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**The standardization of new technologies – its influence on the freedom to exercise  
patent rights**

(a summary of a doctoral dissertation drafted under the supervision of Prof. INP PAN dr.  
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Standards (also known as “norms”) have long played an important role in the everyday life of societies. They are used in many products available on the market, manufactured by various entities, for example in the field of new technologies, as well as health and safety.

Regardless of how the standards are created (in particular in the telecommunications sector), it often happens that the implementation of standards requires the application of patented inventions. The existence of standard essential patents (SEP) causes a risk that the aims of standardization (which include the wide application of standardized solutions by a large number of applicants) will not be achieved. This is due to the fact that, as a general rule, it is not possible to implement standards in devices and services that will be offered on the market, without obtaining the consent of the SEP holder for the use of the patented invention (i.e. concluding a licence agreement). Patent holders are also entitled to obtain fair remuneration for contributing their innovative technology to be used in standardized solutions.

In the event that implementing a standard requires the use of patented technology, the standard setting organisations will require SEP holders to submit what is known as a FRAND declaration. In this declaration, the patent holder states that he will make available (or is prepared to grant) licences for the use of the patented invention on fair, reasonable and non-discriminatory terms and conditions for entities intending to use the patented invention for the purpose of implementing the relevant standards.

However, even submitting such a declaration does not eliminate disputes between SEP holders and the entities implementing standards in their devices introduced on the market. Those disputes result, among other things, from persisting doubts concerning the legal consequences of filing FRAND declarations. In the course of such disputes, various questions have been raised concerning the scope of freedom to exercise rights resulting from SEP patents that are subject to a FRAND declaration. It has been asked whether the freedom is limited in comparison with that resulting from patents that are not essential to the implementation of a standard and that are not subject to a FRAND declaration. In particular, it is a contentious issue whether a FRAND

declaration results in any obligations for the patent holder, e.g. in terms of granting a licence. Moreover, it is also disputable whether patent holders are entitled to claim patent injunctions against entities using patented inventions in order to implement the standard, without concluding license agreement.

Given the actual phenomena and doubts raised in this matter, the essence of the research problem of the dissertation concerns the question of whether the circumstances whereby a given patent is essential in order to implement a standard and a patent holder has submitted a FRAND declaration have an impact on its legal situation regarding the ability to execute patent rights, i.e. whether and how submitting a FRAND declaration: a) limits the freedom of the patent holder to decide to whom and on which conditions it will grant licences, and b) limits the freedom to resist the activities of third parties that enter into the scope of exclusivity resulting from patent rights that are subject to FRAND declarations.

Analysing this research problem resulted in the formulation of the thesis of the dissertation, according to which the circumstances whereby a given patent is essential for the implementation of a standard and is subject to a FRAND declaration does affect the patent holder's freedom to decide not only with respect to whether to grant a license at all, but also regarding the person of the licensee and the conditions of such a licence. As a result, the legal possibilities of holders of SEP patents claiming patent injunctions are limited in comparison with the possibilities enjoyed by holders of patents that are not essential for the implementation of standards and that are not subject to a FRAND declaration.

The research aim of this dissertation is to verify the accuracy of the above thesis, and if it is confirmed as legitimate – to identify the prerequisites and legal grounds for the limitation of the freedom to exercise patent rights resulting from standard essential patents subject to a FRAND declaration.

The dissertation is constructed with this aim firmly in mind. The first chapter is devoted to a general presentation of the phenomenon of standardization. In the first part, the notion of standards, their types and the role of standardization in the modern economy is discussed, along with the benefits and risks resulting from standardization processes and the legal consequences of using patented solutions in standards. Further, the chapter discusses the rules applicable in selected standard organisations in situations when it is or is likely to be necessary to use a patented invention in order to implement a standard.

The arrangements regarding the content and the procedure of submitting FRAND declarations made in the first chapter form the basis for further consideration, divided into two main blocks. The first one covers issues concerning the legal nature and meaning of FRAND declarations under EU law, the laws of selected countries and Polish law (second and third

chapters). In turn, the second block of considerations (fourth and fifth chapters) concerns limitations in raising patent injunction claims concerning SEP patents that are subject to FRAND declarations, and the legal bases therefor, which, depending on the jurisdiction, may result from constructions deriving from competition law or private law.

Therefore, the second chapter looks at whether a FRAND declaration can be treated as a declaration of intent forming part of a contract, on the basis of which an entity interested in using the patented invention for the purpose of implementing the standard may request (enforce) the conclusion of a licence agreement under the FRAND terms and conditions. The analysis included in this chapter is based on case-law and the views of the legal doctrine presented on the grounds of US, German and Japanese laws, but also in light of the jurisprudence of the Court of Justice of the European Union and decisions of the European Commission. The third chapter sets out considerations concerning the legal nature and consequences of the FRAND declaration analysed on the grounds of Polish civil law.

The fourth chapter aims to answer questions about the freedom of holders of SEP patents subject to a FRAND declaration to raise patent injunction claims against entities using the patented invention in order to implement the standard. This issue is analysed on the basis of EU, German and Polish competition law. In the fifth chapter, the availability of a patent injunction for SEP holders is analysed from the perspective of the private law of selected countries (the US, Japan and the Netherlands). This chapter also discusses whether SEP holders raising patent injunction claims against entities implementing standards can be considered an abuse of patent rights or a breach of obligations under Polish law.

The last part of the dissertation comprises a summary of the analysis of the previous chapters, concluding that the thesis of the dissertation is accurate – holders of SEP patents who have submitted FRAND declarations do indeed have limited freedom to decide to whom and on which conditions they will grant licences. This also means that the legal possibilities of effectively raising patent injunction claims resulting from such patents against entities implementing the standards are also limited. The limitations described in the dissertation vary in terms of their legal character and can result, depending on the jurisdiction and factual circumstances, not only from competition law, but can also constitute a breach of contract or an abuse of patent rights, among other things. At the same time, the analysis included in the dissertation reveals the large diversity of views as to the legal nature of the FRAND declaration and the various areas of law that may be applicable in situations where the holder of a SEP raises an injunction claim against entities using patented inventions in order to implement standards, as well as the different ways that the courts in various countries have judged these situations.