国家的法院对专利的有效性具有管辖权。由于这也适用于侵权诉讼中的专利无效抗辩（GAT v. Luk (EU, CJEU, 2006)），因此侵权诉讼将在专利权注册的国家进行。

177 OPPO v. Sharp (China, Shenzhen Intermediate Court, 2020). This ruling was supported by the Supreme People's Court in 2021.

178 Unwired Planet 诉华为案（英国最高法院，2020 年）。

179 OPPO 诉夏普案（中国，深圳中院，2020 年）。该裁决于 2021 年得到最高人民法院的支持。

180 In 2020, for example, ASI was granted in following cases; Huawei v. Conversant (China, Supreme People's Court, 2020), Xiaomi v. InterDigital (China, Wuhan Intermediate Court, 2020), ZTE v. Conversant (China, Shenzhen Intermediate Court, 2020), OPPO v. Sharp (China, Shenzhen Intermediate Court, 2020), Samsung v. Ericsson (China, Wuhan Intermediate Court, 2020)

181 Regarding ASI, there are various activities such as the request of consultations from the EU to China in the dispute settlement process of the WTO and attention should be paid to the future trends.

182 例如，在 2020 年，ASI 在以下情况下被授予：华为诉 Conversant（中国，最高人民法院，2020），小米诉 InterDigital（中国，武汉中院，2020），中兴诉 Conversant（中国，深圳中级法院，2020），OPPO



However, in some cases, an order to further prohibit ASI in the foreign country (Anti-ASI) is issued,<sup>184</sup> and by claiming ASI, the court determined to be in bad faith.<sup>185</sup>

但是，在某些情况下，会发布进一步禁止外国 ASI 的命令（Anti-ASI），<sup>186</sup>并且通过主张 ASI，法院判定其存在恶意。<sup>187</sup>

Regarding the international jurisdiction, some argue that ASI could restrict the exercise by rights holders of their exclusive rights and create barriers to legitimate trade and early settlement is desirable.

关于国际管辖权，一些人认为，ASI 可能会限制专利权人行使其专有权，并为合法贸易设置障碍，尽早解决是可取的。

## 6. Patent Pool Licensing<sup>188</sup> / 专利池授权<sup>189</sup>

In patent pools, wide participation by rights holders and implementers may produce licensing terms that balance the interests of both, which may boost the efficiency of licensing negotiations compared to individual bilateral negotiations amongst multiple parties.

在专利池中，专利权人和实施者的广泛参与可能会产生平衡双方利益的许可条款，与多方之间的单独双边谈判相比，这可能会提高许可谈判的效率。

Where a rights holder participates in a patent pool, the general practice is for that rights holder to approach licensing negotiations with implementers through the body

---

诉夏普（中国，深圳 中级法院，2020 年），三星诉爱立信（中国，武汉中级法院，2020 年）

183 关于 ASI，在 WTO 的争端解决过程中，有欧盟向中国提出磋商请求等各种活动，应关注未来趋势。

184 For example, InterDigital v. Xiaomi (India, Delhi High Court, 2020), and IP Bridge v Huawei (Germany, District Court of Munich, 2021).

185 InterDigital v. Xiaomi (Germany, District Court of Munich, 2021).

186 例如，InterDigital 诉小米（印度，德里高等法院，2020 年）和 IP Bridge 诉华为（德国，慕尼黑地方法院，2021 年）

187 InterDigital 诉小米（德国，慕尼黑地方法院，2021 年）。

188 Refer to III.A.3.a.(c) on the licensing terms for pooled patents.

189 关于合并专利的许可条款，请参阅 III.A.3.a.(c)。

managing the patent pool.

在专利权人参与专利池的情况下，一般做法是专利权人通过管理专利池的机构与实施者进行许可谈判。

Additionally, patent rights that are registered in a pool are normally checked to some extent for essentiality by a third party. Although this does not necessarily guarantee essentiality, it is expected that it may lead to greater SEP transparency.

此外，在专利池中注册的专利权通常会在一定程度上由第三方对其“必要性”进行审查。虽然这并不必然能保证该专利的“必要性”，但预计它可能会导致标准必要专利具备更大的透明度。

On the other hand, there are some cases where standard-related licensing issues cannot be resolved in one patent pool, such as where there are rights holders granting licenses individually, where there are multiple patent pools, or where there are companies holding other patents such as commercially essential patents.

另一方面，在某些情况下，标准相关的许可问题无法在一个专利池中解决，例如专利权人单独授予许可、存在多个专利池或者有公司持有作为商业必要专利的其他专利。

Some point out that patent pools do not necessarily improve efficiency if rights holders who grant licenses individually participate in the patent pool, as this may cause double royalty earnings on the part of such rights holders. Because of this, some patent pools establish mechanisms to prevent double royalty earnings.<sup>190</sup>

有人指出，如果已经单独授予许可的专利权人再参与专利池，专利池不一定会提高许可效率，因为这可能会出现这些专利权人许可费收入翻倍的情况。正因为如此，一些专利池建立了防止双重许可费征收的机制。<sup>191</sup>

---

<sup>190</sup> For example, in the case that an implementer already has a licensing agreement with a rights holder, there are agreements whereby the royalty amount that is already allocated to the rights holder is subtracted from the royalty amount set for the pool.

<sup>191</sup> 例如，在实施者已经与权利持有人签订许可协议的情况下，有一些协议规定，已经分配给权利持有人的许可费金额会从为池设置的许可费金额中减去。

Implementers aiming to resolve disputes through cross licensing must bear in mind that this will not be possible with bodies managing patent pools that are not implementing the invention. There is also a view that patent pool participation does not rule out cross licensing, and that an implementer can simply pay the royalties of those pool members with which it does not have a cross licensing agreement.<sup>192</sup>

再者，对于旨在希望通过交叉许可解决争议的实施者而言，由于管理着专利池的机构并不需要实施任何专利，所以根本无法以交互授权来解决争议。还有一种观点认为，参与专利池并不排除交叉许可，实施者只需支付没有签署交互授权协议的专利池成员许可金即可。<sup>193</sup>

### 7.Greater Transparency of SEPs / 提升标准必要专利的透明性

Enhancing transparency in regard to the essentiality and validity of SEPs leads to more efficient licensing negotiations. The European Communication expects SSOs to promote the development of databases with information on SEPs.<sup>194</sup> It also expects rights holders to provide information on SEPs to SSOs, so the SSOs can then update their information.

提高与标准必要专利必要性与有效性相关的透明度会导致更高效率的许可谈判。欧洲通信希望 SSO 促进开发包含标准必要专利信息的数据库，<sup>195</sup>同时也希望专利权人及时向 SSO 提供相关标准必要专利信息，以便 SSO 可以更新其信息。

With SSOs building up databases and widely providing information on SEPs, it will become easier for rights holders to obtain the necessary documents when presenting offers for licensing negotiations or FRAND licensing terms. It will also

---

192 In some patent pools, an agreement is concluded between two companies after the allocated amounts are paid.

193 在某些专利池中，在支付分配的金额后，两家公司之间会签订协议。

194 The European Communication urges SSOs to improve the quality of their SEP database in order to enhance transparency on SEPs and refers to launching a pilot project on the standard essentiality of SEPs.

195 欧洲通信敦促 SSO 提高其标准必要专利数据库的质量，以提高标准必要专利的透明度，并提到启动一个关于标准必要专利标准必要性的试点项目。

become easier for implementers to obtain information on SEPs related to relevant standards.

随着 SSO 建立标准必要专利数据库并持续提供标准必要专利的相关信息，专利权人在提出许可谈判或 FRAND 许可条款时更容易获得必要的文件。实施者也将更容易获得与相关标准必要专利的信息。

On the other hand, there is also a view that rights holders may need to be compensated for the cost of boosting transparency and the possibility of their own patents being deemed inessential or invalid that is inherent in enhancing SSO databases, so as not to reduce the motivation to participate in standardization.

同时，也有观点认为，就充实 SSO 的标准必要专利数据库而言，专利权人就提升标准必要专利透明性所需的成本，以及可能伴随而来专利权人的标准必要专利是否被判定为“非必要”或被判定为无效所带来的损失，需要获得一定的补偿，以免降低其未来参与标准化的积极性。

## **Royalty Calculation Methods / 1. 许可费计算方法（翻译人员：陈钜炜）**

### **III.**

As mentioned earlier, there are two aspects of FRAND: (i) the negotiation process itself and (ii) the terms of a license. This chapter will address the second aspect of FRAND.

如前所述，FRAND 包括两个方面：（i）谈判过程本身，以及（ii）许可条款。本章将阐述 FRAND 的第二个方面。

FRAND licensing terms include not only royalties but also non-monetary aspects such as cross-licensing, but because there are no established criteria for reasonable and non-discriminatory royalties in SEP licensing negotiations, the parties often disagree on the appropriate FRAND terms.

FRAND 许可条款不仅包括许可费，还包括交叉许可等非货币方面的内容。

但是，由于在标准必要专利许可谈判中，关于合理且非歧视性的许可费并无既定标准，因此当事人经常就适当的 FRAND 承诺适用产生分歧。

Therefore, this chapter will address royalty calculation methods in detail, based on standard practices and the framework indicated by past court rulings. It should be noted, however, that this Guide only identifies issues that may be considered in relation to calculation methods and does not direct any particular way for parties to arrive at a specific royalty rate or amount. Royalty rate calculation methods should be determined flexibly by the parties on a case by case basis, and the calculation methods outlined in this chapter may not necessarily be used.

因此，本章将根据标准惯例和以往法院裁决的框架，详细阐述许可费的计算方法。但是，应当注意的是，本指南仅列明了就计算方法而言应考虑的问题，并未指明当事人达成具体许可费率或金额的任何特定方式。许可费率的计算方法应由当事人根据具体情况灵活确定，不一定采用本章所述的计算方法。

## **A. Reasonable Royalties / A.合理的许可费**

### **1. Basic Approach / 1.基本方法**

Royalties reflect the value that the patent has contributed to the product and therefore is obtained by:

许可费反映了专利对产品作出的贡献的价值，因此，许可费反映了以下各方获得的专利：

(1) Royalty base (Calculation base) x (2) Royalty ratio (Rate)

(1) 许可费基数（计算基数） x (2) 许可费率（费率）

This approach may also be applied to the calculation of SEP royalties. There has been intense discussion, however, on issues such as how to handle the value added after a technology has been incorporated into a standard, how to identify the calculation base, and how to calculate the royalty rate. These issues are discussed

further below.<sup>196</sup>

这种方法也可以应用于标准必要专利许可费的计算。然而，对于如何处理一项技术被纳入标准后的增值、如何确定计算基数以及如何计算许可费率等问题，学界仍存在着激烈的讨论。这些问题也将在下文中进一步讨论。<sup>197</sup>

*(Value Added after Incorporation into a Standard) / (纳入标准后的增值)*

There is a view that SEP royalties should reflect only the value of the patented technology before the standard is widely adopted in the market (generally called “ex ante”). This is based on the idea that, when a technology is being considered to form part of a standard, it is selected from multiple technological options, while once it is incorporated into the standard, it is used only out of necessity to adhere to the standard.<sup>198</sup>

有观点认为，标准必要专利许可费应当仅反映在标准被市场广泛采用之前（通常称为“事前”）专利技术的价值。这是基于以下思想，在一项技术被考虑作为一项标准的一部分时，它是从多个备选技术中挑选出来的，而一旦被纳入标准，它仅在必须遵守该标准的情况下才会被使用。<sup>199</sup>

Based on this premise, there are cases where the royalty is assessed at a point in time before the standard is widely used and set promptly after the standard is announced, then kept at that level regardless of the success or failure in the markets of the products implementing the SEPs.

在这一前提下，存在这样的情况：许可费在标准被广泛采用之前的某一时点确定，在标准公布之后立即确定，并且无论实施标准必要专利的产品在市场上的成败，许可费都保持在这一水平。

---

<sup>196</sup> For example, U.S. courts often apply the fifteen Georgia-Pacific factors (referred to as “GPF”) for calculating the royalty. With FRAND-encumbered SEPs, modified GPFs have been adopted. (Microsoft v. Motorola (U.S., federal district court, 2013))

<sup>197</sup> 例如，美国法院通常适用 Georgia-Pacific 因素 (“GPF”) 计算许可费。对于负有 FRAND 义务的标准必要专利，已采用了修改后的 GPF。（微软诉摩托罗拉案（美国，联邦地区法院，2013 年））

<sup>198</sup> See Ericsson v. D-Link (U.S., CAFC, 2014).

<sup>199</sup> 参见 Ericsson v. D-Link (U.S., CAFC, 2014).

On the other hand, there is a view that the “ex ante” approach is not practical in calculating the damages for infringement of patent rights because the amount of damages should incorporate the value of the patented invention at the time of implementation, and a part of such value is created by the technology successfully becoming the standard. Furthermore, there is also a view that it is inappropriate to adopt the “ex ante” approach because it would lead to the profit from standardization being distributed only to implementers and not to rights holders.<sup>200</sup>

另一方面，有观点认为，在计算侵犯专利权的损害赔偿额时，采用“事前”的方法不具有可操作性，因为损害赔偿额应当包含专利发明在实施时的价值，而这一价值中有一部分是由成功成为标准的技术所创造的。此外，还有观点认为，采用“事前”的方法也是不恰当的，因为这会导致标准化的利润只分配给标准实施者，而不分配给权利持有人。<sup>201</sup>

## 2. Royalty Base (Calculation Base) / 2. 计费基数（计算基数）

*(Calculation Base for Amount of Damages in Patent Infringement Litigations<sup>202</sup>)*  
/（专利侵权诉讼中赔偿数额的计算基数<sup>203</sup>）

In the U.S., as for the calculation base of damages equivalent to a reasonable implementing fee in infringement litigations for patents, including SEPs, debate has

---

200 In *Unwired Planet v. Huawei* (UK, high court, 2017), the court stated that the rights holder could appropriate some of the value that is associated with the inclusion of the technology into the standard and the value of the products using the standards.

201 在“*Unwired Planet v. Huawei*”案（英国，高等法院，2017年）中，法院指出，权利持有人可以占有与将技术纳入标准相关的部分价值和使用标准的产品价值。

202 In many cases, the price of “components” is assumed to be “SSPPU” while the price of “end product” of the supply chain downstream is assumed to be “EMV.” Nonetheless, in reality, since components are not saleable, end products can be SSPPU in theory. Also, since patent claims are for end products, inventions are being worked only in end products from the wording. As a result, in some cases, end products can be considered as SSPPU.

203 在许多情况下，“部件”的价格被假定为“SSPPU”，而供应链下游的“最终产品”的价格被假定为“EMV”。然而，实际上，由于部件是不可销售的，因此，最终产品在理论上可以是SSPPU。而且，由于专利权利要求是针对最终产品的，从措辞上看，发明只在最终产品中工作。因此，在某些情况下，最终产品可以被认为是SSPPU。

centered on whether the smallest salable patent practicing unit (“SSPPU”) <sup>204</sup> <sup>205</sup> or the entire market value (“EMV”) <sup>206</sup> should be adopted. <sup>207</sup> <sup>208</sup> <sup>209</sup> Also in countries other than the U.S., debate has centered on whether the price of component or the price of end product should be adopted as calculation base for damages in patent infringement cases.<sup>210</sup>

在美国，对于在专利（包括标准必要专利）侵权诉讼中相当于合理实施费用的赔偿的计算基数，争论的焦点集中在是采用最小可销售专利实施单元（“SSPPU”）<sup>211</sup> <sup>212</sup>，还是采用整个市场价值（“EMV”）<sup>213</sup>。<sup>214</sup> <sup>215</sup><sup>216</sup>同样在除

---

204 In *Cornell Univ. v. Hewlett-Packard* (U.S., District Court, 2009) in which an infringement case was disputed over non-SEP patents, SSPPU was introduced, as the smallest unit of calculation base related to patent technologies should be selected so that excess damage amounts would not be calculated under the jury system. Nonetheless, in most court rulings in the U.S., when there are sufficient comparable licenses, the courts determined that royalties were evaluated by comparable licenses ahead of SSPPU. (*CSIRO v. Cisco* (U.S., CAFC, 2015)).

205 In *In re Innovatio* (U.S., federal district court, 2013), the rights holder’s portfolio included the patent claims for the entire devices including a Wi-Fi chip, and the court stated that considering the substance of the invention, a Wi-Fi chip is the calculation base for royalties as the SSPPU. In *Virnetx v. Cisco* (U.S., CAFC, 2014) the court stated that “[w]here the smallest salable unit (SSU) is, in fact, a multi-component product containing several non-infringing features with no relation to the patented feature..., the patentee must do more to estimate what portion of the value of that product is attributable to the patented technology.”

206 In *CSIRO v. Cisco* (U.S., CAFC, 2015), the court stated that if a party can prove that the patented invention drives demand for the accused end product, it can rely on the end-product’s entire market value (EMV) as the royalty base.

207 In *LaserDynamics v. Quanta* (U.S., CAFC, 2012), the court stated that it is generally required that royalties be based on the SSPPU approach, citing the concept of “the smallest salable infringing unit” in *Cornell University v. Hewlett-Packard* (U.S., federal district court, 2009), but stated that if it can be shown that the patented feature drives the demand for an entire multi- component product, the entire product (EMV) could be used as the royalty base, and rights holders may be awarded damages as a percentage of revenues or profits attributable to the entire product.

208 In *HTC v. Ericsson* (U.S., US District Court, 2019), the court stated that the ETSI’s IPR Policy neither requested nor excluded royalties to be calculated based on the SSPPU approach.

209 The U.S. Department of Justice (DOJ), in its statement released in September 2020, stated that although the IEEE’s IPR Policy was said to recommend the SSPPU approach as royalty base, royalties were set based on the price of end products in the actual licensing negotiations and that concerned parties should not be prevented from using licenses in such ways. Also, the DOJ stated that in the context of FRAND, there is no only correct method as royalty calculation method. Nonetheless, there is a possibility that this Statement might be revised in accordance with the Executive Order issued on July 9, 2021.

210 In court rulings, such as *Nokia v. Daimler* (Germany, District Court of Munich, 2020), *Sharp v. Daimler* (Germany, District Court of Munich, 2020), *Conversant v. Daimler* (Germany, District Court of Munich, 2020), the court determined that the price of end products should be royalty base.

211 在康奈尔大学诉惠普公司（*Cornell Univ. Hewlett-Packard*）（美国地区法院，2009年）中，一宗关



美国以外的其他国家，专利侵权中是以零部件价格还是以最终产品价格作为损害赔偿的计算基础，也一直存在争议。<sup>217</sup>

The view that the SSPPU should be royalty base, i.e., calculation base, is based on the concept that if a SEP technology is used only in the component that is the SSPPU, the price of that component to which the SEP is considered to contribute should be the calculation base. Meanwhile, the view that the EMV should be the calculation base is based on the concept that the SEP technology is considered to contribute to the function of the whole end product and to drive demand for the product, and the price of the whole end product will be the calculation base.

认为标准必要专利费率应当为计费基础（即计算基数）的观点是基于这样的

---

于非标准必要专利的侵权案中，SSPPU方法被引用，因为该案需要选择与专利技术相关的计算基数的最小单位，从而避免在陪审团制度下计算超额损害赔偿金额。尽管如此，在美国的大多数法院判决中，当存在足量的类似许可时，法院认为许可费是由类似许可计算的。

212 在 Innovation（美国联邦区法院，2013年）一案中，专利权人的专利组合包括了包括 Wi-Fi 芯片在内的整个设备的专利权利要求，法院声明，考虑到发明的实质，Wi-Fi 芯片与 SSPPU 是专利费的计算基础。在 Virnetx 诉思科（美国，CAFC,2014年）一案中，法院声明，“这里的最小销售单元（SSU）实际上是一个包含多个与专利技术无关的非侵权技术的多部件产品……专利权人必须做更多的工作来评估该产品的价值中有多少可归于专利技术。”

213 在 CSIRO 诉思科（美国，CAFC,2015年）案中，法院指出，如果一方能够证明专利发明推动对被控侵权最终产品的需求，该方可依赖最终产品的全部市场价值作为计费基础。

214 在 LaserDynamics 诉 Quanta（美国，CAFC,2012年）一案中，法院表示，通常情况下，特许权许可费应基于 SSPPU 方法确定，并援引了康奈尔大学诉惠普（美国，联邦区法院，2009年）一案中“最小可销售的侵权产品”的概念，但法院表示，如果能够证明专利特征驱动了对整个多组分产品的需求，则可以使用整个产品作为特许权许可费的基础，并且专利权人可以按照可归属于整个产品的收入或利润的百分比获得赔偿。

215 在 HTC 诉爱立信（美国地区法院，2019年）一案中，法院指出，ETSI 的知识产权政策既未要求也未排除根据标准必要专利组合办公室的方法计算许可费。

216 美国司法部在其 2020 年 9 月发布的声明中指出，尽管据称 IEEE 的《知识产权政策》建议将 SSPPU 方法作为许可费基础，但许可费在实际许可谈判中是根据最终产品的价格确定的，不应阻止有关各方以这种方式使用许可证。此外，司法部还指出，在 FRAND 的背景下，不存在唯一正确的许可费计算方法。尽管如此，本声明有可能根据 2021 年 7 月 9 日发布的行政命令进行修订。

217 在法院的裁决中，例如诺基亚诉戴姆勒案（德国慕尼黑地区法院，2020年）、夏普诉戴姆勒案（德国慕尼黑地区法院，2020年）和韦莱特诉戴姆勒案（德国慕尼黑地区法院，2020年），法院决定应以最终产品的价格为计费基础。

概念，即如果一项标准必要专利技术仅用于属于标准必要专利费率的零部件，则该标准必要专利被认为构成价格影响的零部件的价格应当为计算基数。同时，认为 EMV 应当作为计算基础的观点是基于这样的概念，即认为 SEP 技术对整个最终产品的功能作出贡献并推动对产品的需求，而整个最终产品的价格将作为计算基础。

*(Calculation Base in Licensing Negotiations) / (许可谈判的计算基数)*

As stated above, while the SSPPU and EMV are approaches devised by the US courts in calculating damages equivalent to a reasonable implementing fee in patent infringement cases, they could also be used as a reference to determine reasonable royalties in actual licensing negotiations. In some licensing negotiations, for example, the price of “components” is assumed to be “SSPPU” while the price of “end product” of the supply chain downstream is assumed to be “EMV.”

如前所述，SSPPU 和 EMV 是美国法院在专利侵权案件中设计的计算相当于合理实施费用的赔偿的方法，但在实际的许可谈判中，SSPPU 和 EMV 也可以作为确定合理许可费的参考。例如，在一些许可谈判中，“零部件”的价格被假定为 SSPPU，而“最终产品”的下游供应链的价格被假定为 EMV。

There are many cases in which the rights holder has insisted that the EMV should be used as royalty base, from the view point that the SEP technology contributes to the function of the entire end product and drives product demand. Likewise, there are many cases in which the end-product manufacturer has insisted that the SSPPU should be used as royalty base, from the view point that the contributions of the SEP technology are confined to just a portion or component of the overall end product.

在许多案件中，专利权人坚持认为，从标准必要专利技术对整个最终产品的功能作出贡献并推动产品需求的角度看，应当以整体市场价值（EMV）作为计费基础。同样地，在许多案件中，从标准必要专利技术的贡献仅限于整个最终产品的一部分或组成部分的角度看，终端产品制造商坚持认为，应当以标准必要专利生产单元作为计费基础。

In the days when debate focused on cellular phones, where communication technology was central to functionality, many parties supported the use of EMV as royalty base. The emergence of products such as smart phones and connected cars for which communications technology accounts only for a part of the product's functions, however, has raised debate over the use of SSPPU or EMV as royalty base.

当争论集中在移动电话上的时候，通信技术是手机功能的核心，许多人支持使用 EMV 作为使用费基础。但是，通信技术只占产品功能一部分的智能手机和联网汽车等产品的出现引发了关于使用 SSPPU 还是 EMV 作为许可费基础的争论。

*(Approach to the Calculation Base) / (确定计算基数的方法)*

A feature shared by both approaches (SSPPU and EMV as calculation base) is the attempt to use the approach as the calculation base according to where the contribution of the essential part of the SEP lies.<sup>218</sup>

两种方法（SSPPU 和 EMV 作为计算基准）的共同特征是，都试图根据标准必要专利的关键部分的贡献所在，使用该方法作为计算基准。<sup>219</sup>

In addition, the SSPPU and the EMV methodologies are not the only possibilities for considering a royalty base. The point is that a suitable calculation base for each individual case should be considered.

此外，SSPPU 和 EMV 方法并不是考虑使用费基数的唯一可能的方法。关键是应该为每个具体情况考虑一个合适的计算基数。

For example, some argue that when the essential part of the SEP technology supports the operation of functions of a device larger than a chip and contributes to the functions of the device beyond the chip itself, using the price of the chip as the SSPPU may not reflect the real value provided by the SEP technology.

---

<sup>218</sup> In *Ericsson v. D-Link* (U.S., CAFC, 2014), the court stated that the ultimate reasonable royalty award must be based on the incremental value that the patented invention adds to the end product.

<sup>219</sup> 在 *Ericsson 诉 D-Link* (U.S., CAFC, 2014 年) 一案中，法院指出，合理的最终许可费必须基于专利发明对最终产品所带来的增值。

例如，一些人认为，当 SEP 技术的基本部分支持比芯片大的设备的功能的操作并且对芯片本身以外的设备的功能有贡献时，使用芯片的价格作为 SSPPU 可能不能反映由 SEP 技术提供的实际价值。

On the other hand, other suggest that when the contribution of the essential part of the SEP technology is confined to the chip itself and the chip is independent and has an objective market value, the price of the chip may be deemed appropriate as the calculation base.

另一方面，也有意见提出，当标准必要专利技术的关键部分的贡献仅限于芯片本身，芯片具有独立性并具有客观市场价值时，可以将芯片价格作为计算基础较为适当。

Even when the SEP technology goes beyond a particular chip, there is a view that the SSPPU is an effective starting point for discussion in accumulatively and elaborately analyzing the product portions to which the SEP technology contributes. This view emphasizes that the basis of the calculation should not exceed the scope of the contribution of the essential part of the SEP technology for which a license is being sought.

即使在标准必要专利技术超出特定芯片范围的情况下，有观点认为，通过累积及详细分析标准必要专利技术所贡献的产品部分，标准必要专利组合仍是一个有效的讨论起点。这种观点强调，计算基础不应当超出为其寻求许可的标准必要专利技术的必要部分所贡献的范围。

Contrarily, there is an approach using the EMV as the starting point of discussion and determining the calculation base by multiplying the end product by the ratio of the contribution to the end product of all the SEPs that cover the technical standard.<sup>220</sup>

相反地，存在一种方法，使用 EMV 作为讨论的起点，并且通过将最终产品乘以覆盖该技术标准的所有标准必要专利的贡献对最终产品的比率来确定计算

<sup>220</sup> In *Apple v. Samsung* (Japan, IP high court, 2014), because the design, use interface, camera, audio function, etc. contribute to the product in addition to the wireless communication function, the court stated that the basis of the calculation should be multiplied by the rate that it is deemed was contributing to the product by complying with the standard (contribution rate).

基础。<sup>221</sup>

There is a view that if the EMV is used as calculation base, it may lead to a high calculation base with a fixed rate, resulting in a high royalty. Conversely, there is another view that if the SSPPU is used as calculation base, it may reduce the base with a fixed rate, resulting in a low royalty.

有一种观点认为，如果使用 EMV 作为计算基数，可能会导致固定费率的计算基数较高，从而导致较高的许可使用费。相反，另一种观点认为，如果使用 SSPPU 作为计算基数，可能会减少固定费率的计算基数，从而导致较低的许可使用费。

Some argue, however, that when the calculation base is small, the rate will be high, while a large calculation base causes the rate to be low, selecting the calculation base not directly relevant to the resulting royalty amount in theory.

然而，一些人争辩说，当计算基数小时，费率将高，而计算基数大导致费率低，选择计算基数在理论上与由此产生的许可费没有直接关系。

### 3.Royalty Rate / 3.许可费率（翻译人员：邱静思）

*(Approaches to Rate Determination) / (费率的计算方法)*

Of the many different approaches to determining an appropriate royalty rate, two frequently identified in court decisions are (i) determining the royalty rate, by independently evaluating the value of individual SEPs (bottom-up approach); and (ii) calculating the share in the calculation base of the contribution of all SEPs for a given standard and then allotting a share to individual SEPs (top-down approach).

在许多不同的确定适当使用费率的方法中，两种经常在法院判决中被确定：(i)通过独立评估单个 SEPs 的价值来确定使用费率(自下而上法)及(ii)算出所有

---

<sup>221</sup> 在苹果诉三星（日本，知识产权高等法院，2014年）一案中，由于设计、使用界面、摄像头、音频功能等。除无线通信功能外还对产品有贡献，法院称，计算基础应乘以被视为因遵守标准而对产品有贡献的比率（贡献率）。

SEP 对于特定标准的贡献度，再分配到个别 SEP(自上而下法)。

These two approaches are not contradictory. Both approaches may be combined to calculate the rate so as to ensure a more reliable rate through comparison of the results.<sup>222</sup>

以上两种方法并非相互矛盾的。亦可藉由上述二法算出费率并相互比较，从而计算出信赖度更高的费率。<sup>223</sup>

When there is an existing comparable license, some argue for referring to it,<sup>224</sup> whereas others argue for taking the top-down approach that first considers the contribution of all SEPs even in that situation.

有一说认为若市场上已有既存的可比较授权费率，则应以之为参照比较。<sup>225</sup>然亦有一说认为即使在此情况下，仍应先考虑 SEP 的全体贡献，并采用 Top down 法计算。

#### **a. Bottom-Up Approach / a. 自下而上法**

In the bottom-up approach, the value of individual SEPs might be evaluated by, for example, referring to comparable licenses. Specifically, examples of comparable licenses to be referred to include those of patents owned by the same rights holder and patents owned by others essential to the same standard or a similar standard.

在自下而上方法中，单个 SEP 的价值可以通过参考类似的许可来评估。具

---

222 In *Unwired Planet v. Huawei* case (UK, high court, 2017), while adopting a bottom-up approach, the court double-checked whether royalty stacking has occurred with a top-down approach. This was supported also by the ruling of the U.K. Supreme Court in 2020. On the other hand, in *TCL v. Ericsson* case (U.S., federal district court, 2017.), while adopting a top-down approach, the court double-checked with a bottom-up approach.

223 *Unwired Planet v. Huawei*(英国，高等法院，2017年)，法院除采 Bottom up 法，亦利用 Top down 法确认是否发生 Royalty Stacking(许可费堆叠)。另一方面，*TCL v. Ericsson*(美国，联邦地院，2017年)，法院采用 Top down 法，并利用 Bottom Up 法进行确认。

224 In *Laser Dynamics v. Quanta* (U.S., CAFC 2012), the court stated that actual licenses for the patented technology are highly probative as to what constitutes a reasonable royalty for those patent rights, because such actual licenses most clearly reflect the economic value of the patented technology in the marketplace.

225 *LaserDynamics v. Quanta*(美国，CAFC，2012年)，由于既有的专利授权乃是最能明确反映专利发明的市场价值指标，所有既有的专利授权对于何谓专利发明的合理许可费具有高证据力。

体而言,可参考的可比较许可的示例包括同一专利权人拥有的专利以及对同一标准或类似标准至关重要的其他人拥有的专利。

The following are examples of factors that have been considered in court cases and practice in determining whether a license is comparable:

就法院判例或实务观之,于判断是否为可比较协议时的考虑因素可列举如下:

- (1) Whether the license is for the same or similar patents,
- (2) Whether the license covers unrelated technology or different products<sup>226</sup>,
- (3) Whether the license has a similar fee structure (e.g., lump-sum or running royalty)
- (4) Whether the nature of the license is the same in terms of exclusivity<sup>227</sup>
- (5) Whether the license applies to similar territories (e.g., a regional or global license)
- (6) Whether the terms of the license are widely accepted
- (7) Whether the license has been achieved through a court settlement or through normal negotiations
- (8) How recent the license is, and
- (9) Whether the licensee has a sufficient negotiating strength to enable balanced negotiations.

- (1)授权是否与同一或类似专利有关
- (2)授权是否包含无关联性的技术或其他产品<sup>228</sup>
- (3)授权是否具有相似支付架构(例如一次性或浮动式支付许可费)

---

226 In *ResQNet v. Lansa* (U.S., CAFC, 2010), the court stated that the trial court should not rely on unrelated licenses to increase the reasonable royalty rate above rates more clearly linked to the economic demand for the claimed technology.

227 In *Lucent v. Gateway* (U.S., CAFC, 2009), the court stated that GPF3 (exclusive or nonexclusive) is applicable as a consideration factor.

228 *ResQNet v. Lansa*(美国, CAFC, 2010年), 法院认为不得利用无关且不适当的既有的专利授权作为计算许可费之基础。

- (4)授权的本质就排他性<sup>229</sup>是否相同
- (5)授权是否可适用于类似区域(例如为区域性授权或全球性授权)
- (6)授权条件是否广泛地被接受
- (7)授权的成立是经由诉讼后达成和解或经由一般谈判
- (8)最近的授权情况为何
- (9)被授权者是否具有足以维持对等谈判的谈判筹码

(a) Comparable Licenses Held by the Same Patent Holder / (a)由同一专利权人所拥有之可比较授权

In practice, it is often difficult to identify existing licenses that are identical or sufficiently similar to a potential license under discussion. On the one hand, when existing licensing agreements were concluded under circumstances that differ from the parties' present circumstances, the existing licenses may generally be referenced when the parties determine the royalty rate if they can account for the differences, but the effectiveness of such references may vary depending on the level of difference.<sup>230231</sup>

在实务上要认定现在所讨论之授权与过去的授权是否完全类似是相当困难的,当过去的授权与现在的情况并不相同时,如果当事者可以说明该不同之处时,则一般可将该过去的授权视为可比较授权,作为决定许可费率时之参考,然其有效性会随着其与过去授权的情形之不同程度而改变。<sup>232</sup>

When there are great differences between the circumstances of an existing license and present circumstances and it is difficult to reasonably account for such

---

229 *Lucent v. Gateway*(美国, CAFC, 2009 年), 法院认为 GPF3(排他或非排他)可适用为考虑因素。

230 In *Ericsson v. D-Link* (U.S., CAFC, 2014), the court stated that allegedly comparable licenses may cover more patents than are at issue in the action, include cross-licensing terms, cover foreign intellectual property rights, or, as here, be calculated as some percentage of the value of a multi-component product.

231 In *Virnetx v. Cisco* (U.S., CAFC, 2014), the court stated that the “degree of comparability” of the license agreements is applicable as a consideration factor.

232 *Ericsson v D-Link*(美国, CAFC, 2014 年), 法院认为在考量与多机能制品有关的专利价值时, 应将可比较授权是否包含较多专利、是否有交互授权、是否包含外国专利等因素也列入计算。][*Virnetx v. Cisco*(美国, CAFC, 2014 年), 法院指出授权的”可比较程度”也应为考虑因素。



differences, it may then be difficult to consider the existing license as being comparable and it will have less value in determining an appropriate royalty rate.<sup>233</sup>

而当过去的授权与现在的情况十分不同,且当事者难以合理说明该不同之处时,则难以认定该过去的授权为可比较授权,其于决定适当许可费率时的参考价值亦较低。<sup>234</sup>

(b)Comparable Licenses Held by Third Parties / (b)由第三人所拥有之可比较授权

In referring to the existing licensing terms of third parties who hold SEPs for the same standard, it may be possible to calculate an appropriate rate by comparing the number of SEPs owned by the rights holder to those held by the third party and multiplying the ratio obtained.

若为以与同一标准有关之第三人所拥有之 SEP 许可授权作参照的情况,则可比专利人所拥有的 SEP 数量与该第三人所拥有的 SEP 数量,再乘上该 SEP 数量比例而算出确切的许可费率。

In this case, the rate may be adjusted taking into account the value of the specific SEPs. It should also be noted that some third parties inflate the number of SEPs through divisional patent applications.

在此种情形下,亦可考虑特定 SEP 的价值而调整费率。并需注意第三人是否有藉由分专利申请来夸大 SEP 数量。

Some view the limited availability of comparable licenses held by third parties and the difficulty of evaluating other parties' portfolios as standing in the way of making comparisons of licensing terms.

另外,亦有由第三人所拥有之可比较授权并不易寻得,且评价他人的专利组

---

<sup>233</sup> In *Laser Dynamics v. Quanta* (U.S., CAFC 2012), the court stated that the propriety of using prior settlement agreements to prove the amount of a reasonable royalty is questionable. On the other hand, there are some arguments that licenses in litigation could also be referred to as comparable licenses.

<sup>234</sup> *LaserDynamics v.Quanta*(美国, CAFC, 2012 年), 法院认为在诉讼中的授权不宜作为可比较授权。但另一方面,亦有意见认为诉讼中的授权乃可作为可比较授权。

合也相当困难，故难以进行条件比较的意见。

### (c) Patent Pools / (c) 专利池

As a reference in determining a FRAND rate, parties may compare the rate charged by a patent pool for the same standard. It may be possible to calculate an appropriate rate by comparing the number of SEPs owned by the rights holder to those of the patent pool and multiplying the ratio obtained..

与相同标准规格有关的专利池所要求之费率相比较，亦可作为决定 FRAND 承诺的费率时的客观基准。专利权人所拥有的 SEP 对标准规格的贡献度比专利池之专利对标准规格的贡献度为高时，则可要求较专利池为高之费率；而专利权人所拥有的 SEP 对标准规格的贡献度比专利池之专利对标准规格的贡献度为低时，则应要求较专利池为低之费率。

It may also be necessary to note that, in some patent pools, a relatively low royalty is set as a result of taking into account the fact that negotiations, contracts, and the management of royalties are streamlined in many patent pools.<sup>235</sup>

此外，亦需留意专利池可能因为追求谈判、契约、许可费管理等方面的效率化，而设定较低之许可费。<sup>236</sup>

The licensing terms of a patent pool are not always comparable. The coverage rate and licensing record of the patent pool may be considered to assess whether there is comparability.<sup>237</sup>

再者，亦应留意专利池的授权条件并非必然为可比较的要件。识别专利池的授权条件是否为可比较时，应一并考虑专利池之涵盖率与授权记录等较为妥适。

---

<sup>235</sup> In *Microsoft v. Motorola* (U.S., federal district court, 2013), the court concluded that the royalty was triple the pool royalty.

<sup>236</sup> *Microsoft v. Motorola* (美国，联邦地院。2013 年)，法院裁定之许可费为专利池许可费的 3 倍。

<sup>237</sup> In *Microsoft v. Motorola* (U.S., federal district court, 2013), the court stated that the problem with using patent pools as the de facto RAND royalty rate is that the patent-counting royalty allocation structure of pools does not consider the importance of a particular SEP to the standard or to the implementer's products as the court's hypothetical negotiation requires.

There may also be cases where the patent pool situation differs from that of licenses negotiated bilaterally because the rate is set by multiple rights holders. It should also be noted that some rights holders are inflating SEP numbers through divisional patent applications.

又因专利池的费率有可能不同于一般的双方谈判授权,而是由多数专利权人所设定,故亦须注意专利权人是否有藉由分割申请而灌水 SEP 专利数量的情况。

### **b. Top-Down Approach / b. Top-Down 法**

*(Overview) / (概述)*

Determining an appropriate rate by calculating the ratio of the contribution of all the SEPs for the standard in the calculation base is generally known as the top-down approach. In this approach, the aggregate royalty rate is calculated as the extent of the contribution of all SEPs to the standard (total royalty rate for all SEPs that cover the standard), then allotted to individual SEPs.<sup>239</sup>

计算在计算基础中之所有与标准有关的 SEP 之贡献比例以得出适切的许可费率。此一计算方法一般称为 Top down 法。此法以与标准相关的所有 SEP 的贡献范围(即涵盖标准的所有 SEP 之许可费率之合计)计算出总许可费后,再分配至个别 SEP。<sup>240</sup>

---

238 *Microsoft v. Motorola*(美国,联邦地院,2013年),法院认为将专利池作为 de facto RAND 许可费率时,因专利池的许可费分配构造是以专利数计算,因而忽略了特定 SEP 对于标准或诉讼时的假想实施者之制品的重要性。

239 In *Apple v. Samsung* (Japan, IP high court, 2014), the court adopted a top-down approach and set the aggregate royalty rate at 5% for 3G based on the claims of the parties. In addition, in *TCL v. Ericsson* (U.S., federal district court, 2017), the court set the aggregate royalty at 5% for 2G/3G and at 6% or 10% for 4G. In *Huawei v. Conversant* (China, Nanjin Intermediate Court, 2019), the court adopted the top-down approach and indicated a formula to determine the royalty rate of SEPs (the aggregate royalty rate in the specific industry in China x the contribution rate of one SEP family).

240 *Apple v. Samsung*(日本,智财高院,2014年),法院基于当事人的主张,采用 Top down 法算出 3G 的累积许可费费率为 5%。此外, *TCL v. Ericsson*(美国,联邦地院,2017年),法院裁定累积 2G/3G 的许可费费率为 5%、4G 则为 6%或 10%。

(Avoiding Royalty Stacking) / (避免许可费堆叠)

Determining an appropriate rate by calculating the ratio of the contribution of all the SEPs for the standard in the calculation base is generally known as the top-down approach. In this approach, the aggregate royalty rate is calculated as the extent of the contribution of all SEPs to the standard (total royalty rate for all SEPs that cover the standard), then allotted to individual SEPs.

当有多数专利权人个别要求许可费时，则可能会发生个别许可费重叠，导致实施标准时之成本过高的问题。此一问题称为「Royalty Stacking」(许可费堆叠)，是在与同一标准有关的 SEP 由复数专利权人所拥有的情况下可能会发生的问题。

When many rights holders individually demand royalties, there may be cases in which each royalty “stacks up,” making the cost for practicing the standard excessively high. This is called royalty stacking, and is an issue that may occur when there are many rights holders that hold SEPs for the same standard.

而 Top down 法则因为以与标准相关的所有 SEP 的贡献范围作为费率之上限，故可有效回避许可费堆叠问题。从这观点来看，于采用 Bottom up 法时，一并利用 Top down 法，对于检查是否发生许可费堆叠问题亦有所说明。

While some parties believe that royalty stacking is occurring in practice, others suggest that there is no concrete proof of this.

然而对于许可费堆叠一事本身，亦有正反两方的意见，一方认为其为实际已发生之事，另一方则认为并无其实际发生的具体证据。

#### **4.Other Factors to Consider in Determining Rates / 4.决定费率的其他考虑因素**

In addition to the calculation base and the rate described above, other factors may also be considered in practice, as identified below.

除如上所述的计算基础与费率外，尚可加入如下所列之其他实务因素一并考虑。

**a.Number of Licensees that Agreed to the Royalty Rate / a.接受该许可费率之被授权者之数量**

The more licensees have agreed to a particular rate, the easier it may be to show that it is an established royalty rate and FRAND. Therefore, the number of existing licensees may be taken into consideration.

接受该许可费率之被授权者之数量越多，则越显示该许可费率已被确立。故被授权者之数量可为显示该许可费率是否为合理之考虑因素。

On the other hand, some point out that the number of licensees may not be relevant in the initial phase of licensing activities.

另一方面，亦有意见指出在授权活动的初期阶段，既存之被授权者之数量并无参考意义。

**b.Scope of License<sup>241</sup> / b.授权的性质或范围<sup>242</sup>**

In determining the appropriate royalty, the parties may also consider whether there is a restriction on where or to whom to sell the products.

授权的性质是独占或非独占、产品的销售区域或贩卖目的地是否有所限制，均为考虑合理许可费时之考虑因素。

**c.Essentiality/Validity/Infringement of Patent / c.专利的必须性、有效性、被侵权的可能性**

If a patent turns out to be inessential to a standard or invalid, or if there is no infringement, there is normally no need to obtain a license for the patent in order to implement the standard. An implementer, however, may make a business judgement to sign licensing agreements, even if it not convinced of essentiality, validity, or infringement, because of the risks and costs of litigation, or in view of future implementation of the standard. In such cases, the implementer may seek a suitable

---

241 Corresponding to GPF3.

242 对应 GPF3

discount to the royalty.

在专利并非实施标准所必须、专利无效或实施者并未侵害专利权的情况下，实施者并无必要取得授权。然而即使当事者于谈判期间有论及专利的必须性、有效性、被侵权的可能性，但由于考虑到诉讼的风险与费用以及标准规格的未来实施等因素，最终仍多会签订授权合约。然在此情形时，实施者亦可要求与之相应的许可费折扣。

The number of existing patents changes over time. Where there are patent rights which expire, patent rights which are acquired or divested, or patent rights which are newly registered, the number of patents subject to licensing will change.

再者，专利的存在件数会随时间而变，故在契约期间若有到期之专利；购入、卖出或新取得专利权之专利，则授权之专利件数亦会随之改变。

#### **d. Value of Individual Patents / d. 个别专利的价值**

Since the value of individual SEPs is inherently different, in calculating an appropriate royalty, sometimes weights are used rather than a simple ownership ratio to reflect the value of individual patents more accurately.<sup>243</sup> In such cases, some argue that patents that are extremely important to the standard should command a higher rate, while patents that are less important should command a lower rate. Others suggest that patents that have been inflated through divisional patent application should command a lower rate.

由于各个 SEP 的价值本就不同，故在计算适当的许可费时，其实并不应仅单纯乘以 SEP 的拥有比例，而是应该对个别专利进行加权计算，以便更正确地反映个别专利的价值。<sup>244</sup>例如对标准而言非常重要的专利，其费率应较高；对

---

<sup>243</sup> In *In re Innovatio* (U.S., federal district court, 2013), for example, the rights holder's patents were all of moderate to moderate-high importance to the standard, and therefore warranted a higher rate as compared to other patents essential to the standard. In *Unwired Planet v. Huawei* (UK, high court, 2017), the court allowed both parties to call expert witnesses to weigh the value of each patent. In *Apple v. Samsung* (Japan, IP high court, 2014), the court took patent weighing into consideration in determining that the contribution of the patent subject to litigation was not large.

<sup>244</sup> 例如在 *In re Innovatio*(美国，联邦地院，2013年)案中，法院认为专利权人之专利对于标准具有中度至高度的重要性，故应保障其较其他 SEP 有较高费率在 *Unwired Planet v. Huawei*(英国，高等法院，2017

标准而言重要性不高的专利,其费率则应较低。另亦有藉由分割数量填充的专利,其价值应较低的看法。

In cases where the parties involved find it not practical to accurately analyze the value of individual patents, however, the value of individual patents is treated as equal (pro rata).<sup>245</sup>

然因正确地分析个别专利的价值并不容易,现状仍以将各个专利视为等价(Pro Rata)的情况居多。<sup>246</sup>

### **e.Negotiating History / e.谈判历程**

The negotiation history between the parties is another factor that influences the determination of an appropriate royalty. If there is no difference in the royalty agreed with an implementer who has engaged in negotiations in good faith and that with an implementer who has acted in bad faith, there will be little incentive to negotiate in good faith. From that perspective, one approach is to give a suitable discount to a licensee who concludes a license soon after receiving a license offer, or one who requests a license before an offer is made.

当事者间的谈判历程为决定适当许可费的影响因素之一。若对善意谈判的实施者与非善意谈判的实施者都要求相同的许可费,则无诱因令实施者进行善意的谈判。举例而言,相较于授权要约后,早期取得许可的被许可人,应给予授权要约前,即主动要求授权的实施者相对的折扣。

In this way, the length of the negotiating period for an implementer compared to that for other implementers in similar situations may be a factor in determining an appropriate royalty. There is a possibility that an implementer who delays or impedes

---

年)一案,法院允许原告、被告双方对于其专利价值的重要性申请专家证人。在 Apple v. Samsung(日本, 智财高院, 2014 年)一案,法院对专利的重要性进行了评量,并认为该诉讼对象之专利的重要性并不高。

245 In addition, one royalty allocation method is based on the number of technologies adopted among contributions at the standard formulation stage, not the number of declared patents. This method can eliminate the influence of non-essential patents.

246 例如就许可费的分配方法而言,若不以采用的专利数量为基准,而是以标准策立阶段时所采用的技术数量为基准,则可排除非必要专利的影响。

negotiations will pay a substantially higher royalty.

同理，对于相同情况的实施者，其谈判时间的长短，亦为决定适当许可费率的考虑因素。实质上，延迟谈判或妨害谈判的实施者，可能需付出较高额的许可费。

Likewise, the royalty may become higher after a lawsuit has been initiated, as compared to a case in which the parties came to an agreement in the negotiations. In license negotiations, a rights holder may offer pre-litigation licensing rates at a discount. This indicates that once litigation starts, what is considered a reasonable royalty may become higher.

此外，与一般谈判后订定授权合约的情形相较，诉讼开始后才订定授权合约的许可费亦会较高。就一般的专利授权而言，专利权人于诉讼前可能提出许可费折扣，此亦表示一旦诉讼开始后，可合理推知许可费将会提高。<sup>247</sup>

On the other hand, some argue that because FRAND terms require rights holder to license SEPs to a wide range of parties, it is not suitable to give discounts to parties acquiring licenses early, or to demand high royalties from parties who delayed negotiations or took the rights holder to court.

另一方面，亦有 FRAND 承诺要求专利权人应广泛授权其 SEP，故对较早取得授权者提供优惠或对延迟谈判者及遭专利权人提出诉讼者求取高额许可费等事难谓恰当的看法。

## **B. Non-discriminatory Royalties / 无歧视许可费（翻译人员：关佩仪）**

SEP holders can demand royalties at FRAND terms from implementers, but those royalties have to be non-discriminatory. There are disputes regarding what constitutes non-discriminatory.

SEP 的专利权人可以向实施者要求依照 FRAND 承诺的许可费，但许可费必须是无歧视的，而关于什么是无差别待遇则存在争议。

---

<sup>247</sup> LaserDynamics v. Quanta(美国, CAFC, 2012 年), 法院指出因诉讼的强制性本质, 诉讼开始后才达成和解的许可费, 会较未发生诉讼即达成和解的许可费为高。



## 1. Concept of Non-Discrimination / 无歧视的思考方法

Although FRAND licensing terms have to be non-discriminatory, this does not mean that all potential licensees must obtain licenses at the same royalty rate and amount. Some argue that it is instead considered to mean that similarly situated licensees should not be treated differently.<sup>248</sup> Factors in considering whether licensees are similarly situated include whether the standard technology is used in the same way, the level of the company in the supply chain, and the geographic scope of the licensees' business activities.<sup>249</sup> <sup>250</sup> On the other hand, in some court rulings, the court determined that even if favorable licensing terms are provided to some licensees, it may not be discriminatory under certain conditions.<sup>251</sup> <sup>252</sup>

虽然 FRAND 授权条件必须是无歧视的，但这并不意味着所有被授权人必须以相同的授权费率以获得授权。一些人认为，这反而被认为是类似状况的被授权人应该不可被差别对待。<sup>253</sup> 考虑被授权人是否处于类似状况的因素包括标准技术

---

248 In *TCL v. Ericsson* (U.S., federal district court, 2017), regardless of whether it generally distorts the development of competition or standards, even if the implementer is alone, the court stated that it is discriminatory if the difference in the royalty rates causes damage.

249 In *TCL v. Ericsson* (U.S., federal district court, 2017), the court concluded that the following factors could be considered in determining whether two companies are similarly situated: the geographic scope of the companies, the licenses required by the companies, and sales volumes. The court also concluded that the following factors should not be considered in determining whether two companies are similarly situated: overall financial success or risk, brand recognition, the operating systems of their devices, and the existence of retail stores.

250 With regard to the issue of whether or not the FRAND rate should be a range, in *Microsoft v. Motorola* (U.S., federal district court, 2013), the court determined an upper and lower bound of the FRAND range for Motorola's SEP portfolio. In *Unwired Planet v. Huawei* (UK, high court, 2017), the court determined that each region has only one FRAND royalty rate apiece. In *Unwired Planet v. Huawei* (UK, EWCA, 2018), however, it was held that a number of sets of terms may be FRAND in a given set of circumstances.

251 In *Sisvel v. Haier* (Germany, Supreme Court, 2020), the court ruled that the right holder was allowed to provide a license to some licensees in their favorable licensing terms, if it could be objectively justified.

252 In *Unwired Planet v. Huawei* (U.K., Supreme Court, 2020), the court stated that considering the process of formulating the ETSI's IPR Policy, the rights holder did not have any obligation to grant a license in terms equivalent to the most favorable terms for licensees. (The court also stated that the non-discrimination limb was not hard-edged, but general.)

253 在 *TCL v. Ericsson* (美国, 联邦地区法院, 2017) 中, 无论其是否会扭曲竞争或标准的发展, 即使实施者是孤身一人, 法院也表示如果差别对待许可费率会造成损害。

的使用方式是否相同，公司在供应链中的位置以及商业活动的地域范围。<sup>254</sup> <sup>255</sup>另一方面，在一些法院的裁决中，法院裁定，即使向一些被许可人提供有利的许可条件，在某些条件下也可能不是歧视性的。<sup>256</sup> <sup>257</sup>

## 2. Royalties for Different Uses / 不同用途的许可费

In an IoT era, ICT is being used in various industries, and some rights holders consequently argue for different royalty rates and amounts for the same standard technology according to the particular use of that technology in the end product.

在物联网时代，各个行业都在使用信息和通信技术，因此有些专利权人会根据终端产品中同一标准技术的特定用途而争论不同的许可费率和金额。

Specifically, in the ICT field, there is a view that it is not discriminatory for a rights holder to apply different royalties for the same standard technology for products that fully utilize the functions of the technology (e.g., high-speed, high capacity; low latency) and those that only use some of the functions of the technology (e.g., massive Machine Type Communications).

具体而言，在信息和通信技术领域，有些意见认为专利权人对于同样的标准技术，充分利用该技术功能的产品（例如，高速、高容量、低延迟）以及仅使用该技术的一些功能的产品适用不同许可费的方式并非是歧视（例如，大规模机器

---

254 在 TCL v.Ericsson（美国联邦地区法院，2017）中，法院认为在确定两家公司是否具有类似地位时可考虑以下因素：公司的地域范围、公司需要的授权证以及销量。法院还认为，在确定两家公司是否处于类似地位时，不应考虑以下因素：整体财务成功或风险、品牌认同、其设备的操作系统或零售店的存在。

255 关于 FRAND 费率是否应该是一个范围的问题，在 Microsoft v.Motorola（美国联邦地区法院，2013 年）中，法院确定了摩托罗拉产品组合 SEP 之 FRAND 范围的上限和下限。在 Unwired Planet v.Huawei 案（英国，高等法院，2017）中，法院判定每个地区只有一个 FRAND 许可费率。然而，在 Unwired Planet v. Huawei 案（英国，EWCA,2018）中，法院认为在特定情况下，若干套条款可能是 FRAND 的。

256 在 Sisvel v. Haier 案（德国，最高法院，2020 年）中，法院认为，如果在客观上是合理的，则允许专利权人以其有利的许可条件向一些被许可人提供许可。

257 在 Unwired Planet v. Huawei 案（英国，最高法院，2020 年）中，法院表示，考虑到 ETSI 知识产权政策的制定过程，专利权人没有任何义务以相当于对被许可人最有利的条款授予许可（法院还指出，非歧视性条款不是硬性规定，而是一般性规定）。

类型通信)。

On the other hand, some implementers argue that the same royalty rates and amounts should be applied for the same standard technology regardless of the means by or extent to which it is used.

另一方面，一些实施者认为，不管用何种手段使用标准技术或使用标准技术到何种程度，相同的标准技术应该适用于相同的许可费率和金额。

Specifically, they argue that if different rates and amounts are allowed according to the means of utilization of a technology, it could lead to the value created by downstream inventors being allotted to rights holders, running counter to the “ex ante” principle.

具体而言，他们认为若根据技术的使用方式而允许不同的费率和金额，可能会导致下游发明人创造的价值被分配给专利权人，这与“事前 (ex ante)”原则背道而驰。

In addition, there is one view that where suppliers are granted licenses based on SSPPU, because the application of the suppliers' components is unknown, it can be difficult to apply different royalties depending on the end-product.

此外，有一种观点认为在供货商基于 SSPPU 获得授权的情况下，由于供货商组件的应用并不明确，所以很难根据最终的产品而适用不同的许可费。

### **C. Other / 其他**

There are several methods for paying royalties, and different methods will be selected depending on the circumstances.

有几种支付许可费的方法，根据情况而选择不同的方法。

#### **1. Fixed Rate and Fixed Amount / 固定利率和固定金额**

There is a fixed royalty rate and a fixed royalty amount. A fixed royalty rate is determined as a ratio of the price of the whole product and the price of product

components. It is necessary for implementers to know the price of products at all times when the price fluctuates according to market conditions, involving complicated procedures.

有固定利率许可费和固定金额许可费，固定利率系以产品整体价格和零件价格之比率作决定。当价格因市场情况波动时，实施者必须随时掌握产品的价格因而伴随而来烦杂的手续。

In order to reduce such complications, in practice, a method of deciding on a fixed amount of royalties per unit regardless of fluctuations in the price of a product may be used. Although it then becomes relatively simple to collect royalties in such a case, when the price of a royalty-bearing product varies over time, this may result in the royalties on product prices becoming too high or low for implementers.

为了减少这种复杂性，实际上可以使用不考虑产品价格波动而决定每单位固定金额许可费的方法。尽管在这种情况下收取许可费相对简单，但随着时间的进展，当产品的价格逐渐随时间而变化时，相对产品价格的许可费，对实施者而言可能会变得过高或过低。

## 2. Lump-Sum Payment and Running Royalty Payments / 总额型许可费和浮动型许可费

There are lump-sum payments and running royalty payments for paying royalties.

258

许可费的支付方式有总额型许可费支付和浮动型许可费支付。<sup>259</sup>

For lump-sum payments, there are advantages in being able to avoid the risks of non-payment of royalties and the burden of monitoring whether the technology is

258 In *Lucent v. Gateway* (U.S., CAFC, 2009), the court stated that a running royalty is risky to rights holders because such a royalty is subject to the sales of the implementer, while a lump-sum payment does not require monitoring of sales. On the other hand, the court stated that a lump-sum payment has the benefit of being easy to calculate but may not accurately reflect the value of the patent to the technology.

259 在 *Lucent v. Gateway* (美国, CAFC, 2009) 中, 法院指出, 对权利所有者而言, 浮动式许可费是有风险的, 因为这种许可费受制于实施者的销售, 而一次性许可费不需要监控销售。另一方面, 法院指出, 一次性许可费有利于易于计算, 但可能无法准确反映专利对技术的价值。

being used. At the same time, with the royalty fixed and paid before the future sales performance of the implementer's product (the actual usage of the technology in the market) has been established, royalties may in hindsight be too high or too low. Consequently, where both the rights holder and the implementer seek to conclude a lump-sum royalty agreement, they generally set terms that take into consideration predicted product sales.

对于总额型许可费,其有能够避免不支付许可费的风险以及监控技术是否被使用的负担之优点,同时,在未确定实施者的产品的未来销售业绩(技术在市场上的实际使用情况)之前就先确定许可费及支付,而许可费可能会过高或过低。因此,如果专利权和实施者都试图达成总额型许可费协议,那么他们通常会根据预测产品的销售情况而设定条款。

For running royalty payments, although it is possible to calculate royalties that reflect the actual usage of the technology, this adds the cost of monitoring to make sure the amount to be paid will increase or decrease appropriately in response to changes in sales.

对于浮动型许可费,虽然有可能计算反映技术实际使用的专利许可费,但为了确保要支付的金额会随着销售量的变动而适当增加或减少而增加了监控成本。

### **3. Past Component and Future Component / 过去的组成和未来的组成**

Royalties paid by those implementing SEPs from the past into the future can be calculated by considering both past and future implementation. In such cases, different formulas are used to calculate past and future royalties. For example, there are cases where the past royalty component has been calculated as a lump sum while the future component is calculated using a fixed-rate running formula.

从过去到未来因实施 SEPs 而支付的许可费,可考虑透过过去和未来所实施的情况来计算。在这种情况下,使用不同的公式来计算过去和未来的许可费。例如,有些情况下过去许可费的组成部分已经被计算为一笔总额,而未来组成部分是使用固定利率运行公式来计算。

#### 4. Volume Discounts and Cap (Paid-up) / 数量折扣和上限 (已缴"paid-up")

As an incentive to large-scale implementers, a discount rate may be applied for royalty payments over a certain level, or a ceiling set for royalty payments.

作为对大规模实施者的优惠方案, 支付超过特定级别的许可费可能有可适用的折扣率, 或可设定许可费上限的支付方式。

#### Postscript / 附录 (翻译人员: 陈梦豪)

Why has the Japan Patent Office engaged with the issue of SEP licensing negotiations? A year ago, it was proposed that JPO look into the introduction of an administrative adjudication system to determine SEP licensing terms. We concluded that a system based on implementer petitions would upset the balance between rights holders and implementers. We were also concerned that introducing such a system would send the wrong message at home and abroad that JPO is dismissive of rights holders' concerns.

为什么日本特许厅要研究与 SEP 许可谈判相关的问题? 一年前, 有人建议 JPO 研究引入行政裁决制度以确定 SEP 许可条款。我们的结论是, 这样一种基于技术实施者请求而启动的机制将打破权利人和实施者之间的平衡。我们担心如果引进这样的制度, 会给国内外带来 JPO 无视权利人诉求的错误信息。

How, then, could we address implementers' concern that the smooth introduction of new technologies could well be blocked depending on the way in which SEPs were exercised? Our answer was to provide information that would help implementers without experience in this field to engage in licensing negotiations more effectively and efficiently, forestall disputes, and achieve early dispute resolution.

那么如何解决技术实施者的担忧, 即新技术的顺利引入可能会因 SEP 的运作模式而受到阻碍? 我们的答案是提供信息, 帮助在这一领域没有经验的技术实施者更有效地参与许可谈判, 预防并尽早解决纠纷。

From fall 2017 through to spring 2018, we sought the views of experts here and

abroad to gain a sense of the debates underway around the world. There was no way to absorb such a massive amount of constantly evolving information. We decided to concentrate on setting up the most open process we could manage to garner a broad range of information and opinions, identify the key issues, and present these in a balanced and straightforward manner.

从2017年秋季到2018年春季，我们征求了国内外专家的意见，以了解世界各地正在进行的讨论。我们不可能吸收如此庞大并不断演变的信息。我们决定集中精力建立一个尽可能公开的程序，以获得广泛的信息和意见，确定关键问题并以一种平衡和直接的方式提出。

This Guide was compiled by a small team in a limited amount of time, and is consequently far from perfect. Our presentation of both sides of the debate may also be difficult to follow in some places, but it does reflect the heat of the discussion and the lack of convergence over certain points.

本指南是由一个小团队在有限的时间内编写的，因此远非完美。在某些问题上，指南的陈述不可能对讨论双方的观点面面俱到，但它确实反映了讨论的激烈程度和在某些问题上缺乏一致性。

That convergence will eventually emerge as technologies and markets continue to evolve and cases of dispute resolution accumulate, while new issues too will inevitably emerge. We look forward to updating this Guide as appropriate with reference to advice from experts here and abroad.

随着技术和市场的不断发展、纠纷解决的案例不断积累，很多问题都将得出一致性的结论，当然新的问题也不可避免地会出现。我们期待参考国内外专家的意见，并适时更新本指南。

Naoko Munakata

Commissioner

(June 5, 2018)

宗田直子委员

2018年6月5日

**Postscript of the Revision / 修订的附录**

Postscript will be added here.

附录将添加在这里。

Kiyoshi Mori Commissioner

(2022)

清 Mori 专员

(2022)

**Reference / 参考内容**

<Japan>

- Apple v. Samsung (Japan, IP high court, 2014) Case No. 2013 (Ne) 10043
- Imation v. One-Blue (Japan, district court, 2015) Case No. 2013 (Wa) 21383



- Softbank v. Kanematsu (Japan, IP high court, 2015) Case No. 2015 (Ne) 10069

<U.S.>

- Apple v. Motorola (U.S., CAFC, 2014)

Apple, Inc. v. Motorola, Inc., 757 F.3d 1286 (Fed. Cir. 2014), overruled on other grounds by Williamson v. Citrix Online, LLC, 792 F.3d 1339 (Fed. Cir. 2015).

- CSIRO v. Cisco (U.S., CAFC, 2015)

Commonwealth Scientific and Indus. Research Organization v. Cisco Sys., Inc., 809 F.3d 1295 (Fed. Cir. 2015).

- Continental v. Avanci (U.S. District Court of Northern Texas, 2020)

- Cornell University v. Hewlett-Packard (U.S., federal district court, 2009)

Cornell University v. Hewlett-Packard Co., 609 F.Supp.2d 279 (N.D.N.Y. 2009).

- eBay v. MercExchange (U.S., Supreme Court, 2006)

eBay Inc. v. MercExchange, LLC, 547 U.S. 388 (2006).

- Ericsson v. D-Link (U.S., CAFC, 2014)

Ericsson, Inc. v. D-Link Systems, Inc., 773 F.3d 1201 (Fed. Cir. 2014).

- Fujitsu v. Netgear (U.S., CAFC, 2010)

Fujitsu v. Netgear, 620 F.3d 1321 (Fed. Cir. 2010).

- Fujitsu v. Netgear (U.S., CAFC, 2010)

- In re Innovatio (U.S., federal district court, 2013)

Innovatio IP Ventures, LLC Patent Litigation, No. 11-c-9308, 2013 WL5593609 (Oct. 3, 2013).

- LaserDynamics v. Quanta (U.S., CAFC, 2012)

LaserDynamics, Inc. v. Quanta Computer, Inc., 694 F.3d 51 (Fed. Cir. 2012).

- Lucent v. Gateway (U.S., CAFC, 2009)

Lucent Technologies, Inc. v. Gateway, Inc., 580 F.3d 1301 (Fed. Cir. 2009).

- Microsoft v. Motorola (U.S., federal district court, 2012)

Microsoft Corp. v. Motorola, Inc., 864 F. Supp. 2d 1023 (W.D. Was. 2012).

- Microsoft v. Motorola (U.S., court of appeals for the ninth circuit, 2012)

Microsoft Corp. v. Motorola, Inc., 696 F.3d 872 (9th Cir. 2012)

- Microsoft v. Motorola (U.S., federal district court, 2013)

Microsoft Corp. v. Motorola, Inc., No.c-10-1823JLR, 2013 WL 2111217 (W.D. Was. Apr. 25, 2013).

- Quanta v. LG (U.S., Supreme Court, 2008)

Quanta Computer, Inc. v. LG Elecs., Inc., 553 U.S. 617 (2008).

- Realtek v. LSI (U.S., federal district court, 2013)

Realtek Semiconductor Corp. v. LSI Corp., 946 F. Supp. 2d 998 (N.D. Cal. 2013).

- ResQNet v. Lansa (U.S., CAFC, 2010)

ResQNet.com, Inc. v. Lansa, Inc., 594 F.3d 860 (Fed. Cir. 2010).

- TCL v. Ericsson (U.S., federal district court, 2017)

TCL Comm. Tech Holdings, Ltd v. Ericsson, No.8-14-cv-00341 (C.D. Cal. Dec. 21, 2017).

- Therasense v. Becton (U.S., CAFC, 2011)

Therasense, Inc. v. Becton, Dickinson and Co., 649 F.3d 1276 (Fed. Cir. 2011) (en banc).

- Virnetx v. Cisco (U.S., CAFC, 2014)

Virnetx, Inc. v. Cisco Sys., Inc., 767 F.3d 1308 (Fed. Cir. 2014).

<EU>

- GAT v. Luk (EU, CJEU, 2006)

Case C-4/03, Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG. [2006] CJEU

- Huawei v. ZTE (EU, CJEU, 2015)

Case C-170/13, Huawei Technologies Co. Ltd v ZTE Corp., ZTE Deutschland GmbH [2015] CJEU

- Motorola v. Apple (EU, EC, 2014)

European Commission, DG Competition, Decision of 29 April 2014, C(2014) 2892 final, Motorola Mobility Inc.

- Nokia v. Daimler (EU, CJEU, 2021)

Case C-182/21, Nokia Technologies Oy v Daimler AG [2021] CJEU

- Samsung v. Apple (EU, EC, 2014)

European Commission, DG Competition, Commitment Decision of 29 April 2014, C(2014) 2891 final, Samsung Electronics Co., Ltd., et. Al.

<Germany>

- NTT DoCoMo v. HTC (Germany, district court, 2016)

LG Mannheim, Case 7 O 66/15, Order of 29 January 2016

- Philips v. Archos (Germany, district court, 2016)

LG Mannheim, Case 7 O 19/16, Order of 17 November 2016

- Sisvel v. Haier (Germany, high court, 2016)

OLG Düsseldorf, Case I-15 U 66/15, Order of 17 November 2016

- Sisvel v. Haier (Germany, Supreme Court, 2020) BGH, KZR 36/17, Order of 5

May 2020

- St. Lawrence v. Deutsche Telekom and HTC (Germany, district court, 2015)

LG Mannheim, Case 2 O 106/14, Order of 27 November 2015

- St. Lawrence v. Vodafone and HTC (Germany, district court, 2016) LG

Düsseldorf, Case 4a O 73/14, Order of 31 March 2016

- Sisvel v. Wiko (Germany, District Court of Mannheim, 2019)

LG Mannheim, Case 7 O 115/16, Order of 4 September 2019

- Nokia v. Daimler (Germany, District Court of Munich, 2020) LG Muenchen,  
No. 21 O 3891/19

- Sharp v. Daimler (Germany, District Court of Munich, 2020) LG Muenchen,  
No. 7 O 8818/19, Order of 10 Sep 2020

- Conversant v. Daimler (Germany, District Court of Munich, 2020) LG  
Muenchen, No. 21 O 11384/19 Order of 23 Oct 2020

<UK>

- Unwired Planet v. Huawei (UK, high court, 2017)

Unwired Planet v. Huawei ([2017] EWHC 711 (Pat), 5 Apr. 2017)

- Unwired Planet v. Huawei (UK, EWCA, 2018)

Unwired Planet v. Huawei ([2018] EWCA Civ 2344, 23 October 2018)

- Unwired Planet v. Huawei (UK, Supreme Court, 2020)

Unwired Planet v. Huawei ([2020] UKSC 37, 26 August 2020)

<China>

- Huawei v. Conversant (China, Nanjin Intermediate Court, 2019) Case No. 232, 233, 234 of 2018

- Huawei v. Conversant (China, Supreme People's Court, 2020) Case No. 732, 733, 734 of 2019

- Huawei v. Samsung (CN, intermediate court, 2018) Case No. 816 of 2016



• OPPO v. Sharp (China, Shenzhen Intermediate Court, 2020) Case No. 689 of 2020

• Xiaomi v. InterDigital (China, Wuhan Intermediate Court, 2020) Case No.169 of 2020

• ZTE v. Conversant (China, Shenzhen Intermediate Court, 2020) Case No. 335-1of 2018

• Samsung v. Ericsson (China, Wuhan Intermediate Court, 2020) Case No. 743 of 2020

<India>

• InterDigital v. Xiaomi (India, Delhi High Court, 2020)

Interdigital Technology Corporation & Ors. v. Xiaomi Corporation & Ors. (I.A. No. 8772/2020 in CS (COMM) 295/2020)

<Other>

- “Good Faith Negotiation Guidelines for Standard Essential Patent Licenses”, Ministry of Economy, Trade and Industry of Japan (2022)

[https://www.meti.go.jp/policy/economy/chizai/sep\\_license/index.html](https://www.meti.go.jp/policy/economy/chizai/sep_license/index.html)

- “Benefits of Arbitration for Commercial Disputes”, American Bar Association  
[https://www.americanbar.org/content/dam/aba/events/dispute\\_resolution/committees/arbitration/arbitrationguide.authcheckdam.pdf](https://www.americanbar.org/content/dam/aba/events/dispute_resolution/committees/arbitration/arbitrationguide.authcheckdam.pdf)

- European communication (2017)

Communication from the Commission to the European Parliament, the Council and the European Economic and Social Committee: Setting out the EU approach to Standard Essential Patents

- Pilot study for essentiality assessment of Standard Essential Patents (2020)  
[https://publications.jrc.ec.europa.eu/repository/handle/JRC119894#:~:text=and%20growth%20Standards-,Pilot%20study%20for%20essentiality%20assessment%20of%20Standard%20Essential%20Patents,Standard%20Essential%20Patents%20\(SEPs\)](https://publications.jrc.ec.europa.eu/repository/handle/JRC119894#:~:text=and%20growth%20Standards-,Pilot%20study%20for%20essentiality%20assessment%20of%20Standard%20Essential%20Patents,Standard%20Essential%20Patents%20(SEPs))

- SEPs Expert Groups Contribution to the Debate on SEPs (2021)  
<https://ec.europa.eu/docsroom/documents/45217>

- IEEE-SA Standards Board Bylaws (2015)

<http://standards.ieee.org/develop/policies/bylaws/approved-changes.pdf>

- Makan Delrahim, Assistant Attorney General, Antitrust Division, U.S. Department of Justice, “Take it to the Limit: Respecting Innovation Incentives in the Application of Antitrust Law,” Remarks as prepared for delivery at USC Gould School of Law – Application of Competition Policy to Technology and IP Licensing (Nov. 10, 2017) (“Innovation Incentives Speech”)

<https://www.justice.gov/opa/speech/assistant-attorney-general-makan-delrahim-delivers-remarks-usc-gould-school-laws-center>

- New York Convention <http://www.newyorkconvention.org/>

- The Japan Fair Trade Commission the “Guidelines for Use of Intellectual Property under the Antimonopoly Act”

[http://www.jftc.go.jp/en/legislation\\_gls/imonopoly\\_guidelines.files/IPGL\\_Frand.pdf](http://www.jftc.go.jp/en/legislation_gls/imonopoly_guidelines.files/IPGL_Frand.pdf)

· U.S. Dep't of Justice and Federal Trade Commission, Antitrust Guidelines (2017)

U.S. Dep't of Justice and Federal Trade Commission, Antitrust Guidelines for the Licensing of Intellectual Property (Jan. 12, 2017)

· U.S. Dep't of Justice, U.S. Patent and Trademark Office and National Institute of Standards and Technology, Policy Statement (2019)

· U.S. Dep't of Justice and U.S. Patent and Trademark Office, Policy Statement (2013)

U.S. Dep't of Justice and U.S. Patent and Trademark Office, Policy Statement on Remedies for Standard-Essential Patents Subject to Voluntary FRAND Commitments (Jan. 8, 2013)



联系我们 Contact us

☎ 010-82896122

✉ IPE@ipeconomy.cn



战略/市场合作  
Strategic/Market  
cooperation



文章投稿  
Contribute  
channels



杂志订阅  
Magazine  
subscriptions