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2017

ISSN 2282 - 667X

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Il presente lavoro è stato sottoposto ad un procedimento di revisione tra pari, secondo i criteri indicati nella *Nota per gli autori*

ORIZZONTI DEL DIRITTO COMMERCIALE

Rivista Telematica

ISSN 2282 - 667X

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IL CALCOLO DEI DIRITTI DI LICENZA IN REGIME FRAND: TRE CRITERI PRO-CONCORRENZIALI DI RAGIONEVOLEZZA*

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1. Premessa. Diritti di proprietà industriale e standardizzazione. Dal tradizionale indirizzo pro-concorrenziale della UE in materia di telecomunicazioni, all'applicazione della dottrina delle essential facilities alle tecnologie 'indispensabili'.

L'indirizzo 'pro-access' quale espressione di una politica *generale* nel settore delle tecnologie dell'informazione e delle comunicazioni ("ICT") – un settore che vive di interconnessioni – fu originariamente promosso dalla Commissione europea con l'emanazione delle linee guida sulla liberalizzazione dei segnali delle trasmissioni televisive e delle telecomunicazioni. In tale contesto, la Commissione espresse forti preoccupazioni in merito ai rischi della "chiusura proprietaria" degli standard. Di conseguenza, la Direttiva 92/38/CEE relativa all'emissione via satellite di segnali televisivi, riconobbe che l'uso di standard comuni poteva rappresentare "*un elemento che consente una effettiva libera concorrenza*" soprattutto "*tenendo conto che gli standard promuovono la competitività riducendo i costi per i produttori*" (¹).

Tale convinzione fu nuovamente espressa nelle Linee guida sulla proprietà intellettuale e la standardizzazione del 1992 (²), nella prima versione della *IPR Policy* dell'*European*

* Questo scritto, dedicato ad Hanns Ullrich, è frutto di ricerca e riflessione comune dei due autori. La redazione dei paragrafi 1-3 deve attribuirsi a Gustavo Ghidini, mentre quella dei paragrafi 4-6 a Giovanni Trabucco. L'articolo rappresenta un'ampia revisione di una relazione presentata alla Conferenza internazionale "Innovation for Shared Prosperity: IPRs, Competition and Standard Setting in the ICT Sector", promossa dalla O. P. Jindal Global University e tenutasi a Nuova Delhi, il 20-21 agosto 2016.

** Professore ordinario, Università di Milano.

*** Cultore della materia 'Diritto industriale', Università di Milano.

¹ Cfr. settimo *considerando* della Direttiva 92/38/CEE del Consiglio dell'11 maggio 1992 relativa all'adozione di standard per l'emissione via satellite di segnali televisivi; cfr. altresì il settimo *considerando* della Direttiva 95/47/CE del Parlamento Europeo e del Consiglio del 24 ottobre 1995 relativa all'impiego di standard per la trasmissione di segnali televisivi.

² Cfr. *Comunicazione della Commissione – Diritti di Proprietà Intellettuale e Normalizzazione*, COM(92)445, del 27 ottobre 1992. Per un recente commento che contestualizza questo primo approdo della Commissione ai successivi sviluppi – normativi e giurisprudenziali – del diritto dell'Unione Europea, si rinvia a D. GERADIN,

Telecommunications Standards Institute (“ETSI”) del 1994⁽³⁾ nonché nella 1999 *Communications Review* indirizzata al Parlamento Europeo⁽⁴⁾. In seguito, in una prospettiva ancor più ampia, le *Linee direttive sull'applicazione dell'articolo 81 del trattato CE agli accordi di cooperazione orizzontale* del 2001 della Commissione affermarono che, ove emergano standard industriali – siano essi *de iure* o *de facto*⁽⁵⁾ – “la principale preoccupazione sarà [...] di garantire che tali standard siano il più possibile accessibili e che siano applicati in una maniera chiara e non discriminatoria. Per evitare l'eliminazione della concorrenza nel(i) mercato(i) rilevante(i) i terzi devono poter accedere allo standard a condizioni eque, ragionevoli e non discriminatorie”⁽⁶⁾: più note, nella locuzione in lingua inglese, come condizioni “fair, reasonable and non-discriminatory”. Sinteticamente: “FRAND”.

L'originario indirizzo ‘aperto’ delle istituzioni politiche comunitarie verso gli standard nel settore ICT, ha affiancato, e anzi probabilmente incoraggiato, l'orientamento delle Corti europee in ordine al regime da applicare alle innovazioni di più alto livello tecnologico, protette da brevetti per invenzione o copyright: a partire dalle ormai storiche decisioni ispirate alla dottrina delle c.d. *essential facilities*⁽⁷⁾, sino alle più recenti riguardanti i c.d. brevetti essenziali *ad uno standard* – “standard essential patents” o “SEPs”: si vedano i casi *Samsung* e

European Union Competition Law, Intellectual Property law and Standardization, in corso di pubblicazione in J. CONTRERAS (a cura di), *Cambridge Handbook on Technical Standardization Law*, 2017, reperibile in internet al seguente indirizzo: <https://ssrn.com/abstract=2907632>.

- ³ Per una ricostruzione delle negoziazioni che hanno portato alla versione del 1994 della *IPR Policy* dell'ETSI, si veda R. BROOKS, D. GERARDIN, *Taking contracts seriously: the meaning of the voluntary commitment to license essential patents on 'fair and reasonable' terms*, in S. ANDERMAN, A. EZRACHI (a cura di), *Intellectual property and competition law: new frontiers*, Oxford, Oxford University Press, 2011, 397 ss. L'ultimo aggiornamento della *IPR Policy* di ETSI – al momento della stesura dell'articolo – risale al giugno 2016 ed è consultabile sul sito ufficiale dell'organizzazione, al seguente indirizzo: <http://www.etsi.org/about/how-we-work/intellectual-property-rights-iprs>.
- ⁴ Si veda *Comunicazione della Commissione – Verso un nuovo quadro per l'infrastruttura delle comunicazioni elettroniche e i servizi controllati, Esame del 1999 sul quadro normativo delle comunicazioni, Relazione sulle comunicazioni 1999*, COM(1999)539, del 10 novembre 1999.
- ⁵ Per “standard *de iure*”, s'intende un insieme di specifiche tecniche cui più soggetti aderiscono a seguito di un accordo formale, ovvero per effetto di un obbligo di legge. Con l'espressione “standard *de facto*” si indicano invece gli standard che sorgono per effetto di forze di mercato, che “selezionano” alcune tecnologie sopra altre. Si tratta ad esempio del c.d. *network effect*, vale a dire il fenomeno (noto anche come “*demand-side economies of scale*”) per il quale l'utilità che un consumatore ricava da un determinato prodotto cresce quando, e nella misura in cui, altri utilizzano il medesimo prodotto. Il *network effect* agisce come un potente *catalizzatore* di domanda, con la conseguenza che essa si autoalimenta, continuando ad attrarre nella sua rete sempre più consumatori (c.d. *direct network effect*). E più il numero degli acquirenti del prodotto aumenta, più saranno lanciati sul mercato prodotti con esso *compatibili*, rendendo il prodotto base ancor più appetibile per i consumatori (c.d. *indirect network effect*). Il fenomeno dell'effetto rete è particolarmente intenso nel contesto delle tecnologie ICT – oggetto principale del presente contributo – spesso caratterizzato da forme di competizione *sistemica*, in cui le imprese competono offrendo sul mercato prodotti inter-connessi da vincoli funzionali, tali per cui i consumatori possono trarre vantaggio solo da un acquisto congiunto dell'intero pacchetto. L'esempio classico di tale nesso funzionale è quello tra l'*hardware* di un computer e il suo sistema operativo, e tra tali due elementi e programmi come i *browser* che permettono agli utenti di navigare in internet. Si noti tuttavia che standard *de facto* possono essere individuati anche in altri settori della tecnica, come quello dell'innovazione farmaceutica: si ricorda il caso *Pfizer* relativo alla tutela brevettuale e regolatoria del *latanoprost*, un farmaco utilizzato nella cura del glaucoma: cfr. decisione AGCM, 11 gennaio 2012, n. 23194, *Ratiopharm/Pfizer*; confermata da Consiglio di Stato, 12 febbraio 2014, n. 693, in *Rass. dir. farm.*, 2014, 2, 336.
- ⁶ Cfr. *Comunicazione della Commissione – Linee direttive sull'applicabilità dell'articolo 81 del Trattato CE agli accordi di cooperazione orizzontale*, (2001/C 3/02), del 6 gennaio 2001: par. 143 e 174.
- ⁷ Corte Giust. UE, 6 aprile 1995, C-241/91 e C-242/91, *Magill*; Corte Giust. UE, 29 aprile 2004, C-418/01, *IMS Health*; Corte Giust. UE, 17 settembre 2007, *Microsoft*.

Motorola, e la sentenza *Huawei/ZTE* ⁽⁸⁾ – ossia i brevetti che è *necessario* attuare per poter realizzare prodotti e procedimenti conformi ad uno standard tecnico ⁽⁹⁾.

Tale orientamento consiste, come noto, nel concepire in senso evolutivo, all'insegna di una identica ratio pro-concorrenziale, i diritti di proprietà industriale: dal paradigma escludente, ad uno di accesso pagante ⁽¹⁰⁾. Più precisamente, dal riconoscimento del diritto di vietare ai terzi l'uso dell'oggetto di protezione, all'affermazione – nel postulato dell'accertata posizione dominante – di un dovere di accordare l'accesso ai i c.d. “*willing licensees*” a condizioni FRAND. Uno schema di *pay-for-sharing*, la cui applicazione è ora fortemente incoraggiata dal ‘galateo’ dettato dalla sentenza *Huawei/ZTE* – espressione di un canone di correttezza *in contrahendo* – in virtù del quale è il titolare del brevetto essenziale a dover offrire per primo una licenza, e non il potenziale licenziatario a doverla chiedere.

Con riferimento ai brevetti essenziali a uno standard, va ricordato che l'obbligo di concedere una licenza a condizioni FRAND a coloro che vogliono conformarsi allo standard è, di regola, frutto di un impegno del titolare stesso. In particolare, in relazione agli standard formali, si tratta tipicamente di un impegno di natura contrattuale concluso con un ente di standardizzazione (una c.d. “*standard-setting organisation*” o “*SSO*”) e più spesso espressamente imposto da quest'ultimo come requisito per l'inclusione di una determinata soluzione tecnica nello standard. Tale impostazione è stata fatta propria dalla Commissione che nel 2011, con le Linee direttive sull'applicabilità dell'art. 101 TFUE agli accordi di cooperazione orizzontale, ha stabilito che “*per garantire un accesso effettivo*” allo standard “*la politica in materia di DPI [delle SSO] deve imporre a tutti i partecipanti che desiderano che il loro DPI sia incluso nella norma di impegnarsi irrevocabilmente per iscritto a concedere in licenza il loro DPI essenziale a tutti i terzi a condizioni [FRAND]*” ⁽¹¹⁾.

Orbene, in relazione alla natura contrattuale degli obblighi di licenza assunti dai titolari di brevetti essenziali nei confronti delle SSO, ha certamente ragione Hanns Ullrich ⁽¹²⁾ nel rilevare, per così dire, l'autosufficienza civil-commercialistica rispetto alla normativa antitrust, nel caso oggetto della decisione *Huawei/ZTE*, e di alcune altre consimili che l'hanno

⁸ Comm. UE, decisione del 29 aprile 2014, *Samsung*, AT.39939, C(2014) 2891; Comm. UE, decisione del 29 aprile 2014, *Motorola*, AT.39985, C(2014) 2892; Corte Giust. UE, 16 luglio 2015, C-170/13, *Huawei c. ZTE* (di seguito, “*Huawei/ZTE*”).

⁹ In questo senso si veda, per tutte, la definizione di *standard essential patent* proposta nella IPR Policy ETSI (cfr. *supra* n. 3) secondo cui: “*ESSENTIAL as applied to IPR means that it is not possible on technical (but not commercial) grounds, taking into account normal technical practice and the state of the art generally available at the time of standardization, to make, sell, lease, otherwise dispose of, repair, use or operate EQUIPMENT or METHODS which comply with a STANDARD without infringing that IPR. For the avoidance of doubt in exceptional cases where a STANDARD can only be implemented by technical solutions, all of which are infringements of IPRs, all such IPRs shall be considered ESSENTIAL*”. Di seguito, per esigenze di sintesi, si farà generalmente riferimento a “prodotti” conformi allo standard, senza con ciò implicare alcuna distinzione rispetto a “metodi” e “procedimenti”.

¹⁰ Si veda in proposito il recente contributo di F. ABBOTT, *Rethinking Patents: From Intellectual Property to Private Taxation Scheme*', in P. DRAHOS, G. GHIDINI, H. ULLRICH (a cura di), *Kritika: Essays on Intellectual Property*, vol. 1, Cheltenham, Edward Elgar, 2015, 1.

¹¹ Cfr. *Comunicazione della Commissione – Linee direttive sull'applicabilità dell'articolo 101 del trattato sul funzionamento dell'Unione europea agli accordi di cooperazione orizzontale* (2011/C 11/01), 14 gennaio 2011, par. 285 ss..

¹² H. ULLRICH, *FRAND Access to open standards and the patent exclusivity: Restating the principles*, in *Max Planck Institute for Innovation and Competition Research Paper No. 17-04*, reperibile in internet al seguente indirizzo: <https://ssrn.com/abstract=2920660>.

preceduta⁽¹³⁾: casi nei quali, appunto, l'originario impegno contrattuale era stato assunto dall'innovatore 'in cambio' dell'elezione a standard della propria tecnologia brevettata⁽¹⁴⁾.

Altrettanto fondato appare tuttavia, a parere di chi scrive, sottolineare una fondamentale identità di ratio fra quelle fattispecie ed altre nelle quali pure, al di là della differenza genetica (previo impegno/assenza di un previo impegno) è stato affermato – in applicazione della dottrina delle *essential facilities* – l'obbligo di dare accesso ai potenziali concorrenti. In entrambi i casi, infatti, si tratta di prevedere una forma accesso pagante a condizioni (*lato sensu*) FRAND a tecnologie indispensabili o non efficacemente sostituibili, ove il diniego di accesso, e quindi la conservazione della 'riserva proprietaria', possa metter capo ad una situazione di *foreclosure* del mercato rilevante. E ciò, si precisi, anche verso tecnologie rispetto alle quali *nessun impegno* è stato assunto: ci riferiamo, ovviamente, alla estensione della dottrina delle *essential facilities* agli standard *de facto*.

Del resto lo stesso 'scambio', tecnicamente contrattuale, tra elezione a standard di un determinato brevetto e assunzione dell'obbligo di licenza, non è forse stato promosso dalle istituzioni UE in una prospettiva strumentale all'apertura alla concorrenza? Di più: quello scambio, invero, *nasce imposto*: se i titolari non si accordano ('liberamente') sulla concessione della licenza, o se poi barano al gioco imponendo condizioni che impediscono l'accesso effettivo dei concorrenti, sarà loro revocata l'attribuzione dello standard. La licenza a condizioni FRAND è dunque sì stipulata privatisticamente, ma sotto una spada di Damocle volta a garantire un'esigenza pubblicistica, ossia un esito pro-concorrenziale.

E così, in ultima analisi, la vicenda SEPs/FRAND si rappresenta, complessivamente come un intervento di stampo (non aggiudicatorio, bensì) intrinsecamente *regolatorio*, che dagli standard nel settore TLC si è *tout court* esteso alle tecnologie essenziali. Un intervento volto insomma a correggere e prevenire situazioni di chiusura monopolistica del mercato che si potrebbero creare se le tecnologie indispensabili e/o insostituibili fossero fruite da uno solo⁽¹⁵⁾. Correzione regolatoria, si ribadisce, cui corrisponde un compenso equo del titolare, al quale non può certo addebitarsi alcun abuso 'primario': avendo anzi realizzato e regolarmente brevettato una invenzione che comporta un tale progresso tecnologico da meritare il riconoscimento come standard⁽¹⁶⁾.

¹³ V. *supra* note 7 e 8.

¹⁴ E in questa stessa concezione contrattuale, l'obbligo imposto al titolare di dichiarare, all'avvio delle negoziazioni, le condizioni di offerta, non corrisponde ad una interferenza antitrust nel potere dispositivo del titolare, bensì all'applicazione di principi di buona fede (oggettiva) propri, appunto, della teoria del contratto, e in particolare, della responsabilità *in contrahendo*.

¹⁵ È, nella sostanza, la prospettiva del 'nostro', art 2597 c.c., ovvero l'obbligo a contrattare del monopolista legale a chiunque lo richieda, osservando parità di trattamento: e qui rileggasi la Relazione del Guardasigilli all'art. cit., al §1046, secondo cui "tal principio si impone a difesa del consumatore come necessario temperamento della soppressione della concorrenza, tenuto conto che il regime di monopolio legale, per ragioni varie e non tutte contingenti va estendendosi molto al di là di quei particolari settori (come i trasporti ferroviari) nei quali tradizionalmente si soleva considerare tale fenomeno". E ciò è peraltro confermato dalla chiara lettera delle Linee direttive della Commissione sugli accordi orizzontali (v. nt. 11), ove sono esigenze primariamente antitrust ad aver imposto il meccanismo degli impegni FRAND.

¹⁶ Il termine di 'abuso', nella limitata cassetta degli attrezzi linguistici dell'antitrust, può solo invocarsi in senso 'secondario' rispetto al rifiuto dell'osservanza dell'obbligo. La situazione evocata è dunque ben distinta da quella di un esercizio intrinsecamente illegittimo del diritto esclusivo – ad esempio, per compartmentare mercati, o imporre prezzi ingiustificatamente alti, ovvero a quella di un illegittimo conseguimento del titolo, come nel caso *AstraZeneca*, oggetto di una nota decisione della Corte di giustizia UE (sentenza del 6 dicembre 2012, C-457/10) ove alla società erano contestate le dichiarazioni mendaci svolte dinanzi agli uffici

2. Un apparente paradosso.

Ad un primo sguardo, quest'ultimo rilievo pare segnalare un esito paradossale: più un'invenzione (o altra forma di innovazione) è considerata di alta qualità, tanto da essere eletta a standard, e dunque tanto più alto il merito del titolare del diritto, meno è probabile che egli possa mantenere intatto il potere escludente di legge, impedendo a terzi non autorizzati di far uso del bene immateriale⁽¹⁷⁾.

Si tratta tuttavia di un paradosso solo apparente. Infatti, la remunerazione derivante da un flusso (potenzialmente illimitato) di *royalties* potrà certamente soddisfare – o addirittura superare, a seconda delle abilità commerciali e del successo dei licenziatari – le previsioni di guadagno del titolare del diritto e, in tal modo, incentivare ulteriori investimenti in ricerca e innovazione. D'altra parte, l'obbligo di corrispondere *royalties* a condizioni FRAND consentirà generalmente al titolare del diritto di conservare un significativo vantaggio competitivo nei confronti dei suoi concorrenti. Costoro sono infatti gravati da costi aggiuntivi, dalla necessità di colmare il *lead time* che li separa dall'innovatore in termini di apprendimento delle tecnologie licenziate, nonché da una conoscenza inferiore della tecnologia, le cui possibili attuazioni potrebbero non esaurirsi in quanto descritto e rivendicato nel brevetto (e anche in termini di *know-how*)⁽¹⁸⁾.

Dal canto suo, in un sistema di licenze FRAND, anche il titolare del diritto potrà avvalersi della possibilità di avere accesso, alle stesse condizioni, alle diverse tecnologie sviluppate dai terzi, eventualmente tramite accordi di licenza incrociati (c.d. *cross-licensing*)⁽¹⁹⁾.

Peraltro, se l'inclusione nello standard e il sistema delle licenze a condizioni FRAND fossero realmente percepiti dai titolari dei diritti come penalizzanti, non si riuscirebbe a comprendere perché questi facciano tanti sforzi – se non addirittura carte false: vedasi il caso

brevettuali allo scopo di ottenere un illegittima estensione dell'esclusiva brevettuale: qui sì vi è un abuso 'primario', rispetto alla cui commissione l'idea stessa del compenso è incompatibile, per non dire surreale.

¹⁷ Rileva il paradosso, in senso critico, G. COLANGELO, *Il mercato dell'innovazione: brevetti, standards e antitrust*, in *Quaderni di Giurisprudenza Commerciale*, 397, 2016, 64 ss.

¹⁸ Sotto un diverso profilo, la prassi commerciale seguita nella determinazione di una licenza a condizioni FRAND spesso implica anche l'onere del licenziatario di comunicare informazioni commerciali riservate (quantità e prezzi delle vendite, fornitori, clienti, ecc.).

¹⁹ Anche al di là delle disposizioni relative alle licenze obbligatorie per le innovazioni dipendenti di alto profilo ai sensi dell'art. 31, lett. l), TRIPs e dell'art. 71 c.p.i..

Rambus (²⁰) – per far sì che la loro tecnologia sia eletta a standard (²¹). Il fatto è che essi si battono – lo si ribadisce – per diventare *percettori garantiti di flussi indeterminati di royalties* (²²).

3. Il nocciolo della questione, oggi: definire le royalties FRAND. Proposta di tre criteri cumulativi.

L'orientamento pro-concorrenziale sopra descritto con riferimento all'UE è condiviso, nei suoi tratti fondamentali, anche negli Stati Uniti, nonché in altri ordinamenti – come quello cinese ed indiano – coinvolti nello sviluppo di standard tecnologici, specialmente nel settore ICT (²³).

²⁰ Il comportamento di Rambus, che aveva omesso di dichiarare l'essenzialità dei propri brevetti al gruppo di standardizzazione JEDEC, impegnato nello sviluppo delle specifiche SDRAM e DDR SDRAM, è passato al vaglio di autorità antitrust e tribunali, sia in Europa, sia negli Stati Uniti, con esiti contrastanti. La Commissione UE, con decisione del 9 dicembre 2009, *Rambus*, COMP/38636, C(2009) 7610, accettava gli impegni proposti da Rambus, secondo cui la società “*agrees not to charge [any royalty] for the SDRAM and DDR standards that were adopted by JEDEC during the time in which Rambus was a member and engaged in its allegedly intentional deceptive conduct*” e “*commits to a maximum royalty rate of 1,5 % for the later generations of standards adopted by JEDEC after Rambus' resignation*” (par. 55). Negli Stati Uniti, invece, la decisione dell'FTC che accettava la violazione dello Sherman Act da parte di Rambus è stata poi ribaltata dalla Court of Appeals (D.C. Circuit), con sentenza del 22 aprile 2008 (522 F.3d 456) sulla base del fatto che, l'FTC avrebbe “*expressly left open the likelihood that JEDEC would have standardized Rambus's technologies even if Rambus had disclosed its intellectual property. Under this hypothesis, JEDEC lost only an opportunity to secure a RAND commitment from Rambus. But loss of such a commitment is not a harm to competition from alternative technologies in the relevant markets*”.

²¹ Cfr. *infra*, note 33 e 35.

²² Si aggiunga peraltro che il sistema FRAND può essere apprezzato anche sotto un altro profilo. Di fatto, il potere di esclusione proprio del titolare di brevetto è conservato (salvo il caso dei più irriducibili *free rider*) solo con riferimento ad innovazioni “nella media”, vale a dire quelle che superano il test di non ovvietà ma non si qualificano per il premio Oscar: l'elezione a standard. La saggezza implicita in tale “discriminazione” è evidente. Evitando di generalizzare un obbligo di concedere licenze per nuove tecnologie, il sistema scoraggia un generalizzato atteggiamento di c.d. *path-dependance* da parte dei futuri concorrenti. Infatti, come illustrato dalla Corte di giustizia UE: “*se il semplice fatto di detenere diritti di proprietà intellettuale potesse costituire di per sé una giustificazione obiettiva del rifiuto di concedere una licenza, la deroga individuata dalla giurisprudenza non verrebbe mai applicata. In altri termini, un rifiuto di dare in licenza un diritto di proprietà intellettuale non potrebbe mai essere considerato come violazione dell'art. 82 CE, mentre nelle sentenze Magill e IMS Health [...] la Corte ha dichiarato esattamente il contrario*”, cfr. sentenza *Microsoft*, (nt. 7), par. 690.

²³ A tal proposito, si deve ricordare la decisione più influente, nel panorama italiano, in materia, ovvero l'ordinanza Trib. Milano, 5 gennaio 2012, in *Giur. ann. dir. ind.*, 2014, 6069, ove la presidente Tavassi ha chiarito che “*il diritto di vietare ai terzi l'accesso alla propria tecnologia ha subito nel tempo sempre maggiori restrizioni. È infatti oramai principio acquisito che, nei settori della tecnica per i quali si richieda un certo livello di dialogo [...] sorga l'esigenza di assicurare l'interscambiabilità tra i prodotti medesimi [...]. Lo strumento con cui tale interscambio può essere assicurato è quello della licenza*”. Quanto poi alle Corti e autorità statunitensi, esse si sono contraddistinte anzitutto per aver proposto, tra le prime, un “*anti-injunction approach*” ovvero l'orientamento secondo cui l'aver sottoscritto impegni FRAND sarebbe incompatibile con la richiesta di inibitoria dell'attività del (presunto) contraffattore che sia disposto a concludere un accordo di licenza (il “*willing licensee*” di cui si è detto); e ciò in una linea ideologica risalente alla sentenza *eBay* della Supreme Court e, in particolare, alla *concurring opinion* del giudice Kennedy: cfr. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006). Come esempio di tale “*approach*” – per tutti – si veda la sentenza del giudice Posner (poi parzialmente riformata in sede di appello) nel caso *Apple Inc. v. Motorola Inc.*, 869 F.Supp.2d 901, 911 (N.D. Ill. 2012): “*I don't see how, given FRAND, I would be justified in enjoining Apple from infringing [the patent] unless Apple refuses to pay a royalty that meets the FRAND requirement. By committing to license its patents on FRAND terms, Motorola committed to license [the patent] to anyone willing to pay a FRAND royalty and thus implicitly acknowledged that a royalty is adequate compensation for a license to use that patent. How could it do otherwise? How could it be permitted to enjoin Apple from using an invention that it contends Apple must use if it wants to make a cell phone with UMTS telecommunications capability—without which it would not be a cell phone?*” (p. 18). Inoltre, le Corti statunitensi per prime hanno proposto una determinazione numerica delle royalty FRAND. Si veda l'altrettanto nota decisione del giudice Robart (lo stesso che ha bocciato il funesto “*muslim ban*” dell'ultimo successore di Abramo Lincoln), nel caso *Microsoft*.

Nella sostanza, dunque, il cuore dell'attenzione di giudici e studiosi (così come dei pratici) si è oggi spostato: dall'affermazione di un obbligo di concedere licenza sulle tecnologie 'essenziali' – ormai acquisito – alla necessità di definire se tali licenze siano conformi o meno ai principi FRAND.

A questo proposito, ragioni di coerenza con l'intrinseco fondamento pro-concorrenziale dell'obbligo di concedere licenza, richiedono che i criteri seguiti per la determinazione di una licenza a condizioni FRAND riflettano a loro volta un bilanciamento pro-concorrenziale dei configgenti interessi in gioco: vale a dire, da un lato, il diritto dei titolari ("innovators") ad una remunerazione adeguata (²⁴) e, dall'altro, il diritto dei licenziatari ("implementers") ad ottenere condizioni di accesso che consentano un'effettiva competitività sul mercato.

Tali criteri dovrebbero preferibilmente essere incorporati in disposizioni normative, o perlomeno in linee guida emanate da autorità indipendenti – come quelle *antitrust* – e possibilmente fatti propri da convenzioni internazionali (²⁵). E comunque essere incorporati nelle *policy* delle SSO. Questo per evitare che i parametri stessi da seguire per la determinazione di licenze a condizioni FRAND (anche al di là delle possibili asimmetrie di forza contrattuale delle parti) siano primariamente rimessi a negoziazioni private o a decisioni di singoli casi al di fuori di una linea sistematica di riferimento: così correndo il rischio di

Corporation v. Motorola, Inc., No. C10-1823 JLR, 2013 (W.D. Wa. 25 aprile 2013). In essa il giudice Robart ha operato una scelta nell'ambito di un *range* di possibili soluzioni FRAND: approccio qui condiviso (vedi ancora infra par. 3, nel testo, e nota 27, con riferimento alla diversa impostazione da ultimo adottata dal giudice inglese Briss). Per una rassegna sugli orientamenti della giurisprudenza e dalle autorità indiane, note per le politiche industrialistiche particolarmente attente ai diritti umani: cfr. R. Viswanath, *Demystifying the Indian FRAND Regime: The Interplay of Competition and Intellectual Property*, in *Journal of Intellectual Property Rights*, Vol. 21, 2016, p. 90-94. Per l'esperienza cinese si vedano, invece, Y. B. Li, *Antitrust Correction for Qualcomm's SEPs Package Licensing and Its Flexibility in China*, in IIC, 2016, 3, 336; J. Lee, *Implementing the FRAND Standard in China*, in *Vand. J. Ent. & Tech. L.*, 2016, vol. 19, 1, 37; D. Sokol, W. Zheng, *FRAND in China*, in *Tex. Intell. Prop. L.J.*, 2014, vol. 22, pag. 71. Infine, per un'ampia ed aggiornata analisi comparata degli orientamenti statunitensi, europei ed asiatici, si rinvia qui alla recente monografia di G. Colangelo, (nt. 17), pp. 279 e ss. Vedi ancora la ricognizione di B. Lundqvist, *'The rise of standardisation and the limits to self-governance': unilateral conduct under international standards from an EU competition law perspective*, in T. Riis (ed.), *User Generated Law*, Cheltenham, Edward Elgar, 2016, 180.

²⁴ Si noti: adeguata e *non* massimizzata. L'espressione è suggerita, come indicazione di portata generale, dalla Corte di giustizia UE, sentenza del 4 ottobre 2011, *Premier League*, C-403 e 429/08, ECLI:EU:C:2011:631, par. 108 e 109, secondo cui: "l'oggetto specifico della proprietà intellettuale non garantisce ai titolari dei diritti interessati la possibilità di chiedere il più alto compenso possibile. Infatti, in considerazione di tale oggetto, quel che è loro garantito – come previsto dal decimo 'considerando' della direttiva sul diritto d'autore e dal quinto 'considerando' della direttiva sui diritti connessi – è solamente un compenso adeguato per ogni utilizzazione degli oggetti protetti". Nonostante la sentenza si riferisca alla remunerazione dei diritti nel contesto dei diritti d'autore e diritti connessi, non v'è ragione per ritenere che non si tratti di un principio generale che concerne tutti i diritti di proprietà industriale ed intellettuale. Peraltro, spunti analoghi erano già stati fatti propri dalla Corte di giustizia in casi aventi ad oggetto brevetti per invenzione, cfr. sentenza del 14 luglio 1981, C-187/80, *Merck/Stepbar*, par. 9-10 (ove: "la sostanza del diritto di brevetto consiste essenzialmente nell'attribuzione di un diritto esclusivo di prima messa in circolazione del prodotto [...]che] riservando all'inventore il monopolio di sfruttamento del prodotto, gli consente di ottenere la ricompensa per il suo sforzo creativo, senza tuttavia garantirgliela in qualsiasi circostanza"); cfr. anche Corte Giust. UE, 5 dicembre 1996, C-267/95 e C-268/95, *Merck/Primercrown*, par. 31.

²⁵ Nettamente contrari a quest'impostazione, soprattutto in una prospettiva di diritto dell'Unione Europea, parrebbero R. JACOB, A. MILNER, *Lessons from Huawei v. ZTE*, 2016, 12-14, nello studio pubblicato per 4iP Council, reperibile in internet al seguente indirizzo: <http://www.4ipcouncil.com/research>. Gli Autori, facendo riferimento alla Comunicazione della Commissione del 19 aprile 2016 in tema di "ICT Standardisation Priorities for the Digital Single Market" sottolineano che un intervento della Commissione orientato alla re-interpretazione della decisione *Huawei/ZTE* sarebbe superfluo, e che gli aspetti rimasti irrisolti anche a seguito di tale decisione sarebbero meglio affrontati dai tribunali degli Stati Membri.

metter capo ad un costume d'Arlecchino. Il che sarebbe in contrasto con le congiunte esigenze di affidabilità, trasparenza e armonizzazione del regime dell'innovazione standardizzata, internazionale per vocazione⁽⁶⁾.

D'altra parte, è appena il caso di precisare che il presente contributo non intende certo proporre alcuna 'formula magica', valida universalmente nella determinazione di *royalties* rispettose dei principi FRAND. Il concetto stesso di 'ragionevolezza' della licenza, infatti, è espressione di una clausola generale, per ciò stesso elastica. La nostra ricerca è volta piuttosto all'individuazione di un *range* – potenzialmente ampio – di schemi di licenza che, pur diversificati, siano però coerenti con l'equilibrata ispirazione pro-concorrenziale poc'anzi evocata. E tra essi incomberà anzitutto alle parti di scegliere, per negoziare una soluzione condivisa. In difetto di che la scelta – sempre all'interno di quel *range* – sarà compiuta da Corti o Autorità di regolazione del mercato⁽⁷⁾.

Di seguito presentiamo alcuni criteri a nostro avviso adeguati a tale obiettivo. Sono tre, formulati in senso progressivo e proposti per una applicazione congiunta⁽⁸⁾.

4. Primo criterio. Precisa identificazione della tecnologia adottata dai potenziali licenziatari e stretta proporzionalità della licenza.

Giurisprudenza e dottrina parrebbero talora dare per scontato che ogni brevetto dichiarato essenziale a uno standard è utilizzato – e dunque potenzialmente violato – da ciascun prodotto conforme a tale standard⁽⁹⁾. L'assunto pare fondato sul sillogismo secondo cui: siccome (i) il brevetto è stato dichiarato essenziale a uno standard; e (ii) il prodotto è

²⁶ Infatti, una piena armonizzazione in materia di standard potrebbe prevenire il rischio di conflitti di orientamento e di giudicato tra diverse regioni del mondo, dovuti a motivi di carattere 'tecnico' (considerata la varietà e le diverse caratteristiche delle SSO) o alimentati da conflitti geopolitici.

²⁷ Così anche un recente studio del Joint Research Center presso la Commissione Europea, a cura di C. Pentheroudakis, J. A. Baron, *Licensing Terms of Standard Essential Patents. A Comprehensive Analysis of Cases*, in *JRC Science for Policy Report*, EUR 28302 EN, <https://ec.europa.eu/jrc/en/publication/eur-scientific-and-technical-research-reports/licensing-terms-standard-essential-patents-comprehensive-analysis-cases>, 13, secondo cui: "Further developing FRAND as a regulatory instrument for the future of SEP licensing requires that we understand and acknowledge that FRAND, by design and by necessity, defines a ranges – not a rate". Diversa impostazione (almeno *e verbis*) appare posta a fondamento della recentissima decisione *Unwired Planet v. Huawei* [2017] EWHC 711 (Pat), del 5 aprile 2017, che si segnala per essere la prima decisione di una corte europea ad affrontare il calcolo delle royalties FRAND. In essa il giudice Briss, impone "una terza via" di fairness rispetto a quelle ritenute dalle parti, affermando – con un accento dal sapore intrinsecamente regulatory – che "There is only one set of license terms which are FRAND in a given set of circumstances [...]. That may the FRAND undertaking can be enforced".

²⁸ Nel prosieguo, ci si concentrerà sugli aspetti essenzialmente monetari dei contratti di licenza a condizioni FRAND, vale a dire sui criteri appropriati per determinare il valore del brevetto e la ragionevole remunerazione per il suo titolare. Tuttavia, vale la pena di notare che i contratti di licenza includono un'ampia varietà di clausole che dovranno essere tenute in considerazione per valutare il rispetto delle regole FRAND (ad esempio: durata, diritto di recesso, clausole risolutive, clausole di riservatezza, ambito territoriale, retrocessioni e simili) che non sono oggetto del presente contributo.

²⁹ In questo senso sembrano orientate alcune decisioni della giurisprudenza italiana: ad es. Trib. Genova (ord.), 8 maggio 2004, *Koninklijke Philips Electronics N.V. contro Computer Support Italcard s.r.l.*, in *Giur. ann. dir. ind.* 2006, 4949; Trib. Milano, 8 maggio 2008, *Itatel S.p.A. contro Sisvel e altri*, reperibile su *darts-ip.com*; Trib. Trieste, 23 agosto 2011, in *Giur. ann. dir. ind.* 2013, 5951. Il medesimo assunto sembra riscontrarsi anche in M. FRANZOSI, *Royalty per uso di brevetto standard: but for, Georgia Pacific, apportionment*, in *Riv. dir. ind.*, 2015, I, 259. *Contra*, Trib. Milano, 21 settembre 2016, in *IPLens*, reperibile in internet al seguente indirizzo: <https://iplens.org/2017/03/31/the-court-of-milan-says-that-standard-essential-patents-may-be-only-optionally-implemented-in-compliant-products/>.

conforme allo standard; allora (*iii*) quel prodotto deve *necessariamente* attuare la tecnologia brevettata⁽³⁰⁾.

Tuttavia il sillogismo è viziato da una mancata comprensione dei meccanismi di standardizzazione tecnologica. Semplicemente non corrisponde al vero che *tutti* i brevetti dichiarati essenziali a uno standard siano necessariamente violati da *tutti* i prodotti conformi ad esso. In altri termini, non si dà luogo ad alcuna contraffazione automatica o presuntiva⁽³¹⁾. E ciò per tre ragioni, relative alla validità dei brevetti, alla loro essenzialità e, soprattutto, all'esistenza di elementi *opzionali* in molti standard.

Innanzitutto, i brevetti possono essere invalidi o non essenziali. Da un lato, il numero di brevetti ‘robusti’, ossia in grado di sopravvivere a un’azione di invalidità, è notoriamente esiguo. Se la dottrina ha suggerito che, in alcuni ordinamenti, la maggior parte dei brevetti concessi sarebbe almeno parzialmente invalida⁽³²⁾, i dati relativi ai brevetti essenziali confermerebbero che ciò rappresenta un problema esacerbato nel contesto delle tecnologie standardizzate⁽³³⁾. D’altro canto, la dichiarazione di essenzialità che i titolari di SEP rilasciano alle SSO è un atto unilaterale che nella maggior parte dei casi non è verificato dall’organizzazione. Ad esempio, la guida esplicativa della *IPR Policy* adottata dall’ETSI chiarisce che l’ente “*has not checked the validity of the information, nor the relevance of the identified*

³⁰ Una recente pubblicazione di M. RATO, M. ENGLISH, *An Assessment of Injunctions, Patents, and Standards Following the Court of Justice’s Huawei/ZTE Ruling*, in *J. of European Comp. Law & Practice*, 2015, 7, suggerisce che la Corte di giustizia UE avrebbe dato per presupposta una sorta di contraffazione automatica nella sentenza *Huawei/ZTE* (nt. 8). In particolare ove la Corte di giustizia ha osservato: “*il fatto che tale brevetto abbia ottenuto lo status di [brevetto essenziale] comporta che il suo titolare può escludere l’immissione o il mantenimento nel mercato di tali prodotti fabbricati da concorrenti e, quindi, riservare a sé la fabbricazione di tali prodotti*”. A dire il vero, a parziale smentita delle opinioni della dottrina ora menzionata, nella medesima pronuncia la Corte ha riconosciuto che “*il presunto contraffattore non può essere biasimato per il fatto di contestare, parallelamente alle negoziazioni relative alla concessione delle licenze, la validità di tali brevetti e/o il loro carattere essenziale ai fini dell’applicazione di una norma tecnica della quale essi fanno parte e/o il loro effettivo sfruttamento, oppure di riservarsi la facoltà di farlo in seguito*” (par. 69 e *passim*). Si noti tuttavia che la Corte non ha preso in considerazione la potenziale *opzionalità* di una specifica caratteristica tecnica, per la quale cfr. di seguito nel testo.

³¹ Cfr. decisioni menzionate *supra*, nt. 29.

³² Per recenti pubblicazioni e per un dibattito sui dati relativi all’invalidità di brevetti in Germania, vedasi P. HESS, T. MÜLLER-STOY, M. WINTERMEIER, *Are patents merely Paper Tigers?*, 2016, reperibile al seguente indirizzo: http://www.barddehle.com/fileadmin/Papiertiger/_Papiertiger_en.pdf; in risposta, vedasi A. HÜTTERMANN, *Patents – Paper tigers or real tigers?*, in *Mitteilungen der deutschen Patentanwälte*, 2016, 101, reperibile al seguente indirizzo: <http://ssrn.com/abstract=2773628>. Commenti e richiami ad entrambi i lavori possono essere reperiti sul blog *The IPKat*, <http://ipkitten.blogspot.com/>. Per altro verso, il numero delle domande di brevetto depositate all’anno è in costante crescita, come testimoniato, ad esempio dalle statistiche EPO relative all’ultimo quinquennio, reperibili al seguente indirizzo: <http://www.epo.org/about-us/annual-reports-statistics/annual-report/2015/highlights.html>. Cfr. anche, per una prospettiva più ampia sulla ‘qualità’ delle domande di brevetto in Europa, R. HILTY, *The role of patent quality in Europe*, in J. DREXI, ET AL. (ed.), *Technology and Competition, contributions in honour of Hanns Ullrich*, Bruxelles, Larcier, 2009, p. 91. Da ultimo, tuttavia, si segnala un interessante studio empirico di G. DE RASSENFOSSE, A. B. JAFFE, E. WEBSTER, *Low-Quality Patents in the Eye of the Beholder: Evidence from Multiple Examiners*, 2017, reperibile al seguente indirizzo: <https://ssrn.com/abstract=2807141>, che giunge a conclusioni opposte: “*The results suggest that quality in patent systems is higher than previously thought; in particular the percentage of ‘weak’ patents is in single digits for all offices, although the U.S. patent office’s performance is poorer than those of Europe and Japan*”.

³³ Nel 2013 Kang e Bekkers hanno vagliato le strategie brevettuali dei partecipanti agli incontri di standardizzazione del gruppo 3GPP, riscontrando un elevato numero di domande brevettuali “*just-in-time*”, ossia depositate subito prima o durante tali incontri da imprese verticalmente integrate. Il che, a detta degli Autori, lascerebbe intendere uno scarso ‘valore’ delle domande e una più alta probabilità di una loro invalidazione o di un diniego di concessione: cfr. B. KANG, R. BEKKERS, *Just-in-time patents and the development of standards*, in *Research Policy*, 2015, 44, 1948.

patents/patent applications to the ETSI standards and cannot confirm, or deny, that the patents/patent applications are, in fact, essential, or potentially essential”⁽³⁴⁾. Per queste ragioni, il fenomeno della c.d. “*over-disclosure*” – vale a dire la rivendicazione di essenzialità per brevetti non essenziali – è ritenuto piuttosto diffuso, perlomeno nel settore ICT⁽³⁵⁾.

Nondimeno, tali considerazioni non sono di grande aiuto nella determinazione di criteri generali di valutazione dei canoni di licenza FRAND: i brevetti concessi si presumono validi e, per quanto ci è dato di sapere, nessuna delle principali SSO verifica l'essenzialità dei brevetti dichiarati tali rispetto allo standard. Per contro, si dovrebbe rivolgere l'attenzione alle caratteristiche proprie degli standard tecnologici, specialmente nel settore ICT.

Gli standard sono complessi insiemi di regole. Sono soggetti a continui aggiornamenti e modifiche da parte di gruppi di lavoro ed esperti tecnici. Per esempio, il noto standard 3G/UMTS per le telecomunicazioni mobili è stato perfezionato tramite numerose versioni successive (le c.d. “*release*”) e conta centinaia di specifiche tecniche – documenti analitici riferiti ad un particolare elemento o funzione del sistema. A loro volta, le specifiche tecniche sono periodicamente aggiornate, anche più volte per ciascuna nuova versione ‘generale’ dello standard⁽³⁶⁾. Per effetto di una siffatta incessante attività, gli standard tipicamente includono numerose caratteristiche tecniche opzionali⁽³⁷⁾.

Le caratteristiche tecniche di uno standard possono essere opzionali almeno sotto tre profili⁽³⁸⁾. In primo luogo, alcune caratteristiche tecniche possono riguardare solo uno degli

³⁴ ETSI *Guide on Intellectual Property Rights (IPRs), Version adopted by Board #94 on 19 September 2013*, in *ETSI Directives*, versione 35, dicembre 2015, 63, reperibile al seguente indirizzo: https://portal.etsi.org/directives/35_directives_dec_2015.pdf; La Guida ETSI è un documento che fornisce ulteriori informazioni e chiarimenti per l'applicazione della *Policy* dell'istituto in materia di DPI. Cfr. anche la sentenza *Huawei/ZTE*, (nt. 8), paragrafi 20 e 69.

³⁵ Così ad esempio lo studio commissionato dalla Commissione Europea alla Fraunhofer Gesellschaft: K. BLIND ET AL., *Study on the Interplay between Standards and Intellectual Property Rights (IPRs)*, Relazione Finale, aprile 2001, reperibile all'indirizzo http://www.iplytics.com/download/docs/studies/ipr_study_final_report_en.pdf, 63 ss.. Ad analoghi risultati hanno condotto gli studi di Fairfield Resources International sugli standard 3G, GSM, WDCMA e LTE dal 2005 al 2010, dove la società ha esaminato i brevetti dichiarati essenziali per tali standard e valutato che la percentuale complessiva di brevetti essenziali/probabilmente essenziali oscillava tra il 30 e il 50% (cfr. <http://www.frlicense.com/recent.html>). Indagini simili sono state realizzate anche dal Cyber Creative Institute con riferimento allo standard LTE, laddove la percentuale di brevetti realmente essenziali veniva valutata intorno al 50% (cfr. <http://www.cybersoken.com/en/research/lte/>).

³⁶ La prima versione dello standard UMTS è stata pubblicata come “*Release '99*” all'inizio degli anni 2000. Da allora, sono state pubblicate le *release* da 4 a 9, al ritmo di circa una nuova *release* ogni anno. Quanto alle specifiche tecniche, si prenda ad esempio la TS 25.223 “*Spreading and modulation (TDD)*”, aggiornata in sei versioni consecutive nel contesto della sola *release* 4 (v. versione 4.1.0, 4.2.0 etc., in <http://www.3gpp.org/DynaReport/25223.htm>). Lo standard UMTS si è poi evoluto nello standard LTE, per il quale sono state predisposte le *release* da 10 a 14. L'industria ICT è ora concentrata sullo sviluppo degli standard 5G. Per ulteriori informazioni riguardanti il *Third Generation Partnership Project* (3GPP) si veda: <http://www.3gpp.org/>.

³⁷ La IPR Policy ETSI, (nt. 3), all'art. 15, n. 11, nel definire il concetto di standard, concede che esso “*shall mean any standard adopted by ETSI including options therein or amended versions*”. K. BLIND ET AL., (nt. 35), 65, suggeriscono la presenza di diversi standard che prevedono caratteristiche opzionali, tra cui lo standard UMTS e che questo fattore comporta fisiologicamente anche un aumento del novero dei titolari di brevetti essenziali. Si veda anche il contributo di J. P. KESAN, C. M. HAYES, *FRAND's Forever: Standards, Patent Transfers, and Licensing Commitments*, in *Indiana L. J.*, 89, 2014, 241 ss., in cui è introdotto e approfondito il concetto di brevetti *non-core essential*, cioè di brevetti essenziali in relazione a caratteristiche opzionali.

³⁸ Gli esempi che seguono sono suggeriti anche in un recente studio della Commissione UE, *Patents and Standards, A modern framework for IPR-based standardization, Final Report*, 2014, 115-116, reperibile al seguente indirizzo: <http://ec.europa.eu/growth/industry/intellectual-property/patents/standards/>.

elementi di un determinato sistema standardizzato. Ad esempio, le parti dello standard riguardanti i dispositivi mobili potrebbero non regolare il funzionamento dell'infrastruttura della rete, e viceversa. In secondo luogo, una caratteristica tecnica aggiunta in una specifica versione dello standard, pubblicata dopo che diversi prodotti sono entrati sul mercato, non sarà necessariamente attuata da tali prodotti anteriori. In terzo luogo, una caratteristica dello standard può essere opzionale nel senso che il produttore è libero di decidere, sin dal principio, se attuare o meno tale tecnologia, senza con ciò intaccare l'interoperabilità del prodotto.

Se una specifica caratteristica dello standard è opzionale, ne consegue che ogni brevetto dichiarato essenziale con riferimento a tale caratteristica è attuato solo potenzialmente.

Le considerazioni ora svolte sono preliminari alla determinazione stessa di un obbligo di concedere licenza – e dunque si pongono ben prima della definizione dell'entità della *royalty FRAND*. In breve: se un prodotto non applica una determinata tecnologia coperta da brevetto, perché mai il titolare dovrebbe percepire un corrispettivo per il suo (non) utilizzo?! Cionondimeno l'aspetto dell'opzionalità tecnica è spesso messo in secondo piano nel corso delle trattative negoziali tra *implementers* e *innovators*.

D'altro canto, l'opzionalità di un elemento dello standard, di per sé, non pregiudica la possibilità che il relativo brevetto sia effettivamente essenziale. Il brevetto in questione potrà ben essere essenziale, ma solamente in relazione a quell'elemento opzionale. Ciò è espressamente confermato, ad esempio, dalle *Bylaws* dello *Standard Board* dell'*Institute of Electrical and Electronics Engineers* (di seguito “*IEEE*”), una delle più grandi e influenti SSO al mondo, secondo cui “*Essential Patent Claim* shall mean any Patent Claim the practice of which was necessary to implement either a mandatory or optional portion of a normative clause of the IEEE Standard”³⁹. Secondo uno studio del 2013, sette tra le più importanti SSO nel mercato contemplano espressamente le parti opzionali degli standard nella definizione di essenzialità⁴⁰.

Alla luce di quanto sopra esposto, il primo passo nella determinazione di *royalty FRAND* dovrebbe essere quello di attenersi al principio di *stretta proporzionalità*: solo quando l'interferenza è tale in concreto – di modo che il brevetto essenziale è o almeno potrebbe essere contraffatto dal prodotto del concorrente – il terzo sarà gravato dall'obbligo di corrispondere una *royalty FRAND* al titolare. E, simmetricamente, solo quando il brevetto essenziale è effettivamente utilizzato (o contraffatto, che dir si voglia) il corrispettivo per il suo uso potrà essere considerato equo e ragionevole.

Tale valutazione *in concreto* dovrà essere svolta con riferimento a tutte le caratteristiche tecniche opzionali dallo stesso titolare del brevetto essenziale, prima di qualsiasi richiesta di corrispettivo. Il titolare è infatti probabilmente l'unico soggetto con una conoscenza dei brevetti e dello standard in questione adeguata allo scopo. Più precisamente: all'avvio delle negoziazioni il titolare del brevetto essenziale dovrà (*i*) fornire al potenziale licenziatario tabelle di raffronto tra le rivendicazioni del brevetto e lo standard, le c.d. *claim-charts* (o analoghe documentazione), che illustrino come il suo titolo possa essere ‘letto’ nella specifica tecnica

³⁹ IEEE, *IEEE-SA Standards Board Bylaws*, dicembre 2016, 15, reperibile al seguente indirizzo: <http://standards.ieee.org/develop/policies/bylaws/index.html>.

⁴⁰ R. BEKKERS, A. UPDEGROVE, *IPR Policies and Practices of a Representative Group of Standards-Setting Organizations Worldwide*, 2012, p. 58, reperibile al seguente indirizzo: <http://ssrn.com/abstract=2333445>. Tuttavia, gli autori rendono noto che vi sono altre SSO che non fanno menzione di distinzioni tra elementi obbligatori, opzionali e alternativi. Cfr. anche in *Microsoft v. Motorola*, (nt. 23), p. 40 “Importantly, however, because an ‘essential’ patent is one that is necessary to implement either an optional or mandatory provision of a standard, a specific SEP may contribute greatly to an optional portion of a given standard, but if that portion is not used by the implementer, the specific SEP may have little value to the implementer”.

dello standard; *(ii)* valutare se tali specifiche tecniche costituiscono parti obbligatorie ovvero opzionali dello standard in questione; e *(iii)* nel caso in cui si tratti di porzioni opzionali dello standard di riferimento, dimostrare che i prodotti del potenziale licenziatario le attuino⁽⁴¹⁾.

In quest'ultimo caso, tuttavia, il titolare del brevetto essenziale non sarà tenuto a fornire prova piena dell'effettiva utilizzazione ai fini della conclusione di un accordo di licenza. Ciò costituirebbe verosimilmente un onere eccessivo per il titolare: come base per la fase negoziale saranno più che sufficienti elementi di prova *prima facie* dell'essenzialità e dell'interferenza. I potenziali licenziatari saranno quindi nella condizione di poter confutare – si noti: prontamente⁽⁴²⁾ – tali elementi di prova, dimostrando che il brevetto (o i brevetti) in questione non sono attuati nei loro prodotti.

5. Secondo criterio. Quantificazione ex-ante delle royalty: il valore del brevetto prima della fissazione dello standard.

Una volta individuata la tecnologia essenziale di cui il potenziale licenziatario fa effettivamente uso, deve essere determinato il valore dei brevetti che su tale tecnologia insistono.

Il processo di selezione della tecnologia che sarà parte dello standard svolge un ruolo fondamentale nella creazione del suo valore. In genere, prima dell'adozione di uno standard più alternative tecniche rivolte sostanzialmente alle stesse funzionalità concorrono tra loro. Accade spesso, così, che diverse soluzioni ad uno stesso problema tecnico siano valutate e confrontate dai membri della SSO sulla base della loro qualità, del loro costo e del valore aggiunto che apportano allo standard.

Tuttavia, quando lo standard è definito, i titolari dei brevetti aventi ad oggetto le tecnologie selezionate vedranno il valore e il potere di mercato dei loro diritti di proprietà industriale crescere esponenzialmente. Questo perché tali brevetti, a questo punto essenziali, verranno utilizzati – nei limiti dell'opzionalità di cui si diceva – da ogni *implementer*. Ciò ha portato dottrina e giurisprudenza a considerare il rischio che i titolari di brevetti essenziali ai quali molti concorrenti *dovranno* ottenere accesso siano indotti a ‘far leva’ (nel gergo del settore: “*hold-up*”) sui loro concorrenti con richieste di licenze anti-competitive, accompagnate da minacce di azioni inibitorie in caso di mancata accettazione delle proposte contrattuali⁽⁴³⁾.

⁴¹ Anche la sentenza Huawei/ZTE sembra suggerire criteri di stretta proporzionalità e collocare l'onere della prova in capo al titolare di SEP, affermando che prima di intentare azione per ottenere una misura inibitoria il titolare di brevetto dovrà “*avvertire il presunto contraffattore della contraffazione ad esso addebitata, indicando tale SEP e specificando il modo in cui esso è stato contraffatto*”, cfr. Huawei/ZTE, (nt. 8), par. 61.

⁴² I potenziali licenziatari hanno infatti – a loro volta – l'obbligo di evitare qualunque tattica dilatoria rispetto alla conclusione del contratto di licenza a condizioni FRAND, come ora espressamente sancito in Huawei/ZTE, (nt. 8), par. 65.

⁴³ La teoria dell'*hold-up* – e cioè, nelle parole del Giudice Robart “*the ability of a holder of an SEP to demand more than the value of its patented technology and to attempt to capture the value of the standard itself*”, in *Microsoft v. Motorola*, (nt. 23), 21 – è stata ampiamente discussa in dottrina. Tuttavia un'analisi approfondita di tale dibattito fuoriesce dall'ambito del presente contributo. Per la bibliografia essenziale in merito si faccia riferimento all'esaustiva rassegna di J. CONTERAS, *Patents, Technical Standards and Standards-Setting Organizations: A Survey of the Empirical, Legal and Economics Literature*, in corso di pubblicazione, 2015, reperibile all'indirizzo <http://ssrn.com/abstract=2641569>, p. 13. Diversi autori hanno peraltro messo in evidenza anche i rischi della “resistenza” alle richieste dei titolari, ponendo le basi per l'analisi del *reverse hold-up* – vale a dire il comportamento degli *implementers* che intendono pagare *royalty* minime o che non intendono pagare affatto, forti di un potere di mercato e della disponibilità dei mezzi finanziari per far fronte ad eventuali azioni giudiziarie. Per una rassegna dei contributi in questo senso v. J. CONTERAS, *Patents, Technical Standards and*

Al contrario, i brevetti che non sono stati inclusi nello standard potranno rivelarsi privi di valore commerciale, specialmente nel caso in cui non vi sia alcun mercato per tecnologie diverse da quella standardizzata⁽⁴⁴⁾.

In un simile contesto, l'opinione maggioritaria di giuristi ed economisti ritiene che una *royalty* ragionevole dovrebbe limitarsi a riflettere il valore del brevetto in sé, e non il valore potenzialmente associato alla sua inclusione nello standard⁽⁴⁵⁾. Swanson e Baumol sono stati tra i primi a suggerire, nel 2005, che “*the concept of a ‘reasonable’ royalty for purposes of RAND licensing must be defined and implemented by reference to ex ante competition, i.e. competition in advance of the standard selection*”⁽⁴⁶⁾. Alcuni anni dopo, Lemley e Shapiro hanno ribadito che “*by construction, the reasonable royalty rate does not include the value attaching to the creation and adoption of the standard itself. To allow the patentees to capture that value, which flows from the collective adoption decisions of the group rather than from the underlying value of the technology chosen, would undermine the goals of the FRAND commitment*”⁽⁴⁷⁾. Analoghi orientamenti *ex ante* sono stati proposti dalla

Standards-Setting Organizations: A Survey of the Empirical, Legal and Economics Literature, 13. Secondo P. BATISTA, G. MAZUTTI, *Comment on “Huawei Technologies” (C-170/13): Standard Essential Patents and Competition Law – How Far Does the CJEU Decision Go?*, in IIC, 2016, vol. 47, 249, il ‘galateo’ previsto dalla sentenza Huawei/ZTE avrebbe minimizzato sia il rischio di *hold up*, sia quello di *reverse hold up*.

⁴⁴ Da una riflessione di H. HOVENKAMP, *Competition in Information Technologies: Standard-Essential Patents, non-practicing entities and FRAND bidding*, in *University of Iowa Legal Studies Research Paper*, n. 12-32, 2012, reperibile in internet al seguente indirizzo: <http://ssrn.com/abstract=2154203>, 12.

⁴⁵ Tra cui T. COTTER, *The Comparative Law and Economics of Standard Essential Patents and FRAND Royalties*, in *Texas Intellectual Property Law Journal*, vol. 22, 2014, 311, reperibile in internet al seguente indirizzo: http://scholarship.law.umn.edu/faculty_articles/237. Si segnala poi che Autorevole dottrina, pur aderendo in via di principio alla correttezza di tale impostazione *ex ante*, sottolinea come “*it is difficult, if not impossible, for a court to determine ex post how valuable a given patent would have been in the ex ante world in which the standard was formed*”: J. LERNER, J. TIROLE, *Standard-Essential Patents*, in *Journal of Political Economy*, 2015, vol. 123, n. 3, p. 548, reperibile al seguente indirizzo: <http://www.journals.uchicago.edu/doi/citedby/10.1086/680995>. V. anche le sentenze *Microsoft v. Motorola* e *Apple v. Motorola*, già citate (nt. 23) in precedenza.

⁴⁶ D. SWANSON, W. BAUMOL, *Reasonable and Nondiscriminatory (RAND) Royalties, Standards Selection, and the Control of Market Power*, in *Antitrust Law Journal*, vol. 73, 2005, 10.

⁴⁷ M. LEMLEY, C. SHAPIRO, *A Simple Approach to Setting Reasonable Royalties for Standard-Essential Patents*, in *Berkeley Technology Law Journal*, vol. 28, 2013, 1148.

Federal Trade Commission⁽⁴⁸⁾, dalla Commissione Europea⁽⁴⁹⁾ e, più di recente, nelle stesse *Bylaws* dello Standard Board dell'IEEE⁽⁵⁰⁾.

La definizione delle royalty FRAND secondo il principio *ex ante* richiede che il valore della licenza sia parametrato al corrispettivo che il titolare del brevetto avrebbe potuto ragionevolmente ottenere – in condizioni di libera concorrenza – all'esito di un'ipotetica contrattazione con il potenziale *implementer* appena prima dell'elezione a standard della tecnologia in questione. L'adozione dello standard, invece, corrisponde al momento *ex post*, in cui il brevetto è stato incluso nello standard e ha potenzialmente acquisito un notevole valore di mercato (se non è divenuto, addirittura, un fattore costitutivo di posizione dominante). L'assunto alla base di una simile posizione è che solo una *royalty ex ante* rifletterebbe il valore intrinseco del brevetto in un mercato competitivo⁽⁵¹⁾.

⁴⁸ FTC, *The Evolving IP Marketplace, Aligning Patent Notice and Remedies with Competition*, 2011, p. 193, reperibile all'indirizzo <https://www.ftc.gov/reports/>, suggerisce che “Courts should apply the hypothetical negotiation framework to determine reasonable royalty damages for a patent subject to a RAND commitment. Courts should cap the royalty at the incremental value of the patented technology over alternatives available at the time the standard was defined”.

⁴⁹ Comunicazione della Commissione – Linee direttive sull'applicabilità dell'articolo 101 del Trattato sul Funzionamento dell'Unione europea agli accordi di cooperazione orizzontale, cit., la quale propone che “[i]n caso di controversia, per valutare se i canoni applicati per l'accesso al DPI nel quadro della definizione delle norme non sono né equi né ragionevoli occorrerà determinare se il canone richiesto è ragionevole in relazione al valore economico dei DPI (1). In generale, esistono vari metodi per effettuare tale valutazione. [...], è possibile confrontare i canoni di licenza applicati dall'impresa interessata per i brevetti in questione in un ambiente concorrenziale prima che il settore fosse vincolato ad uno standard (*ex ante*) con quelli applicati dopo che il settore è stato vincolato (*ex post*). Questo metodo presuppone che il confronto possa essere effettuato in modo coerente e affidabile”. A questo proposito, l'approccio della Commissione Europea potrebbe persino risultare più cauto nei confronti del principio di determinazione della *royalty ex ante*, come può suggerisce l'indicazione che i canoni di licenza *ex ante* ed *ex post* applicati dal titolare del brevetto debbano essere comparati tra loro. Più di recente, anche il sopramenzionato report del JRC presso la Commissione UE ha ribadito il *favor* nei confronti della determinazione *ex ante* (e, si noti, per tutta l'ampiezza di significato di questa locuzione): cfr. C. PENTHEROUDAKIS, J. A. BARON (nt. 27), 125 ss..

⁵⁰ IEEE Standard Board *Bylaws*, (nt. 39), p. 16: “Reasonable Rate' shall mean appropriate compensation to the patent holder for the practice of an Essential Patent Claim excluding the value, if any, resulting from the inclusion of that Essential Patent Claim's technology in the IEEE Standard”.

⁵¹ Si rileva inoltre che diversi contributi teorici che adottano l'approccio *ex ante* osservano che la *royalty* ragionevole relativa ad un SEP dovrebbe essere fissata – come valore massimo – al *valore incrementale* del brevetto in questione rispetto alla sua “*next-best alternative*” prima della standardizzazione. Vedasi M. LEMLEY, C. SHAPIRO, (nt. 47), 1148. Più precisamente J. FARRELL, J. HAYES, C. SHAPIRO, T. SULLIVAN, *Standard Setting, Patents, and Hold-Up*, in *Antitrust Law Journal*, vol. 74, 2007, p. 611 e ss. definiscono il “*valore incrementale*” – e dunque la loro posizione teorica sull'argomento – mediante il seguente esempio: “consider the choice between a patented production technology and an unpatented alternative. The two technologies yield the same output, so the technology user simply seeks to minimize cost. Suppose that the patented technology requires the user to bear costs of \$40, not including any royalty, and the alternative technology requires the user to bear costs of \$50. The user would be willing to pay a royalty of up to the patented technology's inherent advantage of \$10. This inherent advantage typically allows the patent holder profitably to charge a positive price (more generally, a price above marginal cost), perhaps \$6 in this example”. Tale somma (\$ 10) dovrebbe costituire l'indice di riferimento della massima *royalty* ragionevole conformemente ai principi FRAND.

Se i principi generali sottesi all'approccio *ex ante* sono piuttosto intuitivi, nella loro (possibile) applicazione pratica sono tuttavia emerse numerose difficoltà e altrettante critiche alla solidità teorica di un siffatto approccio (cfr. J. FAULL, A. NIKPAY, *The EU Law of Competition*, III ed., Oxford, Oxford University Press, 2014, par. 4.775-4.780). In particolare, alcuni hanno sostenuto che fissare il livello massimo del tasso FRAND al valore incrementale del SEP, anche se teoricamente fondato, può essere privo di “*real-world applicability*”: cfr. *Microsoft v. Motorola*, (nt. 23), 26. Altri hanno sostenuto che limitare la remunerazione del titolare al valore incrementale del brevetto avrebbe l'effetto sostanziale di minare gli investimenti compiuti da quest'ultimo e scoraggiare in futuro un'ulteriore partecipazione al processo di fissazione dello standard.

Quanto alla prima obiezione, il prerequisito per determinare il valore incrementale di una tecnologia rispetto alla “*next-best alternative*” è che ci fosse, in principio, un'alternativa disponibile. Mancando una valida

A nostro avviso, il principio di definizione *ex ante* rappresenta l'indicazione fondamentale per determinare una licenza conforme alle condizioni FRAND. Pare infatti assolutamente centrale alla *ratio* del sistema che la *royalty* ragionevole rispecchi il valore intrinseco del brevetto prima che esso acquisisca l'inevitabile (e potenzialmente ‘ricattatorio’) potere che segue alla sua inclusione nello standard.

6. Terzo criterio. Considerazione del quadro complessivo delle licenze FRAND: il problema del royalty stacking.

La determinazione dei diritti di licenza deve anche tenere conto del quadro complessivo delle licenze che gravano sul singolo *implementer*.

Nel contesto della fissazione degli standard, in particolare nel settore ICT, uno stesso prodotto fa spesso uso di tecnologie coperte da centinaia, se non migliaia, di brevetti essenziali (⁵²). Ne consegue che gli *implementer* sono generalmente obbligati a pagare *royalties* a diversi *innovator*. Ignorare questo fattore potrebbe rendere possibile un cumulo di canoni di licenza – il cosiddetto “*royalty stacking*” – il cui totale potrebbe superare una ragionevole quota del valore e del prezzo del bene: così di fatto impedendo all’*implementer* l’ingresso (o la sopravvivenza) sul mercato.

Diversi autori invero sottolineano il rischio che vi siano serie probabilità che gli *implementer* siano gravati da richieste di *royalty* accumulate. Una ricerca del 2014, per esempio, ha stimato che le *royalties* relative ad uno *smartphone* offerto al pubblico a 400 dollari ammontano, in

alternativa, si potrebbe mettere in dubbio che il criterio del “valore incrementale” possa continuare a reggere. In dottrina è stato altresì osservato che “*if two technologies have different values it is not clear whether they actually qualify as true alternatives. Moreover, assessing the value of technologies is an inherently subjective task*” (D. GERADIN, *Pricing abuses by essential patent holders in a standard-setting context: A view from Europe*, relazione predisposta per la Conferenza *The Remedies for Dominant Firm Misconduct* 4-5 giugno 2008 – University of Virginia, reperibile all’indirizzo: <http://ssrn.com/abstract=1174922>) e che i fattori da prendere in considerazione sarebbero troppo complessi per una valutazione affidabile (A. LAYNE-FARRAR, G. LLOBET, *Moving beyond simple examples: Assessing the incremental value rule within standards*, in *Int. J. of Ind. Org.*, vol. 36, 2014, 57).

Quanto alla seconda obiezione, diversi autori hanno messo in dubbio il valore incrementale sotto un profilo concettuale. Geradin, per esempio, ha sostenuto che, anche assumendo che sia possibile calcolare il valore incrementale, a causa del modello economico sottostante “*the royalty rate that would emerge from this ex post evaluation of the rate that would have prevailed ex ante could indeed be equal to – or at least near – zero*”. Tale valore prossimo allo zero, tuttavia, non rifletterebbe l’esito della concorrenza tra alternative tecnologiche. In un mercato competitivo i prezzi non sarebbero infatti formati sulla base del valore incrementale di un prodotto rispetto ad un altro prodotto. L’autore osserva, con un esempio di comprensione immediata: “*if customer A buys shampoo X rather than shampoo Y, which is a close alternative, A will not pay the incremental value between X and Y, but rather the full price of X, ostensibly reflecting the average value of using shampoo X (however constrained by competition from Y)*”, in D. GERADIN, cit., 18; nello stesso senso anche J. SIDAK, *The Meaning of FRAND, Part I: Royalties*, in *J. of Competition Law & Economics*, 9(4), 972 e 984. Inoltre, secondo Geradin, un tasso di *royalty* che è stato limitato al valore incrementale della tecnologia standardizzata spesso non riuscirebbe a compensare adeguatamente il titolare di SEP: v. D. GERADIN, cit..

⁵² All’ultima consultazione, del 17 febbraio 2016, il database dell’ETSI riferisce di 201.405 brevetti dichiarati essenziali, riferiti a 373 progetti sviluppati dall’ente. Di questi brevetti sarebbero proprietarie 243 imprese (cfr. <https://ipr.etsi.org/>). Altre fonti suggeriscono una cifra compresa tra 100.000 (A. ITALIANER, *Shaken not stirred. Competition Law Enforcement and Standard Essential Patents*, relazione tenuta a Bruxelles, 21 aprile 2015, reperibile all’indirizzo: http://ec.europa.eu/competition/speeches/text_sp2015_03_en.pdf) e 345.000 SEPs [M. FRANZOSI, (nt. 29), p. 262].

media, a 120 dollari: vale a dire al 30% del prezzo di vendita del prodotto. Una cifra non molto distante dal costo delle componenti fisiche del dispositivo stesso⁽⁵³⁾.

La giurisprudenza statunitense ha da tempo riconosciuto la possibilità che si verifichino casi di *royalty stacking* e le criticità ad esso associate. Con la nota decisione resa nella controversia tra *Microsoft* e *Motorola* nel 2013, il Giudice Robart della *United States District Court* di Seattle ha affermato che “*a proper methodology for determining a RAND royalty should address the risk of royalty stacking by considering the aggregate royalties that would apply if other SEP holders made royalty demands of the implementer*” e che il rischio di *royalty stacking* debba essere tenuto in considerazione dai titolari di SEP nella determinazione di una licenza FRAND⁽⁵⁴⁾. Nello stesso senso si sono poi espresse la Commissione Europea⁽⁵⁵⁾, la Federal Trade Commission⁽⁵⁶⁾ e, di recente, dalla *Competition Commission of India* (CCI), la quale ha posto in rilievo il fatto che “*FRAND licenses are primarily intended to prevent patent hold up and royalty stacking*”⁽⁵⁷⁾.

Cionondimeno, numerosi autori hanno contestato i fondamenti della teoria del *royalty stacking*. In primo luogo, essa non terrebbe adeguatamente in considerazione l’impatto ‘riduzionario’ di prassi comuni come il *cross-licensing*, la possibilità che le esclusive brevettuali non siano fatte valere nei confronti di terzi e le dinamiche di mercato riscontrate nella realtà, che porterebbero a penalizzare gli *innovators* che avanzino richieste di *royalty* eccessive. In secondo luogo, parte della dottrina ha sottolineato come non vi sia prova dell’esistenza del fenomeno del *royalty stacking*, o perlomeno non vi siano dati sufficienti ad accertare la presenza di un serio rischio per la collettività⁽⁵⁸⁾. Si tratterebbe quindi di un falso problema.

Prendendo posizione nel dibattito, la *Court of Appeals for the Federal Circuit* in *Ericsson v. D-Link* ha recentemente osservato che, seppur il *royalty stacking* possa costituire un problema per i licenziatari di brevetti essenziali, questi ultimi devono in ogni caso dare prova di un effettivo cumulo di *royalties* (nel testo della decisione: “*actual evidence of [...] stacking*”), che non può essere semplicemente presunto sulla base di considerazioni di carattere generale⁽⁵⁹⁾.

⁵³ A. ARMSTRONG, J. MUELLER, T. SYRETT, *The Smartphone Royalty Stack: Surveying Royalty Demands for the Components Within Modern Smartphones*, reperibile all’indirizzo: <http://ssrn.com/abstract=2443848>. Si noti che il contributo prende in considerazione il valore offerto e nominale delle licenze in oggetto, e dunque non tiene conto di alcuna concreta contrattazione (per quanto verosimile possa essere) tra le parti.

⁵⁴ *Microsoft c. Motorola*, (nt. 23), par. 72; più recentemente ripresa anche dal giudice Holderman in *In re Innovatio IP Ventures, LLC Patent Litigation*, 2013 WL 5593609 (N.D. Ill. 3 ottobre 2013).

⁵⁵ Y. MÉNIÈRE, *Fair, Reasonable and Non-Discriminatory (FRAND) Licensing Terms, Research Analysis of a Controversial Concept*, pubblicazione del Joint Research Centre della Commissione, <http://is.jrc.ec.europa.eu/pages/ISG/EURIPIDIS/documents/05.FRANDreport.pdf>.

⁵⁶ Si veda lo studio condotto dal Department of Justice e la FTC, *Antitrust Enforcement and Intellectual Property Rights: Promoting Innovation and Competition*, Washington, 2007, 61.

⁵⁷ Per esempio, *Competition Commission of India*, decisione del 12 maggio 2015, *Best IT World (India) Private Ltd. v. Telefonaktiebolaget LM Ericsson*, 4/2015, 5, <http://www.cci.gov.in/May2011/OrderOfCommission/261/042015.pdf>.

⁵⁸ Per un recente esempio: J. SIDAK, *Apportionment, FRAND Royalties, and Comparable Licenses After Ericsson v. D-Link*, reperibile in internet al seguente indirizzo: <https://www.criterioneconomics.com/apportionment-frand-royalties-comparable-licenses-ericsson-dlink.html>; vedasi anche D. GERADIN, M. RATO, *Can Standard-Setting lead to Exploitative Abuse? A Dissonant View on Patent Hold-Up, Royalty Stacking and the Meaning of FRAND*, in *European Competition Journal*, vol. 3, 1/2007; K. GUPTA, *The patent policy debate in the high-tech world*, in *Journal of Competition Law & Economics*, 2013, 827; da ultimo, GALETOVICY, K. GUPTA, *Royalty Stacking and Standard Essential Patents: Theory and Evidence from the World Mobile Wireless Industry*, working-paper, giugno 2016, reperibile in internet al seguente indirizzo: http://www.law.northwestern.edu/research-faculty/searlecenter/events/innovation/documents/Galetovic_Royalty_stacking_060416_GG.pdf.

⁵⁹ Cfr. *Ericsson v. D-Link*, 773 F.3d 1201 (Fed. Cir. 2014), pp. 54 e 55: “*Certainly something more than a general argument that these phenomena are possibilities is necessary*”: “*The mere fact that thousands of patents are declared to be*

In definitiva, l'esistenza, la diffusione e le problematiche connesse ad un rischio di *royalty stacking* non hanno raccolto un consenso unanime tra gli accademici e gli operatori del settore. Da un lato, se centinaia, quando non migliaia, di brevetti possono riguardare il medesimo prodotto, il *royalty stacking* è – a dir poco – probabile. Dall'altro, vi possono certamente essere casi in cui il rischio di un cumulo di *royalties* viene neutralizzato (mediante *cross-licensing*, prezzi ribassati, esaurimento dei diritti brevettuali, e così via) o è assente.

Nondimeno, a parere di chi scrive, il verificarsi del *royalty stacking* è del tutto inconciliabile con il concetto stesso di FRAND in tutti i casi in cui ciò determini la corresponsione di licenze che minimizzano o eliminano ogni profitto sul prodotto che fa uso dello standard. Non può ritenersi equo e neppure ragionevole che il sommarsi dei diritti di licenza renda la commercializzazione di prodotti conformi allo standard antieconomica o non remunerativa⁽⁶⁰⁾. Peraltro, come giustamente osservato da Lemley e Shapiro, l'esistenza di un *royalty stacking* potrebbe render ancora più serio il problema dell'*hold up* brevettuale, moltiplicando le probabilità che un *implementer* debba fronteggiare azioni di contraffazione e richieste di prezzi superiori al livello concorrenziale⁽⁶¹⁾.

Per neutralizzare un simile rischio, le parti coinvolte nella contrattazione dovranno quindi prendere in considerazione i quadri complessivi delle licenze, e basarsi sui dati disponibili per la definizione delle *royalties*: le trattative non avvengono nel vuoto⁽⁶²⁾. Si consideri poi che numerosi standard – soprattutto quelli di più alto valore economico e tecnologico – sono in corso di elaborazione da molti anni e che, anche in caso di sviluppo e modifica, tali evoluzioni avvengono in modo graduale. Ne consegue che le parti coinvolte nelle trattative per una licenza FRAND avranno verosimilmente un certo grado di conoscenza del quadro complessivo di *licensing*, conoscenza che – nel caso – potrebbe essere sufficiente per individuare il rischio di *stacking*.

In caso contrario, ove non fossero disponibili informazioni di tal genere, le parti potranno delineare una licenza *prima facie* FRAND, possibilmente corredata da una clausola di adeguamento in caso di mutamento significativo delle circostanze⁽⁶³⁾. Ancora una volta, le *Bylaws* recentemente aggiornate dell'IEEE costituiscono un ottimo esempio, ove suggeriscono che la determinazione della licenza ragionevole dovrà ricoprendere “*the value that the Essential Patent Claim contributes [...], in light of the value contributed by all Essential Patent Claims for the same IEEE Standard practiced in that Compliant Implementation*”⁽⁶⁴⁾

essential to a standard does not mean that a standard-compliant company will necessarily have to pay a royalty to each SEP holder”.

⁶⁰ A. LAYNE-FARRAR, *The Economics of FRAND*, in D. SOKOL (a cura di), *Antitrust Intellectual Property and High Tech Handbook*, Cambridge, Cambridge University Press, in corso di pubblicazione.

⁶¹ Cfr. M. LEMLEY, C. SHAPIRO, *Patent Holdup and Royalty Stacking*, in *Texas Law Review*, vol. 85, 2007, 1991.

⁶² L'espressione è mutuata dal giudice Robart che, proprio in tema di *royalty stacking* (seppur nella prospettiva del licenziatario) ha osservato: “*the hypothetical negotiation almost certainly will not take place in a vacuum: the implementer of a standard will understand that it must take a license from many SEP owners, not just one, before it will be in compliance with its licensing obligations and able to fully implement the standard*” (pag. 32).

⁶³ Si suggerisce, inoltre, che un primo rimedio contro il *royalty stacking* sarebbe rappresentato dallo sviluppo, da parte delle SSO, di migliori sistemi informativi che consentirebbero agli sviluppatori di farsi un'idea dei SEP aventi ad oggetto la parte di standard in considerazione: si pensi al sito *web* dell'ETSI *ipr.etsi.org*. Ciò potrebbe velocizzare ricerche incrociate mediante le quali i potenziali sviluppatori potrebbero disporre – sin dal principio – di informazioni generali circa il contesto dei brevetti essenziali su una determinata tecnologia, essendo così in grado di negoziare più efficacemente. Allo stesso tempo, la possibilità di avere velocemente una visione d'insieme dello scenario dei brevetti essenziali relativi ad una porzione dello standard non costituirebbe un onere eccessivo in caso di negoziazione di un portafoglio di brevetti.

⁶⁴ *IEEE-SA Standards Board Bylaws*, (nt. 39), p. 16.

Infine, pare opportuno fare un cenno alla possibilità che, per risolvere il problema del *royalty stacking* in radice, si possa fare ricorso ad un ‘*cap*’: un tetto massimo complessivo dei canoni di licenza che possono essere imposti all’*implementer*. Tale soluzione è stata spesso prospettata in dottrina: da ultimo si ricorda un recente scritto del Prof. Franzosi, che adatta il principio dell’*apportionment* alle dinamiche dei brevetti essenziali, proponendo un calcolo della royalty per il singolo titolo a partire da una royalty totale (si legga: un ‘*cap*’) sull’intero prodotto, la quale debba essere poi ripartita (appunto: *apportioned*) tra segmenti tecnici del prodotto, e infine suddivisa per il numero di brevetti afferenti a tale segmento⁽⁶⁵⁾.

Nella giurisprudenza statunitense e, in particolare, nella sentenza *In re Innovatio* il giudice Holderman – richiamandosi ai principi di *Microsoft v. Motorola* – ha adottato il c.d. metodo “*top down*” che, prendendo seriamente in considerazione i rischi di *royalty stacking*, “best approximates the [F]RAND rate that the parties to a hypothetical ex ante negotiation would have agreed upon”⁽⁶⁶⁾. Il metodo “*top down*” considera innanzitutto il prezzo medio del prodotto che utilizza il brevetto (nel caso di specie: un chip per la connessione Wi-Fi). Con riferimento al prezzo medio, è poi calcolato il margine di profitto medio che il produttore genera dalla vendita di ogni prodotto, così isolando la porzione di profitto su cui l’*implementer* sarebbe in grado di corrispondere royalties: ovvero vi è la determinazione di un ‘*cap*’. Il profitto medio così individuato è poi moltiplicato per il rapporto tra i brevetti oggetto di causa e il numero totale di brevetti dello standard in questione. Inserendo in questo calcolo un fattore ‘qualitativo’, ossia la considerazione che “84% of the value in electronic patents is found in the top 10% of electronic patents”⁽⁶⁷⁾ e valutando che i brevetti essenziali di causa avessero un’importanza da media a moderata per lo standard, e che quindi rientrassero in tale 10%, il Giudice Holderman parrebbe essere riuscito nell’arduo compito di *calcolare* una royalty a condizioni FRAND tenendo in considerazione i principi che abbiamo ora richiamati⁽⁶⁸⁾.

La decisione *Innovatio* – pur se legata ad una fattispecie concreta molto particolare – si segnala quindi per offrire numerosi spunti, teorici e pratici, per un serio bilanciamento degli interessi di *implementers* e *innovators*. E ciò proprio nella prospettiva, auspicata da chi scrive, di un calcolo che faccia riferimento solo a brevetti effettivamente utilizzati dall’*implementer*, tramite una determinazione *ex ante* del loro valore e tenendo in considerazione il rischio di *royalty stacking*.

⁶⁵ M. FRANZOSI, (nt. 29), 259.

⁶⁶ *In re Innovatio*, (nt. 54), 85.

⁶⁷ *Id.*, 85-86.

⁶⁸ *Id.*, 10 ss. sui principi generali del metodo di calcolo.

BREVI RIFLESSIONI SULLA SENTENZA HUAWEI: VERSO UNA REGOLAZIONE DELLE LICENZE FRAND DI “STANDARD ESSENTIAL PATENTS”

MARIO LIBERTINI*

Sommario: 1. Gli accordi di standardizzazione nel diritto della concorrenza e gli “Standard Essential Patents”. I limiti della soluzione fondata sugli impegni FRAND e l’esigenza di una regolazione del fenomeno. – 2. La sentenza Huawei: un passo nella giusta direzione e i problemi aperti. – 3. La disciplina delle clausole FRAND come problema di diritto positivo.

1. Gli accordi di standardizzazione nel diritto della concorrenza e gli “Standard Essential Patents”. I limiti della soluzione fondata sugli impegni FRAND e l’esigenza di una regolazione del fenomeno.

Una ulteriore riflessione su una sentenza, che ormai è stata oggetto di numerosi commenti, ed è stata anche spesso definita come un *landmark* nella materia, deve cercare di andare oltre la stretta attualità e i normali esercizi di esegeti della decisione; perciò si può anche dare per noto il contenuto della sentenza di cui si tratta¹.

Pertanto, credo che sia opportuno muovere dal tema più generale, nel quale si colloca il caso deciso dalla sentenza, e cioè il tema della disciplina antitrust degli accordi di standardizzazione

* Professore emerito, Sapienza Università di Roma.

¹ Per comodità di lettura, riportiamo qui di seguito il dispositivo della sentenza (Corte di Giustizia UE C-370/13), che ne costituisce anche massima ufficiale:

“L’articolo 102 TFUE deve essere interpretato nel senso che il titolare di un brevetto essenziale ai fini dell’applicazione di una norma tecnica stabilita da un organismo di normalizzazione, che si sia irrevocabilmente impegnato nei confronti di tale organismo a concedere a terzi una licenza a condizioni eque, ragionevoli e non discriminatorie, dette «FRAND» («fair, reasonable and non discriminatory»), non abusa della sua posizione dominante ai sensi di tale articolo quando esperisce un’azione per contraffazione volta alla cessazione del pregiudizio arreccato al suo brevetto o al richiamo dei prodotti per la fabbricazione dei quali sia stato utilizzato tale brevetto, laddove:

- prima di esperire la suddetta azione, da un lato, abbia avvertito il presunto contraffattore della contraffazione addebitatagli, indicando il suddetto brevetto e specificando il modo in cui esso è stato contraffatto, e, dall’altro, dopo che il presunto contraffattore ha confermato la sua volontà di stipulare un contratto di licenza a condizioni FRAND, abbia trasmesso a tale contraffattore una proposta di licenza concreta e scritta alle suddette condizioni, specificando, in particolare, il corrispettivo e le sue modalità di calcolo, e

- il suddetto contraffattore, continuando a sfruttare il brevetto di cui trattasi, non dia seguito a tale proposta con diligenza, conformemente agli usi commerciali riconosciuti in materia e in buona fede, circostanza che deve essere determinata sulla base di elementi obiettivi ed implica in particolare l’assenza di ogni pratica dilatoria.

L’art. 102 TFUE deve essere interpretato nel senso che, in circostanze come quelle considerate nel procedimento principale, esso non vieta a un’impresa in posizione dominante e titolare di un brevetto essenziale ai fini dell’applicazione di una norma tecnica stabilita da un organismo di normalizzazione, che la stessa impresa si è impegnata, dinanzi a tale organismo, a concedere in licenza a condizioni FRAND, di esperire un’azione per contraffazione contro il presunto contraffattore del suo brevetto e volta alla presentazione dei dati contabili relativi ai precedenti atti di sfruttamento di tale brevetto o al risarcimento dei danni derivanti da tali atti”.

(o “normalizzazione” o anche “normazione”²) produttiva ai sensi dell’art. 101 TFUE e dell’interferenza che tali accordi possono avere con gli istituti della proprietà intellettuale.

E’ noto che, nel diritto della concorrenza, gli accordi di standardizzazione (il cui obiettivo è quello di *“definire requisiti tecnici o qualitativi di prodotti, servizi e processi o metodi di produzione attuali o futuri”*³) sono visti, in linea generale, con favore⁴. Si ritiene infatti che la standardizzazione volontaria (cioè non imposta con vincoli giuridici o di fatto, così che le imprese interessate hanno pur sempre la facoltà di discostarsene⁵) produca effetti economici positivi sotto diversi profili: facilita l’informazione dei consumatori (e con essa il confronto fra prodotti concorrenti), può garantire certi livelli di qualità dei prodotti e, soprattutto, favorisce l’interoperabilità fra prodotti diversi (e, con ciò, la concorrenza su mercati di prodotti complementari), nonché l’integrazione fra diversi mercati⁶.

Da qui la scelta politico-legislativa per cui il fenomeno della standardizzazione di prodotto è oggetto, nel diritto U.E., di una regolazione promozionale (il regolamento in vigore – n. 1025/2012 – fa seguito ad una serie di regolamenti in materia, avviata nel 1989), che si rivolge all’attività delle c.d. *Standard Setting Organizations* (SSO), del loro finanziamento e del loro riconoscimento giuridico. Non si è sentito infatti il bisogno di un regolamento di esenzione per categoria degli accordi di standardizzazione (che pur sono, concettualmente, accordi orizzontali di uniformazione dell’offerta tra imprese concorrenti).

Naturalmente i profili di possibile distorsione della concorrenza non potevano essere completamente trascurati. E’ chiaro infatti che, a fronte degli effetti positivi sopra ricordati, gli accordi di standardizzazione presentano anche alcuni rischi tipici, che la Commissione UE individua nella possibilità che essi creino un ambiente favorevole ad intese accessorie, restrittive “per oggetto” (p.e. uniformazione dei prezzi, discriminazione) e, soprattutto, nella possibilità che diano luogo ad ostacoli all’innovazione futura (in particolare, ostacoli all’affermazione di standard alternativi più efficienti o all’affermazione di innovazioni puntuali non compatibili con lo standard vincente)⁷.

² Quest’ultimo è il termine ufficialmente utilizzato nel Reg. UE/1025/2012, che disciplina l’attività delle organizzazioni che elaborano gli standard. Nel testo si continuerà a preferire, in conformità all’uso dottrinale prevalente, il termine “standardizzazione”.

³ Secondo la definizione della Commissione UE, nella Comunicazione su *Linee direttive sull’applicabilità dell’articolo 101 del trattato sul funzionamento dell’Unione europea agli accordi di cooperazione orizzontale* del 14.1.2011, § 7.1 (n. 257).

⁴ Per una ricca informazione e per ampi riferimenti bibliografici si rinvia a V. TORTI, *Intellectual Property Rights and Competition in Standard Setting. Objectives and Tensions*, Routledge, London – New York, 2016, 48 ss.

⁵ Nel Reg. UE/1025/2012 la “norma” che si inserisce in uno standard è definita come una “*specifica tecnica, adottata da un organismo di normazione riconosciuto, per applicazione ripetuta o continua, alla quale non è obbligatorio conformarsi*”.

Questa connotazione degli standard elaborati dall’autonomia privata rende sfocata la distinzione, frequente in letteratura, fra “*de facto standards*” e “*de iure standards*”. In realtà, quelli che sono classificati come standard *de iure* sono tali perché determinati da un’organizzazione (privata) apposita e non risultanti da semplici prassi di mercato.

Standard tecnici o di qualità possono essere talora anche obbligatori, perché imposti da norme legislative o regolamentari, ma in questo caso si tratta di norme eccezionali (da un punto di vista sistematico) che devono avere una specifica giustificazione in termini di interessi sociali tutelati.

⁶ Cfr. *Linee direttive*, (nt. 2), nn. 263, 308.

⁷ Cfr. *Linee direttive*, (nt. 2), n. 264 e *passim*.

Da qui l'affermazione di principio per cui gli standard (per essere leciti alla stregua delle norme antitrust) da un lato non devono essere obbligatori⁸ e, dall'altro, devono essere aperti all'accesso di qualsiasi operatore interessato⁹.

* * *

Queste indicazioni di principio sono state ritenute da sole sufficienti per garantire la proconcorrenzialità degli standard; e ciò è senz'altro vero per gli standard più tradizionali, attinenti a formati o confezioni di prodotti e non coperti da diritti dominicali (in particolare, non coperti da diritti esclusivi di proprietà intellettuale)¹⁰.

I problemi di politica della concorrenza, posti dagli standard "di prima generazione", sono, dunque, relativamente semplici: in essi gli standard "di compatibilità/interoperabilità" vengono definiti – di norma da un'organizzazione collettiva senza fini di lucro - come "beni pubblici", messi a disposizione di tutti i produttori del mercato e creati al fine di favorire l'interoperabilità dei prodotti; non si pone un problema di diritti dominicali sullo standard.

Qualche problema in più si pone, sotto il profilo del divieto di discriminazione, per gli standard di qualità (marchi di certificazione, indicazioni geografiche protette), in cui l'organizzazione che gestisce lo standard è anche titolare esclusiva di un diritto di proprietà intellettuale e può, in qualche caso, abusarne¹¹. Inoltre, gli standard di qualità, di norma, sono protetti da un diritto di proprietà intellettuale. Si tratta, in questo caso, di proprietà collettiva (p.e. marchi collettivi, indicazioni geografiche), normalmente intestata ad un'organizzazione collettiva di tipo consortile. In tali situazioni, in una prospettiva di tutela della concorrenza si pone comunque, sostanzialmente, solo l'esigenza di rispettare il principio generale di non discriminazione e di prevenire latenti tendenze dell'organizzazione ad andare oltre la funzione di garanzia della qualità per svolgere una vera e propria attività di cartello.

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Già per quanto riguarda gli standard di qualità, l'attenzione per i possibili profili di distorsione della concorrenza dovrebbe essere elevata (più di quanto lo sia tradizionalmente). Lo scenario cambia tuttavia radicalmente quando si delinea, più di recente, il fenomeno della creazione di standard destinati ad essere utilizzati nello sviluppo di settori tecnologicamente avanzati. In questa nuova prospettiva gli standard si presentano come entità in continua evoluzione, tanto che, per designare le organizzazioni preposte alla definizione degli stessi, si tende a parlare non più soltanto di *Standard Setting Organizations* (SSO), ma anche di *Standard Developing Organizations* (SDO). La novità più significativa è però costituita dal fatto che questi standard evolutivi di ultima generazione si reggono sull'apporto di una serie di innovazioni tecnologiche incrementali, a loro volta protette da diritti di proprietà intellettuale individuali, di cui sono titolari le singole imprese che contribuiscono all'evoluzione dello standard.

⁸ Cfr. *Linee direttive*, (nt. 2), n. 280 e *passim*, nonché *supra*, nt. 4.

⁹ Cfr. *Linee direttive*, (nt. 2), n. 283.

¹⁰ Per esempio gli attacchi di lampadine o i formati delle bottiglie di vino, ecc. Questi standard non precludono l'adozione di varianti originali da parte di singoli produttori. In certi casi, la presenza di standard differenziati può favorire – in mancanza di divieti – l'immissione sul mercato di prodotti complementari, destinati a favorire l'interoperabilità fra prodotti che utilizzano standard diversi (p.e. le prese universali o i riduttori di formato nell'ambito delle prese elettriche).

¹¹ Mi permetto di richiamare, in proposito, M. LIBERTINI, *I segni geografici protetti: pubblico e privato, protezionismi e concorrenza*, in *A.I.D.A. (Annali Italiani del Diritto d'Autore)*, 2015, 342 ss.

E' intuitivo che i problemi di funzionamento di questi standard di nuova generazione sono molto più complessi di quelli nascenti dagli standard tradizionali. I compiti dell'organismo preposto alla gestione dello standard si ampliano, in una prospettiva di selezione permanente degli apporti migliorativi. Si pone poi il grave problema del coordinamento fra una pluralità di brevetti complementari, che contribuiscono alla costruzione dello standard. Si determina, soprattutto, una situazione in cui lo standard vincente tende ad acquisire una posizione di monopolio di fatto in un certo mercato (di solito un mercato di prodotti ad alto contenuto tecnologico e di grande dimensione economica). I problemi sono dunque ben diversi da quelli posti dagli stessi standard di qualità, che normalmente si inseriscono in mercati in cui vi è concorrenza effettiva fra prodotti di qualità diversa.

La complessità di questi problemi è stata sottovalutata. Gli standard di ultima generazione hanno così goduto del generale *favor* che gli accordi di standardizzazione avevano acquisito nell'esperienza storica precedente¹² (e fin qui può dirsi che la scelta politica è stata giusta, se si tiene conto del successo commerciale e tecnologico che i nuovi standard hanno ottenuto¹³), ma si è trascurato il problema nuovo della disciplina e del coordinamento della pluralità di diritti di proprietà intellettuale.

* * *

Naturalmente, è possibile che la serie di d.p.i. che compongono lo standard sia fatta confluire in capo all'organizzazione che gestisce lo standard medesimo, mediante appositi atti di conferimento o di mandato. In questo modo, la storia delle *Standard Organizations* sembrerebbe destinata ad incontrarsi con quella di un altro fenomeno, di per sé storicamente già formatosi al di fuori degli accordi di standardizzazione, che è quello dei *patent pool*.

Com'è ormai noto, questo tipo di organizzazione è nato in funzione della cooperazione di più imprese in programmi di ricerca e sviluppo volti alla creazione di prodotti innovativi. Il *patent pool* è incaricato della gestione collettiva – non necessariamente sulla base di un titolo proprietario – della serie di brevetti costituenti oggetto dell'accordo cooperativo.

Questi accordi sono stati a loro volta giudicati positivamente, dalle autorità antitrust americane, se e in quanto finalizzati a valorizzare l'impiego integrato di brevetti complementari e non a realizzare una ripartizione del mercato fra brevetti sostitutivi¹⁴. Il giudizio favorevole è stato valorizzato anche dall'analisi economica, che sostiene che la gestione accentrata di un fascio di brevetti conduce a prezzi di licenza più bassi di quanto deriverebbe dalla gestione separata di diritti di esclusiva da parte di diversi titolari degli stessi¹⁵.

¹² N. PETIT, *EU Competition Law Analysis of FRAND Disputes*, in *The Cambridge Handbook of Technical Standardization Law*, J. Contreras ed., Cambridge University Press, 2017 (paper reperibile in S.S.R.N.), scrive che, inizialmente, la Commissione "followed a policy of deference towards SSOs".

¹³ Cfr. sul punto V. TORTI, (nt.4), 194 ss. e *passim*.

¹⁴ Cfr. G. COLANGELO, *Mercato e cooperazione tecnologica. I contratti di patent pooling*, Giuffrè, Milano, 2008; ID., *Il mercato dell'innovazione: brevetti, standards e antitrust*, Giuffrè, Milano, 2016.

¹⁵ Questa tesi, che viene fatta risalire a Cournot, è una costante dei ragionamenti svolti in questa materia.

Una interessante indagine empirica, che ha messo in discussione l'attendibilità della tesi corrente, dimostrando altresì che l'organizzazione interna dei diversi *patent pool* storicamente affermatisi presenta grandi differenze, può leggersi in M. MATTIOLI, *Power and Governance in Patent Pools*, in *Indiana Law School Research Paper*, n. 234, June 3, 2013.

Questa linea di soluzione è stata fatta propria, sostanzialmente, in tutto il mondo¹⁶ e così anche nel diritto europeo: benché il regolamento di esenzione in materia di accordi di trasferimento di tecnologie non parli del fenomeno, contestualmente all'adozione di tale regolamento la Commissione ha pubblicato anche una comunicazione che tratta di *patent pooling* e che, sostanzialmente, ha il contenuto sostanziale di un'esenzione per categoria, tradotta però in uno strumento di *soft law*.

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In effetti, il *patent pool* è sembrato, in un primo momento, lo strumento normale per dare una disciplina soddisfacente al problema degli *Standard Essential Patents* (SEP), cioè di quei diritti di proprietà intellettuale che costituiscono parte integrante di un certo standard, sicché l'ottenimento di licenza sugli stessi diviene una condizione per l'accesso al mercato del prodotto standardizzato¹⁷. In questo modo, anche l'esercizio del potere di licenza dell'organizzazione si può ricondurre, in misura abbastanza lineare, antro l'alveo della disciplina normale del divieto di abuso di posizione dominante (fermo restando, ovviamente, che di posizione dominante si può parlare non per qualsiasi SEP, ma solo per quelli che si inseriscono in standard di successo, che a loro volta acquisiscono una posizione di monopolio di fatto, o quasi, nei rispettivi mercati).

Negli anni più recenti questa corrispondenza biunivoca tra standard di ultima generazione e *patent pool* è però venuta meno, nella prassi. Diverse organizzazioni, fra cui la più importante fra tutte, cioè quella che gestisce gli standard (GSM e suoi sviluppi evolutivi) utilizzati nelle comunicazioni mobili (consorzio ETSI), hanno escluso la gestione accentratata dei diritti di brevetto confluiti nello standard, e si sono limitate a stabilire, come condizione di accesso al consorzio, l'impegno dei titolari dei brevetti a dare licenza, a chiunque ne faccia richiesta, a condizioni *Fair, Reasonable and Non Discriminatory* (c.d. FRAND).

Si è così pensato che questa soluzione normativa (di fonte privata convenzionale) avrebbe dato luogo ad un risultato efficiente di *cross licensing*, fondato sulla libera contrattazione e idoneo a stimolare la diffusione delle innovazioni nel mercato¹⁸, nonché meno costoso di una gestione accentratata¹⁹. Qualcuno ha anche teorizzato che il sistema così creato fornirebbe una soluzione efficiente in termini di *soft law*, favorendo comportamenti cooperativi fra le imprese interessate al funzionamento del sistema stesso, e quindi una soluzione del problema in un quadro di *lex mercatoria*²⁰.

¹⁶ Cfr. WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO), *Patent Pools and Antitrust – A Comparative Analysis*, March 2014.

¹⁷ Così ha funzionato, per esempio, il consorzio per gli standard MPEG, che hanno retto lo sviluppo della tecnologia dei DVD. V., in proposito, J. CONTRERAS, *Fixing Frand: a Pseudo-pool Approach to Standards-based Patent Licensing*, in 79 *Antitrust Law Journal*, 76 (2013).

¹⁸ Cfr. C. SHAPIRO, *Navigating the Patent Thicket: Cross Licenses, Patent Pools and Standard Setting*, in *The Innovation Policy and the Economy*, MIT Press, 2001, I, 130. Questo studio mette peraltro in luce i rischi di incremento dei costi transattivi, indotti dalla soluzione di cui si discute.

¹⁹ Cfr. J. CONTRERAS, (nt. 17), 54, 77. Quest'ultimo argomento può essere abbastanza facilmente ridimensionato se solo si pensa all'elevatissimo costo sociale del contenzioso indotto dalle divergenze nell'applicazione della clausola FRAND.

²⁰ Cfr. N. PETIT, (nt.12), secondo cui questa impostazione starebbe alla base della stessa sentenza Huawei. In realtà, la sentenza tende a stabilire limiti all'applicazione della norma sul divieto di abuso di posizione dominante, sicché appare distante da una logica di *soft law*.

In realtà questa soluzione è nata, con ogni probabilità, dalla preoccupazione delle grandi imprese, titolari dei brevetti più importanti, di non attribuire alla *Standard Setting Organization* troppo potere (potere che sarebbe divenuto incontrollabile da parte di singole imprese, anche grandi, dal momento che le imprese partecipanti allo standard sono in numero molto elevato). Probabilmente ha inciso in modo decisivo la preoccupazione delle grandi imprese verticalmente integrate, che sono fra i protagonisti del settore (accanto però ad altre categorie di imprese, come quelle dei produttori di componentistica e quelle che operano esclusivamente nei mercati a valle dei prodotti finali), di non compiere atti di disposizione dei diritti di brevetto, che potrebbero dar luogo ad effetti di c.d. esaurimento del brevetto stesso, ma di conservare la piena titolarità del brevetto al fine di poterne fare un uso negoziale o conflittuale/strategico nei confronti dei concorrenti²¹.

La Commissione ha assecondato, senza porsi molti dubbi, questo orientamento del mercato. Probabilmente in ciò ha giocato un favore ideologico per le contrattazioni bilaterali, indotto dal clima generale di egemonia della *free market ideology* che ha accompagnato l'affermazione degli standard di ultima generazione, ma certamente avrà avuto il suo peso anche la forza di *lobby* delle maggiori imprese interessate all'applicazione degli standard per la telefonia mobile²².

Così, i SEP hanno avuto una propria disciplina, sempre nella forma di *soft law*, con le Linee Guida in materia di cooperazione orizzontale del 2011. Con riferimento ai fenomeni di cui si tratta la Commissione ha dato alcune indicazioni:

- a) la titolarità di un SEP non significa, di per sé, potere di mercato (“*la questione del potere di mercato può essere esaminata solo caso per caso*”)²³;
- b) tuttavia, l'accordo di standardizzazione che preveda, al suo interno, SEP, deve prevedere, per evitare di incorrere nel divieto di cui all'art. 101 TFUE, sia l'obbligo del titolare di dichiarare preventivamente la qualità di SEP del diritto di cui è titolare, sia l'impegno pubblico del titolare stesso di concedere licenze sul diritto a condizioni *FRAND* (*fair, reasonable and non discriminatory*)²⁴;
- c) non è invece necessario che l'organizzazione si impegni a verificare il rispetto effettivo dell'impegno FRAND da parte dei titolari di SEP²⁵;
- d) la determinazione della *royalty* equa può essere fatta con criteri diversi, ma la Commissione non intende fornire indicazioni a tale proposito²⁶.

* * *

²¹ Cfr. M. LO BUE, *Patent Holdup and Holdout Under the New IEEE's Policy: Are These Breaches of Competition Law?*, in *S.S.R.N.*, 2016, p. 16 e 54-55 del paper.

²² Un'altra spiegazione, avanzata in dottrina [cfr. J. CONTRERAS, (nt. 17), 60, ove indicazioni] è quella che fa capo al ruolo preponderante dei tecnici nelle *Standard Organizations* e all'inclinazione di questi ultimi di non gravare l'organizzazione della soluzione di problemi giuridici ed economici.

²³ Cfr. *Linee direttive*, (nt. 2), n. 269.

²⁴ Cfr. *Linee direttive*, (nt. 2), n. 285.

²⁵ Cfr. *Linee direttive*, (nt. 2), n. 288.

²⁶ Cfr. *Linee direttive*, (nt. 2), n. 290.

Questa linea di soluzione del problema, incentrata su accordi bilaterali (o sulla decisione giudiziaria di controversie bilaterali) ha ricevuto parecchi consensi²⁷, spiegabili – a mio avviso – soprattutto in chiave ideologica (nel senso della fiducia nell’intrinseca razionalità di soluzioni guidate dal mercato, a sua volta inteso come rete di scambi bilaterali).

In realtà, tuttavia, la soluzione di affrontare il problema dei SEP mediante la clausola generale FRAND e la contrattazione bilaterale che su di essa si dovrebbe innestare, presenta delle gravi debolezze:

- I) Sul piano economico, essa dimentica la tesi di Cournot (che, contemporaneamente, era posta a base delle norme e delle elaborazioni dottrinali in materia di *patent pool*²⁸), secondo cui la gestione individuale di più diritti di esclusiva paralleli conduce a prezzi complessivi di licenza più alti di quelli che derivano da una gestione accentrativa.
- II) La deduzione teorica è rafforzata da un’osservazione di buon senso: rispetto a uno standard che, a quanto ci dice la sentenza Huawei, consta di circa 4.200 SEP²⁹, i costi di transazione per la realizzazione di una rete completa di licenze appaiono intuitivamente proibitivi³⁰. Inoltre, ciascuna licenza, per evitare che il fenomeno della stratificazione di brevetti e di relative *royalty* (*patent stacking* e *royalty stacking*) conduca a risultati economicamente insostenibili, dovrebbe prevedere *royalty* di dimensioni davvero minime (risultato che non è semplice da affidare ad una contrattazione bilaterale).
- III) Inoltre, per assicurare l’equità e la ragionevolezza delle *royalty*, si dovrebbero anche prevedere clausole di adattamento delle stesse all’evoluzione dello standard e al peso relativo che i diversi SEP vengono man mano ad acquisire. Ma una simile definizione dinamica è palesemente inadatta ad una gestione bilaterale delle *royalty*.
- IV) Per assicurare il rispetto della parità di trattamento (“non discriminazione”, costituente uno degli elementi costitutivi dell’impegno FRAND) si dovrebbe poi avere un accesso all’informazione su tutte le contrattazioni bilaterali attuate; ma la prassi attuale non prevede doveri di pubblicità che possano agevolare questo controllo sulla non discriminatorietà degli accordi.

²⁷ V. indicazioni in J. CONTRERAS, (nt.17), 55 ss.

²⁸ Da ultimo, sulle ragioni di efficienza che dovrebbero indurre a preferire la gestione in *pool* dei brevetti costituenti uno standard, v. H. DELCAMP, *The Value of Patents and Its Implications for Competition*, in *The Criterion – Journal of Innovation*, 2016, 161 ss.

²⁹ In letteratura [v. J. CONTRERAS, (nt. 17), 61, ove indicazioni] si osserva spesso che solo una parte (stimata in circa il 30%) dei brevetti dichiarati essenziali lo sono effettivamente (o sono ancora effettivamente tali). Questo rilievo è temperato però dalla considerazione che il concetto di “essenzialità” può essere inteso in senso puramente tecnico (e quindi restrittivo) o in senso commerciale (sì da essere comprensivo di *optionals* che tendono a divenire di uso comune) [ivi, 74]. La probabile fondatezza di questi rilievi non inficia comunque l’osservazione generale, per cui il numero di SEP incorporati in un prodotto tecnologicamente avanzato come uno *smartphone* rimane elevatissimo.

³⁰ Cfr. J. CONTRERAS, (nt.17), 72.

V) La clausola FRAND è costruita come una vera e propria clausola generale, cioè come una norma che individua un conflitto d'interessi e un criterio elastico di risoluzione del conflitto stesso³¹, per poi affidare alla contrattazione bilaterale fra le parti, o alla decisione di un terzo imparziale, la costruzione della norma del caso concreto, atta a comporre il conflitto fra le parti in causa³². Ma questo modello di soluzione dei conflitti può ben funzionare nelle situazioni in cui gli interessi in gioco sono limitati e l'individuazione di una regola particolare e concreta può essere necessaria e sufficiente per realizzare una soluzione soddisfacente di un certo conflitto (si pensi, p.e., ad una certa soluzione che definisca i limiti di immissioni da rumore di un fondo rispetto a un altro); non altrettanto può dirsi per situazioni in cui la soluzione di un singolo conflitto è interdipendente da quella di una serie di conflitti analoghi (come, appunto, accade nella gestione di un certo standard produttivo). In una situazione del genere la soluzione dei problemi non può essere affidata a decisioni caso per caso³³, ma richiederebbe una forma di regolazione (o autoregolazione) a carattere

³¹ La vaghezza dei termini contenuti nella clausola FRAND ha dato luogo a ricorrenti critiche dottrinali, fondate sul facile rilievo della incertezza applicativa [v., per tutti, V. TORTI (nt. 4), 94 ss.]. Ma il rilievo, posto in questi termini, è perfino banale (cfr. D.A. CRANE, *Patent Pools, RAND Commitments, and the Problematics of Price Discrimination*, Cardozo School of Law, Working Paper n. 232, April 2008, 21), e potrebbe essere esteso a qualunque clausola generale. Proprio per ciò, il rilievo potrebbe essere smentito dalla esperienza applicativa di numerose altre clausole generali, che hanno dato luogo alla formazione di un diritto giurisprudenziale non meno certo e prevedibile di quello che può derivare da una definizione normativa *ex ante* di una certa materia.

Il punto critico è però che, mentre un certo tipo di conflitti può essere razionalmente affidato alla costruzione progressiva di un *corpus* di precedenti giurisprudenziali, in casi come quello in esame questa modalità di formazione progressiva delle regole non è soddisfacente, perché ciascun conflitto bilaterale è interconnesso con tutta la serie di interessi coinvolti nell'applicazione dello standard.

³² Cfr. M. LIBERTINI, *Clausole generali, principi generali, norme a contenuto indeterminato. Una proposta di distinzione*, in *Riv.crit.dir.priv.*, 2011, 345 ss.

³³ La decisione caso per caso può ancora funzionare (forse) con riferimento alle tradizionali licenze obbligatorie, in cui la negoziazione si pone all'interno di un rapporto bilaterale, in cui si esaurisce l'operazione economica (la licenza di brevetto è lo strumento necessario e sufficiente per entrare nel mercato del prodotto). E' in tale prospettiva che si è formata la prassi di calcolare la *royalty* in una percentuale del prezzo di vendita del prodotto finale. I titolari di SEP tentano di trasportare lo stesso criterio alle licenze dei SEP stessi, ma in questo modo non si tiene conto che qui l'accesso al mercato del prodotto è dato dallo standard nel suo insieme e non dal singolo SEP. Da qui la ragionevolezza di un criterio di definizione della *royalty* fondato sulla *smallest saleable unit*, anziché su una percentuale del prezzo del prodotto finale.

V. però in senso contrario, al termine di un'accurata rassegna della casistica americana (casistica che non si è ancora assestata su un orientamento stabile) D.J. TEECE, E.F. SHERRY, *A Public Policy Evaluation of RAND Decisions in the U.S. Courts*, in *The Criterion - Journal of Innovation*, 2016, 113 ss.

Più in generale, per ampie informazioni sul dibattito americano sul tema v. G. COLANGELO, *Il mercato dell'innovazione*, (nt. 14), 198 ss.

Sulla probabilità di errori legati all'approccio bilaterale ai problemi di applicazione del principio FRAND v., p.e., R. KAPUR, *Standard Essential Patents and their Competition Law Regulation – Discovering the Law, in the Realm of Inventions*, in S.S.R.N., December, 20, 2015, che critica una sentenza dell'Alta Corte di New Delhi (caso *Ericsson v. Micromax*), che ha determinato il livello di *royalty* in una percentuale (da 1,25 a 2%) del prezzo del prodotto finale, senza tenere conto del ruolo svolto dal brevetto in questione nella tecnologia complessiva governata dallo standard. Il livello della *royalty* appare intuitivamente troppo elevato.

permanente³⁴. La dimostrazione di ciò è data anche dalle profonde incertezze sui criteri adottati dalle corti per determinare il livello delle *royalty*³⁵.

In sostanza, i problemi di politica legislativa posti degli standard innovativi e dai SEP si sarebbero dovuti affrontare mediante meccanismi di regolazione appropriati. In tal senso si sono manifestate diverse opinioni dottrinali, anche se poi tra loro differenti in ordine al contenuto regolamentare ritenuto preferibile³⁶. L'approfondimento di questo profilo contenutistico sarebbe, in effetti, del massimo interesse. Allo stato, la soluzione più persuasiva mi sembra quella della gestione collettiva e dinamica dei SEP e dei meccanismi FRAND da parte delle SSO³⁷.

Ciò che invece può essere oggetto di riflessione è se occorra una regolazione pubblica o se possa essere realizzata efficacemente un'autoregolazione dettagliata dei criteri di formazione dei prezzi (e di risoluzione delle dispute) da parte delle stesse SDO.

Un problema, in proposito, è dato dal fatto che tale soluzione presenterebbe forti criticità in ordine alla compatibilità con l'art. 101 TFUE³⁸. Non si tratterebbe però di un problema insuperabile: potrebbe richiedersi, in proposito, una “constatazione di inapplicabilità” dell'art. 101, ai sensi dell'art. 10, Reg. 1/2003/CE (sostanzialmente corrispondente alla “attestazione negativa” della prassi antitrust ante-modernizzazione). Esperienze di questo tipo si sono avviate, in effetti, negli Stati Uniti, con l'adozione, nel 2015, delle linee-guida di *IP Policy* dello IEEE (*Institute of Electrical and Electronic Engineers*), organizzazione titolare di diversi importanti standard; ma l'iniziativa ha suscitato forti critiche da parte delle principali imprese interessate³⁹.

³⁴ Un'opinione opposta a quella accolta nel testo può leggersi in R. JACOB, A. MILNER, *Lessons from Huawei v. ZTE*, in *4iP Council*, October 2016, 2. L'opinione, tuttavia, mi sembra affermata, più che dimostrata.

³⁵ V. *supra*, nt.33.

³⁶ In tal senso v. la matura ricostruzione della problematica da parte di J. CONTRERAS, (nt. 17), secondo cui la SDO dovrebbe avere il potere di fissare l'ammontare aggregato di *royalty* gravante sugli utilizzatori dello standard e di attribuire poi a ciascun titolare di SEP una percentuale del monte complessivo di *royalty*, determinato in base all'importanza relativa dei brevetti apportati allo standard.

Questa soluzione è più radicale – ma anche più convincente, a mio avviso – di un'altra (P. PICHT, *The ECJ rules on standard-essential patents: thoughts and issues post-Huawei*, in *European Competition Law Review*, 2016, 374-5), pur ragionevole e correttamente orientata, che propone di attribuire alla SDO un compito di risoluzione delle controversie fra titolari di SEP e utilizzatori.

Ancora diversa la soluzione proposta da V. TORTI, (nt. 4), incentrata sull'obbligo del titolare del brevetto, che richiede l'inserimento nello standard, di comunicare contestualmente il prezzo massimo e le altre condizioni delle licenza che si impegna a rilasciare ai richiedenti.

E' chiaro comunque che qualsiasi soluzione del tipo di quelle qui richiamate dovrebbe passare attraverso un intervento normativo regolamentare.

³⁷ E' la soluzione proposta da J. Contreras (v. nota prec.).

³⁸ In tal senso lo stesso N. PETIT, (nt. 12), 22, pur essendo fautore della soluzione dell'autoregolazione della materia da parte delle SSO.

³⁹ Sul punto v. l'ampio studio di M. LO BUE, (nt. 21). La regolazione dell'IEEE specifica tanto l'ambito di vincolatività dell'impegno FRAND quanto i criteri di determinazione delle *royalty*. Essa ha ricevuto un assenso preventivo da parte del DoJ (che ha imposto, tuttavia, che i criteri di determinazione delle *royalty* abbiano valore solo di raccomandazione e non impongano un vincolo di presso).

L'a. sostiene ragionevolmente (v., in particolare, p. 39-40) l'opportunità della soluzione – anche in ragione dell'improbabilità, di cui si parla *infra* nel testo, di un intervento regulatorio pubblico - e critica l'idea “purista” secondo cui una regolazione del fenomeno da parte delle SSO realizzerebbe una sorta di cartello fra acquirenti di licenze sui SEP. Non è esatta però l'affermazione dell'a. (p. 31) secondo cui una “*business review letter*”, simile

E' dunque possibile, ed anche auspicabile, che iniziative di questo tipo si affermino anche in Europa. Ma in ogni caso, a fronte di una problematica come quella in discussione, e alla constatazione che meccanismi di autoregolazione non si sono spontaneamente realizzati, si deve confermare che sarebbe stato piuttosto opportuno un regolamento di esenzione per categoria, atto a definire una disciplina regolamentare dei profili concorrenziali degli accordi di standardizzazione, che allo stato non esiste.

Tuttavia, una linea di politica legislativa di questo tipo appare ai più, al giorno d'oggi, anacronistica, perché viviamo un'epoca di crisi generale del normativismo⁴⁰ e di successo del decisionismo e perché i regolamenti di esenzione per categoria sono sostanzialmente considerati strumenti tipici di stagioni passate del diritto antitrust; soprattutto, rimane ancora un tabù l'idea che la politica della concorrenza si debba fare anche con opportune regolazioni di certi problemi che devono essere affrontati con regole generali, e non con negoziazioni o decisioni bilaterali. Questa linea di pensiero anti-regolazione è stata peraltro condivisa anche dalle principali imprese interessate, che hanno ritenuto preferibile la decisione dei conflitti caso per caso rispetto ad una regolazione dettagliata del funzionamento del mercato delle licenze sui SEP⁴¹.

Così, anziché muovere verso una gestione collettiva dei SEP, opportunamente regolata, si è preferito spostare l'approccio antitrust del fenomeno sul terreno, tipicamente sanzionatorio, del divieto di abuso di posizione dominante; con la conseguenza di una moltiplicazione di procedimenti per abuso e dell'accettazione dell'idea di una rete di posizioni dominanti fra loro interferenti⁴².

Si deve subito precisare che questa impostazione non deve apparire, di per sé, eccezionale: l'esperienza dei mercati dell'interconnessione nei servizi a rete (o anche di alcuni fenomeni della distribuzione tradizionale, che hanno indotto a configurare la c.d. dipendenza da

a quella che il DoJ ha rilasciato a favore dell'IEEE, non sarebbe prevista nel diritto antitrust europeo; in realtà, come si dice nel testo, si potrebbe applicare l'art. 10, Reg. 1/2003, purtroppo trascurato nella prassi.

Le reazioni negative, ricordate nel testo, di alcune grandi imprese interessate sono riferite a p. 22 dello studio citato.

⁴⁰ Cfr., per esempio, M.R. FERRARESE, *Promesse mancate. Dove ci ha portato il capitalismo finanziario*, Il Mulino, Bologna, 2017, 33-4.

Con specifico riferimento alla materia trattata nel presente scritto, v., p.e., L. SILVA MORAIS, *Competition in Digital Markets and Innovation. Dominant Platforms and Competition Law Remedies*, in *Concorrenza e comportamenti escludenti nei mercati dell'innovazione*, a cura di G. Colangelo e V. Falce, Il Mulino, Bologna, 2017, 42-3.

⁴¹ Cfr. M. HEIM (vice presidente di Qualcomm), *Antitrust enforcement in innovation industries: SEP cases on the two sides of Atlantic*, in <http://www.eui.eu/Projects/ENTRANCE/Documents>.

⁴² Il punto è ben segnalato da V. MELI, Standard, standardizzazione e applicazione dell'art. 102 TFUE ai conflitti su licenze relative a diritti di proprietà intellettuale, in *Impresa e mercato. Studi dedicati a Mario Libertini*, Giuffrè, Milano, 2015, II, 1100 ss., che sottolinea come "la disciplina dell'abuso di posizione dominante venga qui in realtà utilizzata per risolvere alcuni di quei problemi che la standardizzazione può porre e che la Commissione ha affrontato nelle Linee direttive sugli accordi di cooperazione orizzontale, ma che non è in grado di risolvere con il ricorso all'art. 101 TFEU, che costituisce, in astratto, la via più coerente per affrontare la questione". Subito dopo l'a. aggiunge che "l'utilizzazione della normativa sull'abuso di posizione dominante, rispetto ad un problema che nasce in un contesto cooperativo, ma per il quale l'applicazione della norma sulle intese appare inopportuna o impossibile, si pone come un succedaneo".

In questa analisi puntuale rimane però da spiegare perché l'applicazione della norma sulle intese debba considerarsi inopportuna o impossibile. A mio avviso, la vera ragione è puramente ideologica e consiste – come si accenna nel testo – nella visione dogmatica della disciplina antitrust come disciplina prettamente sanzionatoria.

assortimento) ci mostra altri esempi di “dominanza plurima non collettiva”⁴³. Il punto peculiare, nel fenomeno in esame, è però quello dell’interdipendenza fra una pluralità di d.p.i. e della conseguente difficoltà di conseguire soluzioni soddisfacenti mediante plurime applicazioni del divieto di abuso in una miriade di rapporti bilaterali.

* * *

Risulta abbastanza chiaro, per quanto detto, che lo strumento FRAND bilaterale, per quanto a prima vista suadente, è sostanzialmente inadatto a governare in modo equilibrato ed efficiente i conflitti che sorgono nell’ambito delle *Standard Developing Organizations* con riguardo alla gestione dei SEP⁴⁴.

Ciò è confermato da indagini empiriche, da cui emerge che, nell’esperienza applicativa concreta, gran parte dei SEP sono utilizzati di fatto, dalle imprese interessate, senza la base di specifici accordi di licenza⁴⁵. Si registra dunque un fenomeno di (apparente) *cross-licensing* generalizzato di fatto fra operatori del settore. Di ciò, in particolare, si avvalgono i produttori di componentistica, sfruttando la circostanza che il titolare del brevetto, se dà licenza ad un produttore intermedio, non può limitare – in base al principio dell’esaurimento – la circolazione del prodotto brevettato a valle.

Questo equilibrio precario è però rotto frequentemente dall’insorgere di controversie, che costituiscono probabilmente momenti di uso strategico dei diritti di brevetto in un sistema complessivo di funzionamento del mercato (oligopolistico) su cui non si dispone di informazioni sufficienti. Peraltro, questo fenomeno di tolleranza generalizzata costituisce anche lo sfondo su cui si innestano episodi, non infrequenti, di *patent ambush*.

Paradossalmente, si potrebbe dire che le clausole FRAND non sembrano dare luogo a molti accordi FRAND, ma certamente danno luogo a frequenti controversie sull’applicazione della clausola FRAND⁴⁶⁴⁷.

Questa esperienza conferma come la clausola in questione non fornisca la soluzione al problema della gestione dei SEP, ma costituisca soltanto il punto di partenza di una linea di

⁴³ Ho cercato di segnalare il fenomeno in M. LIBERTINI, *Diritto della concorrenza dell’Unione europea*, Giuffrè, Milano, 2014, 300-1.

⁴⁴ L’inefficienza della linea di soluzione del problema fondata sull’obbligo di licenze FRAND è ora dimostrata, con approfondita trattazione, da V. TORTI, (nt. 4).

⁴⁵ Cfr. J. CONTRERAS, (nt. 17), 62.

⁴⁶ Nella letteratura in materia [cfr. P. PICHT, (nt. 36), 366] si distinguono tre categorie di controversie inerenti i SEP: gli *ambush cases* (in cui il titolare del brevetto non dichiara preventivamente l’essenzialità del trovato e non assume un impegno FRAND, sì che i relativi doveri comportamentali devono desumersi, se del caso, da principi generali); i *portfolio transfer cases* (in cui il titolare attuale del brevetto è un cessionario che, non avendo sottoscritto direttamente l’impegno FRAND, sostiene che questo impegno è soggettivamente limitato al dante causa); le *FRAND disputes* vere e proprie, in cui il titolare del SEP non contesta l’impegno FRAND, ma pretende di esercitare il diritto di esclusiva (e il relativo rimedio inibitorio) fino a quando non sia stato raggiunto l’accordo definitivo con l’aspirante licenziatario.

L’ultima categoria è, ovviamente, la più importante.

⁴⁷ Le cronache recenti ci danno una conferma del fenomeno: BlackBerry, che era un tempo *leader* nel mercato degli *smartphone* ed ora è stata costretta ad abbandonare questo mercato, avrebbe deciso di valorizzare un patrimonio di circa 38.000 brevetti di cui è titolare (e che, evidentemente, ha lasciato utilizzare, negli anni di successo commerciale, senza curare particolarmente i meccanismi di licenza), avviando una serie di negoziazioni e di conflitti giudiziari in materia (A. MARUCCIA, *Blackberry e il nuovo business dei brevetti*, in *Punto informatico*, 12 agosto 2016). L’illazione sembra confermata dalla notizia – riportata da tutti gli organi di informazione a metà febbraio 2017 – di un’azione legale avviata da BlackBerry contro Nokia per la violazione di 11 brevetti.

soluzione del problema stesso, che dovrebbe realizzarsi mediante un'apposita attività di regolazione, lasciando solo uno spazio finale e di dettaglio a meccanismi di risoluzione di controversie bilaterali.

Alcune indagini empiriche sembrano dimostrare che il sistema, in realtà, si sarebbe assestato su un equilibrio accettabile, per quanto riguarda il livello di *royalty* pagate dai fabbricanti dei prodotti finali (che risulterebbe circa il 5% del prezzo del prodotto finale stesso, e renderebbe improbabile il rischio di *royalty stacking*)⁴⁸. Ciò non toglie che l'elevata quantità di controversie dimostri l'esistenza di forti cause di instabilità, che continuano a far pensare che la soluzione appropriata del problema avrebbe richiesto l'adozione di un regolamento di esenzione per categoria, contenente la previsione e la definizione dettagliata di un regime di gestione accentratamente sui SEP, o almeno una più precisa definizione dei criteri di determinazione quantitativa delle *royalty*, nonché regole procedurali atte a guidare sia la negoziazione bilaterale sia la risoluzione dei conflitti.

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2. La sentenza *Huawei*: un passo nella giusta direzione e i problemi aperti.

A fronte di queste lacune, la sentenza *Huawei* rappresenta un episodio di supplenza, da parte della Corte di Giustizia, ad un'attività regolatoria della Commissione che finora è mancata. La sentenza infatti, più che presentarsi come decisione di un concreto conflitto d'interessi fra due specifici operatori, detta una precisazione, in termini generali e astratti (cioè sostanzialmente normativi), sul modo in cui deve operare la clausola FRAND nelle negoziazioni bilaterali⁴⁹.

La pronuncia della Corte era ovviamente condizionata dai vincoli procedurali costituiti dai quesiti posti dal giudice tedesco e quindi non si traduce (né poteva tradursi) in una minuta e completa regolazione di dettaglio del modo di funzionamento della clausola FRAND.

Sotto questo profilo risulta facile individuare le “lacune” della sentenza, cioè i numerosi problemi di funzionamento della clausola FRAND, a cui la sentenza non dà una risposta⁵⁰.

⁴⁸ Cfr. J.G. SIDAK, *What Aggregate Royalty Do Manufacturers of Mobile Phones to License Standard-Essential Patents?*, in *The Criterion – Journal of Innovation*, 2016, 701 ss.; in uno scritto immediatamente successivo (*How Commissioner Vestager's Mistaken Views on Standard-Essential Patents Illustrate Why President Trump Needs Unified Policy on Antitrust and Innovation*, ivi, 721 ss.) l'a. critica una presa di posizione della commissaria europea sulla concorrenza, che ha invece enfatizzato il rischio di *royalty stacking* e affermato che il prezzo di uno smartphone per il consumatore sarebbe gravato da circa 120 € di *royalty*.

⁴⁹ Fra i commentatori ci si è chiesto se la sentenza debba essere interpretata nel senso di porre un preciso discriminio fra comportamenti abusivi e non del titolare di SEP o se piuttosto debba intendersi come volta a fissare un *safe harbour*, all'interno del quale il titolare del SEP ha la certezza di non violare l'art. 102 TFUE, mentre al di fuori la controversia dev'essere comunque valutata alla luce dei complessivi effetti anticoncorrenziali prodotti. Quest'ultima soluzione (in tal senso C. MEO, in uno scritto di prossima pubblicazione in *Italian Antitrust Review* 2017) appare preferibile, alla luce dei principi del diritto antitrust. Ma ciò non toglie che alla sentenza debba attribuirsi il significato di dettare una presunzione, sia pure reversibile, di abuso, e comunque di svolgere una supplenza di tipo regolamentare, di fronte alla complessità dei problemi posti dai SEP e dalle clausole FRAND.

⁵⁰ Una puntuale individuazione di questi problemi aperti (o almeno ritenuti tali) è, ad esempio, in R. JACOB, A. MILNER, (nt. 34), 11 ss.:

- se l'impegno FRAND possa darsi violato in qualsiasi caso di richiesta di prezzo eccessivo o solo in caso di effettivo *bold up* a danno del concorrente (ma per la verità mi sembra che la sentenza scelga la risposta più estensiva);

Questi limiti (a cominciare dal silenzio sui criteri di determinazione delle *royalty*⁵¹) sono innegabili. Ma la rilevazione di queste lacune ha soprattutto il significato di mettere in evidenza come sia improprio affidare alle sentenze, e anche alla stessa tecnica dell'accumulo di precedenti, la risposta all'esigenza di una compiuta regolazione del fenomeno.

In ogni caso, pur con i suoi limiti, la sentenza, se vista entro questa prospettiva di “supplenza” di una regolazione mancante, fa comunque una scelta precisa – e, a mio avviso, convincente – volta ad intendere la clausola FRAND in termini di valore giuridico rafforzato, con conseguente massima responsabilizzazione del titolare del SEP, se pur temperata dall'obbligo dell'utilizzatore di coltivare in buona fede la prosecuzione della trattativa e di rispettare alcuni obblighi di protezione nell'interesse del titolare del SEP (obbligo di rendicontazione sugli impieghi del SEP e disponibilità a risarcire il danno arrecato).

Si deve aggiungere che questi obblighi comportamentali dell'utilizzatore devono ritenersi – anche se la sentenza non sembra dirlo espressamente – come obblighi incondizionati, che l'utilizzatore deve sempre rispettare, anche nel caso in cui non abbia ricevuto un'offerta

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- cosa accade se ambedue le parti fanno proposte compatibili con la clausola FRAND, ma non sono ancora state in grado di raggiungere un accordo (secondo gli aa. in tal caso tornerebbe ammissibile l'inibitoria del titolare del SEP; a me sembra, invece, che le indicazioni della sentenza debbano essere lette nel senso che i tempi di una normale negoziazione escludono la possibilità di inibitorie, e che questo rimedio torni attuale solo se l'aspirante licenziatario abbia dato luogo ad una rottura ingiustificata della negoziazione);
 - se il titolare del SEP possa pretendere la sottoscrizione di un accordo di riservatezza prima della formulazione della propria offerta (gli aa. propongono la soluzione positiva, che in effetti rimane preferibile, fino a quando una ipotetica disciplina regolamentare imponga ai titolari di SEP di formulare un'offerta di riferimento aperta al pubblico);
 - se l'impegno FRAND sia già di per sé un impegno contrattuale (gli aa. rispondono affermativamente, richiamando anche la disciplina dei contratti a favore di terzo; questa soluzione merita, ad avviso di chi scrive, condivisione, come si dice espressamente più avanti nel testo);
 - come debba essere valutata l'eventuale eccezione di nullità o di decadenza del brevetto, avanzata dall'utilizzatore (secondo gli aa. la soluzione va lasciata alle corti nazionali; in effetti, non si vede il fondamento di tale soluzione, che aprirebbe spazio a forti disparità fra un paese e l'altro, nel funzionamento delle clausole FRAND; la soluzione più corretta sembra essere quella per cui l'eccezione di nullità/decadenza dev'essere ammessa, come espressione generale del diritto di difesa dell'utilizzatore, ma contemporaneamente i tempi di attesa della soluzione giudiziaria sull'eccezione non possono andare a discapito dei legittimi interessi del titolare del SEP: perciò gli obblighi di protezione dell'utilizzatore, in termini di documentazione dell'utilizzo e garanzia di futuri pagamenti, devono essere nel frattempo rispettati);
 - se, in caso di rigetto dell'eccezione di nullità/decadenza possono pretendersi, da parte del titolare del SEP, dei compensi aggiuntivi (secondo gli aa. la risposta è positiva, perché non si devono dare incentivi ad eccezioni pretestuose; tuttavia c'è anche il rischio opposto, per cui si deve piuttosto ritenere che il computo degli interessi sulle *royalty*, accompagnato dalla liquidazione di danni in caso di lite temeraria o imprudente (cioè, in effetti, alla stregua dei diversi diritti nazionali) sia soluzione adeguata);
 - se la base per il calcolo della *royalty* debba essere la “*small saleable unit*” o piuttosto il prezzo di vendita del prodotto finale (gli aa. propendono per la seconda soluzione, che è evidentemente la più gradita ai titolari di SEP; ma, come si è già detto *supra* (nt. 33), trattasi di soluzione incoerente, che traspone una soluzione tradizionale, propria delle licenze di brevetto che si traducono in licenza di un particolare prodotto, la situazione che si verifica in presenza di un fascio di brevetti complementari, nessuno dei quali si identifica con il prodotto finale, che traggono il loro valore proprio e soltanto dall'aggregazione nello standard, che, a sua volta, è una realtà in evoluzione).

⁵¹ E' questa certamente l'incertezza più grave lasciata dalla sentenza (cfr. M. LO BUE, *Huawei v ZTE: established case law and open issues after ECJ's judgment*, in *S.S.R.N.*, 2015).

FRAND da parte del titolare del brevetto⁵²: l'equilibrio di interessi è dato dalla esclusione dell'inibitoria, fino a che la negoziazione non sia rotta per cause imputabili all'utilizzatore, ma non anche da un diritto dell'utilizzatore di sfruttare incondizionatamente il brevetto prima della definizione dell'accordo di prezzo con il titolare del SEP.

Un'altra scelta interpretativa della sentenza è quella di un'applicazione estensiva della norma sul divieto di abuso di posizione dominante, che viene implicitamente concepita come "posizione dominante plurima non collettiva"⁵³, attribuita a ciascun titolare di SEP, in quanto tale⁵⁴.

L'applicazione concreta delle indicazioni contenute nella sentenza Huawei richiederà certamente progressive (e numerose) precisazioni. Ciò non toglie comunque che la sentenza abbia indicato un punto di equilibrio, che intende il diritto di esclusiva sul SEP – per il tramite della norma sul divieto di abuso di posizione dominante – come un diritto "funzionalizzato" al conseguimento degli scopi di efficienza dell'accordo di standardizzazione (per usare una terminologia arcaica, un diritto che deve essere esercitato dal suo titolare secondo criteri di "speciale responsabilità").

Ciò ha portato al rigetto dell'alternativa che i giudici tedeschi avevano invece ritenuto preferibile⁵⁵, e che si traduceva in pesanti oneri di definizione della propria offerta di *royalty* da parte dell'aspirante licenziatario, e conseguenti rischi di inibitoria in caso di difetti di questa offerta. Questa idea, ben diversa da quella affermata dalla Corte, muoveva dall'assunto implicito dell'eccezionalità dell'impegno FRAND rispetto ad un principio (ritenuto sistematicamente superiore) di tutela della proprietà (in questo caso intellettuale) e della libertà di contrattare⁵⁶. Viceversa, la posizione della Corte, ponendo a carico del titolare del SEP l'onere di formulare la prima offerta equa e ragionevole, e ponendo a carico dell'utilizzatore solo obblighi di adeguata risposta, nonché obblighi di protezione degli interessi patrimoniali del titolare del SEP, sembra muovere dall'opposta idea, che vede l'impegno FRAND come espressione del più generale principio di buona fede nei rapporti economici.

⁵² In tal senso P. PICHT, (nt.36), 374.

⁵³ V. *supra* nt. 43.

⁵⁴ Questa interpretazione estensiva della nozione di posizione dominante dovrebbe far ritenere superata la questione, posta da diversi commentatori [v. ampiamente, anche per riferimenti, N. PETIT, (nt. 12)], secondo cui la sentenza lascerebbe aperto il problema dell'applicabilità delle soluzioni indicate a soggetti come le "*patent assertion entities*" e le "*non-practicing entities*", che gestiscono diritti di brevetto senza svolgere attività produttiva nei mercati a valle, e quindi non sono in concorrenza diretta con i soggetti utilizzatori.

In realtà, comunque, anche tali soggetti sono "imprese" ai sensi del diritto della concorrenza, almeno perché forniscono licenze (che sono servizi, in senso lato) a titolo oneroso, e la posizione dominante deriva loro dall'essenzialità del brevetto, e come tale può essere riconosciuta anche in direzione verticale.

In ogni caso non sembra proprio che la sentenza abbia implicitamente previsto un trattamento più favorevole per soggetti di questo tipo.

⁵⁵ Questo condizionamento ha continuato ad operare nella giurisprudenza tedesca anche dopo la sentenza *Huawei*, con diverse decisioni di giudici di merito che ne hanno fatto un'applicazione restrittiva (anche se il *trend* sembra essersi invertito nei giudici di appello). Ampie informazioni sul punto in G. COLANGELO, *L'enforcement europeo dei brevetti essenziali dopo Huawei*, in *Concorrenza e comportamenti escludenti* (nt.40), 190 ss.

⁵⁶ E' stato rilevato che, anche dopo la sentenza *Huawei*, le corti tedesche hanno tendenzialmente accolto le ragioni dei titolari di SEP, interpretando restrittivamente la portata della sentenza della Corte di Giustizia [cfr. R. JACOB, A. MILNER, (nt. 34), 8 ss.; P. PICHT, (nt. 36), 369].

La soluzione adottata nella sentenza *Huawei* sembra dunque andare nella direzione di un giusto bilanciamento fra rischi di *hold-up* e rischi di *hold-out*⁵⁷. Essa può certamente avere l'effetto di sospingere verso il basso la definizione del livello di *royalty* accettato nella prassi; ma questo rilievo non può dar luogo a critiche, se si tiene conto della moltitudine di SEP e della prassi, sopra ricordata, dell'utilizzazione di fatto degli standard anche in assenza della copertura con licenze.

In ogni caso, una volta accettata la soluzione normativa della doverosità della licenza (come già avviene con l'imposizione al titolare del SEP di assumere pubblicamente l'impegno di rilasciare licenze a condizioni FRAND), è più equa (ed anche più efficiente) una soluzione che fa gravare sul licenziante, anziché sul licenziatario, il rischio inherente ai tempi di attesa della definizione della *royalty*: con questa linea di soluzione il licenziante rischia solo di percepire in ritardo le somme dovutegli, ma può essere garantito da adeguati doveri di protezione in capo all'aspirante licenziatario; quest'ultimo rischia invece – se si adotta l'opposta soluzione - di dover subire l'inibitoria e quindi di ritardare il suo ingresso nel mercato, con effetti negativi anche sul funzionamento complessivo dello stesso⁵⁸.

Inoltre, a livello di sistema, la linea di soluzione adottata dalla Corte favorisce il rapido accesso nel mercato finale di più offerte di prodotti concorrenziali, ed anche sotto questo profilo si fa preferire in una prospettiva di incremento del benessere del consumatore.

Del resto, la linea di soluzione adottata dalla Corte è conforme all'orientamento manifestato anche dalle autorità antitrust americane, che hanno considerato il *patent holdup* come un pericolo maggiore rispetto a quello di *patent holdout*, nel funzionamento degli accordi di standardizzazione⁵⁹.

Si deve certo notare che questo orientamento è soggetto a forti critiche da buona parte della dottrina statunitense⁶⁰, ma tali critiche sembrano fondarsi solo su una fanatica fede nella capacità di autocorrezione del mercato, piuttosto che su un'analisi economica approfondita degli effetti delle diverse soluzioni in campo.

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3. *La disciplina delle clausole FRAND come problema di diritto positivo.*

La sentenza *Huawei* segna dunque un passo nella giusta direzione, ma dopo la sentenza c'è ancora da costruire tutta una disciplina dettagliata delle procedure di negoziazione e c'è, soprattutto, il problema di individuare un criterio praticabile ed equo di determinazione del livello delle *royalty*, in mancanza di una gestione collettiva delle stesse.

Si tratta di problemi che difficilmente troveranno una soluzione davvero soddisfacente mediante l'accumulo di precedenti giudiziari (anche se non sarà facile trovare critiche allo

⁵⁷ In tal senso anche D. KALLAY, *The ECJ Huawei-ZTE Decision: En Route to Ending Hold-Out?*, in www.competitionpolicyinternational.org, Oct 27, 2015. Infatti, come si è sottolineato in dottrina [cfr., p.e., P. PICHT, (nt. 36), 367 ss.; G. COLANGELO, *Il mercato dell'innovazione* (nt. 14), 267], la posizione della Corte si differenzia anche da quella sostenuta dalla Commissione, che onerava l'utilizzatore solo di dichiarare la propria disponibilità a pagare un corrispettivo FRAND.

⁵⁸ Cfr. in tal senso D.A. CRANE, (nt. 31), 34: “Inverting the burden of proof requiring the licensor to justify the preferred terms rather than requiring the licensee to prove them unreasonable is a familiar remedy in the intellectual property-antitrust context” (ivi indicazioni di giurisprudenza americana).

⁵⁹ Cfr. M. LO BUE, (nt. 21), 34 ss.

⁶⁰ Per ampi riferimenti v. G. COLANGELO, *L'enforcement europeo*, (nt. 55), 171-2.

status quo da parte di chi assiste le imprese nelle controversie giudiziarie e da parte delle imprese che ritengono di potere fare un uso strategico del contenzioso). In ogni caso, se può plausibilmente pensarsi ad una progressiva definizione dei doveri comportamentali (procedurali) delle parti nelle negoziazioni FRAND – e, in tal modo, ad una accettabile definizione dei presupposti che possono talora legittimare il rimedio inibitorio - più difficile sembra il conseguimento di soluzioni sufficientemente certe in materia di definizione dei giusti livelli di *royalty* e di eventuale irrogazione di danni ulteriori in caso di utilizzo dei SEP in mancanza di licenza⁶¹.

Ciò non esime comunque dall'onere di fare delle scelte, il più possibile sensate, sul piano del diritto positivo.

In tale prospettiva una prima linea dev'essere – a mio avviso - quella del rafforzamento degli effetti giuridici degli impegni FRAND.

In questo senso, la linea interpretativa seguita nella sentenza *Huawei* si salda idealmente con quegli orientamenti che – in contrasto con la diversa linea che intende la clausola FRAND in termini di *soft law*, come volta solo a favorire comportamenti cooperativi⁶² - hanno valorizzato l'efficacia civilistica dell'impegno FRAND, configurandolo come offerta al pubblico immediatamente vincolante a tale da dar luogo ad un vincolo contrattuale già attuale, ad oggetto determinabile, a seguito dell'adesione dell'aspirante licenziatario⁶³; una situazione nella quale, non a torto, nell'ordinamento italiano potrebbe proporsi l'applicazione analogica dell'art. 80 c.p.i., in materia di "licenze di diritto"⁶⁴. In coerenza con questa linea di ragionamento, l'impegno FRAND si dovrebbe considerare trasferito *ex lege* in caso di trasferimento del ramo d'azienda contenente il portafoglio di brevetti interessati.

Nella stessa linea si pone anche l'orientamento prevalente negli Stati Uniti, che ha valorizzato, come base civilistica della soluzione, il meccanismo del contratto a favore di terzi (cioè ha attribuito tale qualificazione all'accordo fra il titolare del brevetto e la SSO, in base al quale il primo formula l'impegno FRAND nei confronti dei futuri utilizzatori, che vengono qualificati come serie di soggetti sufficientemente determinata per dar luogo alla costituzione di pretese esigibili nei confronti del titolare del brevetto)⁶⁵.

⁶¹ Quest'ultimo punto è attualmente oggetto di vive discussioni negli Stati Uniti. A fronte di un orientamento delle corti federali volto a negare danni punitivi nei casi di utilizzo non autorizzato di SEP in presenza della clausola FRAND, la Corte Suprema, nella sentenza *Halo Electronics, Inc. v. Pulse Electronic, Inc.* (2016), ha sancito la legittimità dell'irrogazione di danni punitivi in tutti i casi in cui sia accertato un "egregious infringement" da parte dell'utilizzatore (cfr. J.G. SIDAK, *Enhanced Damages for Infringement of Standard-Essential Patents*, in *The Criterion – Journal of Innovation*, 2016, 1101 ss.).

⁶² Cfr. N. PETIT, (nt. 12).

⁶³ Cfr. M. MAUGERI, *Frond commitments e disciplina del contratto*, in *Impresa e mercato*, (nt. 42), 1033 ss.

⁶⁴ Il collegamento sistematico fra l'impegno FRAND e le "licenze di diritto" è stato fatto anche dall'avvocato generale Wathelet, nel caso *Huawei* [come ricorda G. COLANGELO, (nt. 55), 268].

⁶⁵ Cfr. J.G. SIDAK, *Injunctive Relief and the FRAND Commitment in the United States*, in *Cambridge Handbook of Technical Standardization Law*, vol. I: *Antitrust and Patents*, J. Contreras ed., Cambridge University Press (in corso di pubblicazione), reperibile come *paper in S.S.R.N.*; ID., *A FRAND Contract's Intended Third-Party Beneficiary*, in *The Criterion – Journal of Innovation*, 2016, 1001 ss., ove interessanti approfondimenti sul contenuto civilistico dell'obbligo FRAND: in particolare, l'a. sostiene plausibilmente che l'obbligo ha ad oggetto una *portfolio licence*, comprensiva di tutti i brevetti dello stesso titolare compresi nello standard e non anche una licenza ad oggetto selezionato ad arbitrio dall'utilizzatore; meno plausibilmente, l'a. sostiene che l'obbligo FRAND si esaurirebbe

Questa situazione ha determinato la diffusa convinzione che l'attuazione delle clausole FRAND sia un problema di diritto dei contratti e non di diritto antitrust⁶⁶. Da ciò la critica, talora rivolta alla sentenza *Huawei*, di avere utilizzato nozioni e principi propri del diritto dei contratti (in primo luogo: il principio o di buona fede) per risolvere un problema di diritto della concorrenza⁶⁷.

Queste affermazioni sono, a mio avviso, non appropriate. In realtà, l'impegno FRAND, e il buon funzionamento dello stesso, costituiscono – almeno nella prospettiva del diritto antitrust europeo - *condicio iuris* per l'esenzione *ex lege* degli accordi di standardizzazione per le tecnologie avanzate (ciò ai sensi dell'art. 101.3 T.F.U.E.).

Il dovere civilistico di buona fede, che discende dall'impegno FRAND (impegno a sua volta imposto da principi propri del diritto della concorrenza), si riempie poi di contenuti operativi concreti proprio in base a criteri di buon funzionamento complessivo del mercato.

In ogni caso, l'ordinamento non ha compartimenti stagni e la tutela della concorrenza fra imprese è un principio generale, che può indirizzare l'applicazione di norme generali come quelle sulla validità o l'efficacia o l'interpretazione dei contratti⁶⁸, come può indirizzare - in altri contesti - l'applicazione delle norme sulla legittimità degli atti amministrativi. Non si deve pensare il diritto antitrust come un comparto separato ed autosufficiente dell'ordinamento.

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Il problema ulteriore è costituito dal fatto che la costruzione civilistica, su cui si può innestare la regolazione progressiva del funzionamento degli impegni FRAND, può operare solo nei confronti di quegli operatori che abbiano effettivamente assunto un impegno FRAND.

Problemi possono nascere, però, nel caso in cui i diritti di brevetto siano stati ceduti a terzi (e non possano operare gli strumenti di successione *ex lege* nelle posizioni contrattuali, come quelli forniti in Italia dalle norme sulla cessione d'azienda), o anche nei casi, rari⁶⁹ ma importanti (che hanno avuto un esempio eclatante con riguardo al comportamento di Apple), di operatori che non aderiscono alla SSO, e quindi non mettono i loro brevetti a disposizione dell'organizzazione e non sono obbligati ad assumere un impegno FRAND, ma contemporaneamente registrano brevetti che assumono concreta importanza per l'evoluzione di uno standard già affermato.

con la formulazione di una prima proposta rispettosa dell'impegno, sicché, in caso di non accettazione e controproposta dell'aspirante licenziatario, il titolare del SEP sarebbe legittimato a chiedere l'inibitoria.

V. anche sul punto richiamato nel testo M. LO BUE, (nt. 21), 11-2, che sottolinea come tuttavia le autorità antitrust americane (DoJ e FTC) non abbiano affatto escluso la possibilità che il divieto di *monopolization* possa applicarsi anche a carico del titolare di SEP che utilizzi gli stessi per strategie di “*aggressive litigation*”.

⁶⁶ Cfr. M. LO BUE, (nt. 21), 52.

⁶⁷ Cfr., in particolare, P. PICHT, (nt. 36), 370-1.

⁶⁸ Cfr. D.A. CRANE, (nt. 31), 22: “*even a contractual dispute over the meaning of a RAND commitment will need to invoke some antitrust principles as background to understanding the words of the contract*”.

⁶⁹ Si tratta di casi rari perché, di norma, l'impresa che realizza un'innovazione tecnologica in un mercato dominato da uno standard ha tutto l'interesse a far accettare il suo brevetto all'interno dello standard, al fine di farlo poi accettare dall'intero mercato e di evitare di rimanere emarginata [cfr. M. LO BUE, (nt. 21), 10].

Può darsi però talora il caso che un'impresa sia titolare di brevetti così significativi da poter preferire (come è avvenuto proprio nel caso di Apple) che essi si rendessero di fatto essenziali nello standard, senza necessità di un riconoscimento formale da parte dell'organizzazione.

Di fronte a questi fenomeni, che possono minare il funzionamento complessivo del sistema, si pone il problema di estendere l'ambito di applicazione del meccanismo FRAND anche in mancanza di una base contrattuale dello stesso.

Il passaggio ulteriore sarebbe quello di qualificare l'obbligo FRAND come obbligo fondato su un uso commerciale “virtuoso”, formatosi – come si è detto – come condizione di esenzione *ex lege* nel quadro della disciplina antitrust degli accordi di standardizzazione⁷⁰ e come tale divenuto vincolante – anche al di là dell'impegno espresso – per tutte le imprese che intendano inserirsi nell'evoluzione dello standard, anche quando non abbiano espressamente aderito all'accordo di standardizzazione⁷¹.

Questa conclusione può essere più facile in quegli ordinamenti che hanno mantenuto codici di commercio separati rispetto al diritto privato generale e così hanno mantenuto una posizione privilegiata all'uso commerciale nella gerarchia delle fonti⁷².

In Italia non sarebbe difficile riconoscere una valenza integrativa del contratto all'uso, in base alle norme generali degli artt. 1340 e 1374 c.c., con particolare riguardo a quella valenza che si suole attribuire agli usi del commercio internazionale⁷³. Ma il problema delle clausole FRAND non si pone normalmente in funzione di integrazione (o anche di buona fede correttiva), all'interno di contratti già conclusi; si pone piuttosto come problema di reazione a un rifiuto, assoluto o “costruttivo”, di contrarre da parte del titolare del brevetto, o comunque di pretesa di *royalty* eccessive da parte dello stesso.

In sostanza, il problema dell'applicazione generale del meccanismo FRAND si può risolvere solo con il riconoscimento di una obbligatorietà *ex lege* e, in particolare, con l'estensione del meccanismo anche al di fuori del funzionamento delle SSO, e quindi in tutto l'ambito degli standard di fatto, quali possono risultare dall'evoluzione del mercato anche al di fuori della sfera di controllo delle SSO (si pensi ancora alla strategia brevettuale di Apple).

Ne consegue che, in tutti i casi in cui non esista un impegno FRAND valorizzabile sul piano della ricostruzione degli effetti negoziali, la soluzione del problema può essere data solo dall'applicazione estensiva della norma antitrust sul divieto di abuso di posizione dominante – che, peraltro, le corti europee applicano anche nei confronti delle imprese che hanno assunto l'impegno FRAND⁷⁴ - e/o dall'applicazione del principio di divieto di abuso del

⁷⁰ Su questo corretto inquadramento sistematico della clausola FRAND nel diritto antitrust europeo v. anche G. COLANGELO, (nt. 55), 174.

⁷¹ Negli Stati Uniti l'impegno FRAND è stato imposto dalla FTC anche come condizione per l'autorizzazione di operazioni di concentrazione fra imprese del settore interessato allo standard [cfr. J.G. SIDAK, *Injunctive Relief* (nt. 65), 19].

⁷² Il valore dell'uso sarebbe peraltro messo in dubbio, almeno nella concezione giuspositivistica tradizionale, dall'idea che le norme consuetudinarie sarebbero sempre dispositive, cioè derogabili da espresse pattuizioni negoziali [cfr. A. PAVONE LA ROSA, *Consuetudine (usi normativi e usi negoziali)*, in Enc. Dir., XI, Giuffrè, Milano, 1961].

⁷³ Corte Giust. UE, sez. III, 9 giugno 2011, C-87/10, *Electrosteel Europe SA c. Edilcentro S.p.A.*; in dottrina, per tutti, F. GALGANO, *Le forme di regolazione dei mercati internazionali*, in *Contratto e impresa*, 2010, 353 ss.

⁷⁴ Questa, sul piano comparatistico, è considerata la principale differenza fra USA ed Europa, nell'impostazione della materia trattata [cfr. M. LO BUE, (nt. 21), 53, 56; lo stesso a. riconosce che “*In absence of a submitted LOA (Letter od Agreement), the only tool to limit SEP holders' market power arises from competition law*”, anche se l'applicazione delle norme antitrust richiede una prova rigorosa del *foreclosure effect* conseguente alla condotta del titolare del SEP].

diritto di brevetto. Apparentemente, la soluzione più estensiva – che appare anche quella necessaria per consentire all’intero sistema della standardizzazione tecnologica di ben funzionare – sembra quest’ultima⁷⁵.

A mio avviso non ci sono, tuttavia, reali differenze fra le due soluzioni. L’abuso del diritto di brevetto dev’essere infatti ricostruito alla luce della funzione proconcorrenziale che legittima lo strumento stesso del brevetto⁷⁶. Per quanto riguarda invece l’applicazione del divieto di abuso di posizione dominante il percorso argomentativo sarà più complesso, ma, come si è già detto nel corso di questo scritto, l’evoluzione del diritto antitrust porta sempre più ad abbandonare una concezione della posizione dominante come situazione eccezionale e a riconoscere piuttosto una coincidenza tra la nozione di posizione dominante e quella di potere di mercato. Da qui il riconoscimento di posizioni plurime di potere negli stessi mercati. In questa prospettiva, non dovrebbe essere difficile riconoscere il potere di mercato anche in capo alle cosiddette *Non-Practicing Entities*, cioè ad imprese che fanno incetta di SEP non per utilizzarli nella produzione, bensì solo per farne uso strategico in futuri contenziosi⁷⁷. Più in generale, come ho cercato di dimostrare altrove⁷⁸, si dovrebbe riconoscere che l’intero sistema di divieti delle norme antitrust europee dev’essere ricostruito come un *continuum*: oggetto del divieto è sempre l’esercizio di un potere di mercato, individuale o collettivo, che viene usato, o può essere usato, per finalità anticoncorrenziali. In relazione al divieto delle intese il potere di mercato è creato (o rafforzato) dall’intesa stessa, mentre i divieti di condotte unilaterali riguardano situazioni in cui il potere di mercato preesiste alla condotta vietata. La base normativa dei divieti è sostanzialmente unitaria, nella sua *ratio* e nella necessità di applicare anche alla condotte unilaterali quella particolare *rule of reason* europea, che è sancita nell’art. 101.3 T.F.U.E.

⁷⁵ Soluzione ritenuta preferibile da P. PICHT, (nt. 36), 373.

⁷⁶ Sul punto v. da ultimo V. DI CATALDO, *La questione brevettuale all’inizio del XXI secolo*, in *Orizzonti del diritto commerciale* (sito telematico), febbraio 2017.

Più in generale, per la linea di pensiero accennata nel testo con riguardo ai rapporti fra *patent misuse* e abuso di posizione dominante, v. T. KÄSEBERG, *Intellectual Property, Antitrust and Cumulative Innovation in the EU and the US*, Hart, Oxford, 2012.

⁷⁷ In dottrina è diffusa la preoccupazione che le norme sul divieto di abuso di posizione dominante non si possano applicare a queste entità che, non essendo titolari di imprese verticalmente integrate, non possono fare un uso “predatorio” del rifiuto di contrarre [v., p.e., G. COLANGELO, (nt. 55), 190, secondo cui la sentenza *Huawei* non coprirebbe questi casi].

A mio avviso, però (v. già *supra*, nt. 54), un’applicazione estensiva del divieto di abuso può ben comprendere tutti i casi in cui vi è controllo di una risorsa essenziale ai fini dell’attività da svolgere nel mercato a valle, senza necessità di accertare il ricorso a strategie predatorie. Evidentemente il punto richiederebbe ben altro approfondimento, rispetto al cenno qui compiuto.

⁷⁸ M. LIBERTINI, *Diritto della concorrenza*, (nt. 43), 270 ss.

THE FUTURE OF ANTITRUST: CONCERN FOR THE REAL INTERESTS AT STAKE, OR ETIQUETTE FOR OLIGOPOLISTS?

FRANCESCO DENOZZA*

Summary: 1. The Huawei decision and its shortcomings. – 2. The antitrust goals and the “efficiency theory”. – 3. The empty notion of efficiency and the problematic notions of consumer welfare and of total welfare. – 4. How the efficiency theory made the antitrust myopic. – 5. A “disembedded” antitrust, blind to any social consequence. – 6. An antitrust blind to macroeconomic consequences. – 7. An antitrust blind to systemic consequences. – 8. The antitrust enforcement: not a matter of “consumer welfare”, but a matter of balancing the interests of some consumers against the interests of other consumers. – 9. Concluding remarks: the main question missing in the Huawei reasoning.

1. The Huawei decision and its shortcomings.

The *Huawei* decision¹ is affected by a paradoxical shortcoming. I will try to explain why. The question referred to the Court concerned the possible existence of an abuse of a dominant position in the conduct of holders of FRAND – pledged standard essential patents (patents essential to a standard developed by a standard-setting organization), applying for an injunction to stop the activity of (unlicensed) users of their technology. A question, as it is obvious, whose answer immediately affects the possibility of a new maker entering the market and that is potentially able to influence the degree of competition from which consumers will benefit².

* Professore ordinario f.r., Università di Milano.

¹ C-170/13, *Huawei Technologies V. ZTD*, 16 July 2015.

² The point is acknowledged (but not taken into the consideration it deserved) in the Opinion of Advocate General Wathelet, in *Huawei*, see par. 74, and especially note 51: “... where the SEP-holder uses actions for a prohibitory injunction as leverage to increase licence fees, contrary to the FRAND commitment, the prices of LTE standard-compliant products and services are indirectly and unfairly affected, to the detriment of the consumers of those products and services”. In fact, it is obvious that downstream consumers are harmed when excessive royalties are passed on to them: J. FARRELL, J. HAYES, C. SHAPIRO, T. SULLIVAN, *Standard Setting, Patents, and Hold-Up*, 74 *Antitrust L.J.* 2007, 603, 605; S. Mitchell, *Microsoft and Apple Patents ‘Push Up Price of Android’*, PC PRO (Aug. 4, 2011): “Google’s patent war with Apple and Microsoft could lead to price increases for Google’s Android phones and less handset choice”; J. Lee, *An Un(frand)ly Game: Preventing Patent Hold-Up by Improving Standardization*, 10 *J. Bus. & Tech. L.* 2015, available at: <http://digitalcommons.law.umaryland.edu/jbtl/vol10/iss2/7>, 375, 391: “The consumer loses financially, as it has to pay for higher prices for this patent infringement litigation and personally, as the number of product options decreases”.

The question is obviously rooted in the context of the antitrust law, where consumers' interest should be paramount. One would therefore have expected that the starting point of the Court's reasoning would be an analysis of the problems connected with the competitiveness of the markets in which Standard Essential Patent are present and, especially, with the ways in which SEPs can harm or benefit consumers. Nevertheless, a serious reference to the consumer interest, which should have been the pole star of the whole reasoning, is totally absent throughout the Court's opinion.

Not just that. Consumer interest, in addition to being verbally ignored, seems to be totally out of the horizon of the Court's concerns. The Court cares about delineating the etiquette that courtly patent holders and courtly potential users ought to respect in their interaction. Nothing is said about the consumers' interest in enjoying the benefits of greater competition³.

The result is a decision under which if the patent holder behaves rudely whilst the potential user behaves in a polite and courteous manner (by strictly complying with all the formal moves required by the etiquette established by the Court), consumers shall benefit from increased competition. In the opposite case of a polite patent holder and a rude potential user, consumers shall suffer the monopoly power of the patent owner and its licensees⁴.

This is a result that I deem paradoxical: the satisfaction of the consumers' interest made dependent on the respective rudeness and politeness exhibited in the given circumstances by the two contenders, the patent holder and the potential user.

In this paper I maintain that this paradoxical result is not the occasional consequence of a situation that exhibits in turn some paradoxical features (a patent becomes essential not – or not just - on its merits, but as a result of an agreement among competitors⁵). The distorted perspective (mistakenly ignoring real consumer interests) inspiring the opinion of the Court in *Huawei* is the result not of an accident, but of the conceptual evolution that characterized the antitrust law over the past decades.

³ The fact that the reference to the Court of Justice made by the Dusseldorf Court originated from a problem of interpretation of the so-called *Orange Book* defence, that can be used by defendants in patent infringement actions in German courts, does not seem to me a valid excuse for the way in which the Court of Justice set the problem.

⁴ The decision has been criticized also for giving some leeway to the “gambles” of the patent trolls, B. LUNDQVIST, *The Interface between Competition Law and Standard Essential Patents - Some Early Comments on the Huawei Case* (November 9, 2015), available at SSRN: <https://ssrn.com/abstract=2688257>; for opening the way to strategies to circumvent the licensing framework, for example by suing instead of the maker, its customers, D. GERARDIN, *European Union Competition Law, Intellectual Property law and Standardization, The Cambridge Handbook of Technical Standardization Law (forthcoming 2016)*; for being a conservative judgment which “does not seem to contemplate any antitrust liability against firms that use injunctions on FRAND-pledged SEPs to extract “unfair” licensing terms”, N. PETIT, *Huawei v. ZTE: Judicial Conservatism at the Patent-Antitrust Intersection*, N. PETIT, *Huawei v. ZTE: Judicial Conservatism at the Patent-Antitrust Intersection, CPI Antitrust Chronicles*, Volume 10, Number 2, October 2015, available at SSRN: <https://ssrn.com/abstract=2681377>.

⁵ European Commission, *Standard-essential patents, Competition policy brief*, June 2014, 3: “Standard -setting (or standardisation) is generally achieved by means of an agreement between undertakings, often competing on the same market, and so is subject to Article 101 TFEU. Given their positive economic effects, standardisation agreements are generally compatible with Article 101 TFEU, even if they are agreements between competitors to adopt a single technology in favour of others”.

This connection may appear astonishing, given that during the last few years consumer interest, has apparently dominated the antitrust policy, whose professed principal concern has been the maximization of the consumer welfare. So, before returning to the specific problems of *Huawei*, I will try to explain how the theory which posits consumer welfare as the goal of the antitrust law can lead to ignoring or distorting the real problems of the protection of the interests of the consumers.

2. The antitrust goals and the “efficiency theory”.

As every scholar knows (and some, as this author, remind) nearly half a century ago the traditional and, in some sense, natural goal of the antitrust law (preserving the competitive structure of the markets) was replaced by another ambiguous and rather cryptic goal, the pursuit of “efficiency”⁶. This shift in perspective is notoriously associated with the triumph of the so called Chicago school of antitrust, whose roots date back to the fifties/ sixties of the last century⁷ and whose maturity was reached in the seventies⁸. The ideas of the Chicago School, and especially the focus on efficiency⁹, have had a tremendous success in the US¹⁰,

⁶ W. DAVIES, *The Politics of Externalities: Neo-liberalism, Rising Powers and Property Rights*, Network Grant, ESRC Rising Powers Programme, 2010-2011, 7: “By the 1970s, a new vision of anti-trust had emerged from the Chicago School, that was purely dedicated to the maximisation of efficiency (measured as consumer welfare), and agnostic as to whether this was best pursued by markets or by monopolistic hierarchies. Highlighting the efficiencies of industrial concentration has been the major contribution of Chicago Law and Economics to US, and subsequently European, competition policy”.

⁷ E.g.: A. DIRECTOR, E. LEVI, *Law and the Future: Trade Regulation*, 51 *Northwestern University Law Review* 1956, 281 (efficiency presented as a central concern); R. BORK, W. BOWMAN, *The Crisis in Antitrust*, 65 *Col. Law Rev.*, 1965, 363 (antitrust laws enforced in way that is “anticompetitive” especially in decision dealing with mergers and vertical integration); O. WILLIAMSON, *Economies as an Antitrust Defence: the Welfare Tradeoffs*, 58 *American Economic Review*, 1968, 18.

⁸ R. POSNER, *Antitrust Law: an Economic Perspective*, University of Chicago Press, 1976; R. BORK, *The Antitrust Paradox*, New York Basic Books, 1978.

⁹ The paradoxical reasoning of Bork (the cornerstone of the Chicagoan efficiency theory) is well summed up by B. LYNN, *Cornered: The new monopoly capitalism and the economics of destruction*, John Wiley & Sons, 2009, 138: “... if antitrust law exists to serve the consumer, and if consumers are best served by getting more for less, and if the best way to get more for less is to encourage business to be “efficient,” and if the best way to be efficient is to build up scale and scope, then ergo, monopoly is the best friend of the consumer”.

¹⁰ J. MARKHAM, JR., *Lessons for Competition Law from the Economic Crisis: The Prospect for Antitrust Responses to the “Too-Big-To-Fail” Phenomenon*, 16 *Fordham j. Corp. & Fin. L.* 2011, 278: “In the last two decades of the Twentieth Century, antitrust law embraced this narrow, Chicago School, doctrinal approach to antitrust law and accepted the optimization of allocative efficiency of firms and markets as the dominant antitrust policy.” On the influence of the Bork’s book on the U.S. Supreme Court, see especially G. PRIEST, *Bork’s Strategy and the Influence of the Chicago School on Modern Antitrust Law*, 57 *The Journal of Law & Economics*, 2014, 1.

have shaped antitrust policy becoming in a way “commonsensical”¹¹, certainly influencing the evolution of European antitrust law too¹².

In the last two decades or so, some thesis advanced by the Chicago scholars have been amended or even challenged, so we speak now of a Neo- Chicago or a Post- Chicago¹³. What exactly is implied by this transition from a tight Chicagoan orthodoxy to an evolved, or changed, theoretical perspective, seems controversial and difficult to establish¹⁴. However, I think that at least one feature of the original Chicago thought still dominates the economic approach (and remains in any case a key point of reference with which all the views on the goals of antitrust law, even those less sympathetic, have to contend). I mean the belief that: a) efficiency is the main, or the sole, goal of antitrust law and b) this goal can guide the interpretation and the enforcement of antitrust law unambiguously, sheltering it from the influence of any (arbitrary) political evaluation.

I intend to criticize this belief and to highlight the serious limitations of the conception (which I will refer to, from now on, as the “efficiency theory”) that conceives of efficiency as the most important, if not the sole, normative objective of antitrust law. A conception quite widespread in the U.S. and in the European scholarship, and which seems to be shared, in its general terms, even by Neo- and Post- Chicago.

3. The empty notion of efficiency and the problematic notions of consumer welfare and of total welfare.

¹¹ Even among the not entirely sympathetic scholars. See e.g. H. SCHWEITZER, *Efficiency, political freedom and the freedom to compete- comment on Maier – Rigaud . The Goals of Competition Law*, (D. Zimmer, ed.), Edward Elgar, 2012, 196, 181: “there are few who would contest that efficiency and consumer orientation are among the relevant aspirations of competition law. What is more: efficiency criteria and consumer interests are clearly relevant as a matter of positive EU law”.

¹² D. BARTALEVICH, *The Influence of the Chicago School on the Commission’s Guidelines, Notices and Block Exemption Regulation in EU Competition Policy*, 54 *Journal of Common Market Studies*, 2016, 267, 279; L. PARRET, *Shouldn’t we know what we are protecting? Yes we should! A plea for a solid and comprehensive debate about the objectives of EU competition law and policy*, 6 *European Competition Journal*, 2010, 339, 357-358; A. WEITBRECHT, *From Freiburg to Chicago-the First 50 Years of European Competition Law*, *European Competition Law Review* 2008, 81, 85 “...a process of Americanisation began and the Commission gradually adopted its own version of the consumer welfare approach developed by the Chicago School...”.

¹³ D. CRANE, *Chicago, Post-Chicago, and Neo-Chicago. Review of How Chicago Overshot the Mark: The Effect of Conservative Economic Analysis on U.S. Antitrust*, by R. PITOFSKY, editor., 76 *U. Chi. L. Rev.* 2009, 1911; Id., *A Neo-Chicago Perspective on Antitrust Institutions*, 78 *Antitrust Law Journal*, 2012, 43.

¹⁴ In fact the relationship between Chicago and Post- Chicago is rather controversial. Some commentators minimize the differences between the two schools: e.g., J. MARKHAM, (nt. 10), 278–81, maintains that “Post-Chicago School antitrust is the stepchild of Chicago School antitrust . . .” it “departs from the Chicago School views mostly around the margins.”; B. Kobayashi, T. MURIS, *Chicago, Post-Chicago, and Beyond: Time to Let Go of the 20th Century*, 78 *Antitrust Law Journal*, 2012, 505, arguing that “...the contributions of the “Post-Chicago” school to antitrust doctrine and policy are limited”. D. BUSH, *Too Big To Bail: the Role o Antitrust in Distressed Industries*, 77 *Antitrust Law Journal*, 2010, 277, 279 296: this “Post-Chicago ” view of economics still examines the world through the lens of efficiency and consumer welfare. Thus, while the movement towards a Post-Chicago world is a promising turn for some, it still ignores political considerations and continues the Chicago focus on efficiencies and firm size as not being necessarily evil”. J. WRIGHT, *Abandoning Antitrust’s Chicago Obsession: The Case for Evidence-Based Antitrust*, 78, *Antitrust Law Journal*, 2012, 301, 302: “The Neo-Chicago School could be interpreted as arising largely as an exercise in marketing — rebranding the Chicago School... In the end, the Neo-Chicago School offers little if any true product differentiation from its predecessor”.

The critique to the efficiency theory can usefully start from the obvious observation that efficiency is not only a concept susceptible of multiple meanings¹⁵ but also a substantially empty notion. Nothing is efficient in the vacuum, abstracting from a given goal. What is efficient in reaching a given end (say, the satisfaction of my preferences) may often be inefficient in pursuing another goal (say, the preservation of my health). So, in order to give content to the notion of efficiency we have to define a specific goal¹⁶. Only afterwards, can the degrees of efficiency of each of the possible ways for reaching the chosen goal be evaluated and, perhaps, measured.

With reference to antitrust law, the candidates for carrying out the function of giving content to the notion of efficiency by defining a specific goal, are two quite different (and, in their turn, problematic) notions¹⁷, that of (efficiency as) maximizing the total welfare or that of (efficiency as) maximizing the consumer welfare¹⁸. The theoretical difference between the two perspectives is that in the latter (consumer welfare) only the well-being of consumers counts, whilst in the former (more coherently, but less reasonably, as we will immediately see) what counts is the effect of the considered practice on society at large.

The problem of defining the practical differences between these two notions of efficiency¹⁹, and even more that of choosing between them, is rather complex.

¹⁵ "...efficiency is a multifaceted concept..." E. FOX, *The Efficiency Paradox*, in *How The Chicago School Overshot The Mark: The Effect Of Conservative Economic Analysis On U.S. Antitrust*, 77, 88 (R. PITOFSKY ed., 2008); T. HORTON, *Efficiencies and Antitrust Reconsidered: An Evolutionary Perspective*, 60 *The Antitrust Bulletin* 2015, 168; A. FOER, *On the Inefficiencies of Efficiency as the Single-Minded Goal of Antitrust*, AAI Working Paper No. 14-02, April 16, 2014, 7; E. BEINHOCKER, *The Origin of Wealth, Evolution, Complexity, And The Radical Remaking Of Economics*, 2006, 399: "... asking whether markets are efficient makes about as much sense as asking whether the ecosystem of the Amazon rain forest is efficient. Efficient compared to what?"

¹⁶ Qualifying efficiency as "economic efficiency" does not solve the problem. Not even the concept of economic efficiency can do without the definition of a precise goal. The decision of introducing capital intensive technologies may be economically efficient if the goal is that of increasing the profits of firms, but may be economically inefficient from the viewpoint of the protection of the interests of the employees.

¹⁷ Among the most recent, see, S. SALOP, *Question: What is the Real and Proper Antitrust Welfare Standard? Answer: The True Consumer Welfare Standard*, 22 *Loyola Consumer Law Rev*, 2010, 336; R. BLAIR, D. SOKOL, *The Rule of Reason and the Goals of Antitrust: An Economic Approach* 78 *Antitrust L.J.* 2012, 2, 4.

¹⁸ On the role of consumer welfare in competition enforcement across the global competition community, see International Competitive Network, *Competition Enforcement and Consumer Welfare – Setting the Agenda* (2010). On the role of consumer welfare in the European Union, see the then Commissioner N. KROES, *European Competition Policy—Delivering Better Markets and Better Choices*, Speech 05/ 512 (2005): "Consumer welfare is now well established as the standard the Commission applies when assessing mergers and infringements of the Treaty rules on cartels and monopolies". See also the European Commission's press release (3rd December 2008) announcing the Article 82 guidance paper headed *Antitrust: consumer welfare at heart of Commission fight against abuses by dominant undertakings*.

¹⁹ Much of the time these goals produce in practice the same results and are therefore indistinguishable: H. HOVENKAMP, *Distributive Justice and Consumer Welfare in Antitrust* 9 (2011), available at <http://ssrn.com/abstract=1873463>: "The volume and complexity of the academic debate on the general welfare vs. consumer welfare question creates an impression of policy significance that is completely belied by the case law, and largely by government enforcement policy. Few if any decisions have turned on the difference. In fact, antitrust policy generally applies both tests"). For more nuanced views A. MEESE, *Reframing the (False?) Choice Between Purchaser Welfare and Total Welfare*, 81 *Fordham Law Review*, 2013, 2197, 2199 (The choice between these two standards often will not matter for antitrust doctrine. At the same time, there is a subset of conduct that a "purchaser welfare" standard would condemn, but that a "total welfare" approach would leave unscathed and even applaud); J. JACOBSON, *Another Take on the Relevant Welfare Standard for Antitrust*, *The Antitrust Source*, 2015, "In most antitrust cases, the choice of welfare standard really does not matter, as the same results

Both perspectives try to give content to the notion of efficiency by recurring to the notion of “welfare maximization”, and in both the crucial datum, on which the antitrust evaluation of the relevant practices should depend, is the fact that the practice in question increases or decreases the welfare of the individuals concerned. The reference to the goal of “maximizing welfare” is their common theoretical core.

What I intend to criticize in this essay is just the idea that the goal of maximizing welfare can give precise content to the notion of efficiency and that the functioning of antitrust laws can be defined and limited by these two conceptual references (efficiency and welfare maximization). The criticism I will move to the idea that all antitrust ends boil down to the pursuit of something called “efficiency” applies to both theories, to that which uses the notion of consumer welfare and (in a sense, *a fortiori*) to the one that uses the notion of total welfare.

Thus, there is no reason of dwelling here on the problems of the more or less subtle differences between the two views.

The main criticism that can be levelled against the efficiency goal understood as maximizing (consumer or total) welfare, is that this end *does not provide any clear indication, for the majority of the relevant antitrust practices have different effects on different individuals, mostly increasing the well-being of some and decreasing that of others, with no possibility of establishing whether the algebraic sum is positive or negative.*²⁰

The occurrence of this phenomenon (different effects on the well-being of different individuals) is blatantly obvious if we adopt the total welfare criterion. Changes in market power of a given corporation have effects on the customers and the shareholders of the corporation, but also on the competitors, on the employees and on almost any other individual in the considered society. For instance, a merger between two oil companies may reduce the needed workforce and thus the costs of the resulting firm, potentially benefiting the shareholders and, if the reduction of costs translates in a reduction of prices, the consumers. In this case, it is rather obvious, however, that the merger may harm the competitors (if they exist); may harm the dismissed employees or even all employees, if the firm becomes a monopolist (and, therefore, from the viewpoint of its employees, a monopsony); may harm the environmentalists who regret that a decrease in the oil price can delay the development of renewable energy sources, etc.

will hold regardless of the standard applied”; for different views B. ORBACH, *The Antitrust Consumer Welfare Paradox*, 7 *Journal of Competition Law & Economics*, 133, 164 (The differences between the total surplus standard and consumer-oriented standards are substantial...); R. BLAIR, D. SOKOL, *Welfare Standards in US and EU Antitrust Enforcement*, 81 *Fordham L. Rev.*, 2012, 2497 (it is total welfare rather than consumer welfare that should drive antitrust analysis).

²⁰ Technical flaws and limitations of the notion of consumer or total welfare (other than that that inspires the criticism carried out in the text) are illustrated in J. COBSON, *Another take on the Relevant Welfare Standard for Antitrust*, *The Antitrust Source*, August 2015, p.5. See also J. DREXL, *On the (a)political character of the economic approach to competition law*, in *Competition Policy and the Economic Approach. Foundations and Limitations*, edit. J. DREXL, W. KERBER, R. PODSUN, Cheltenham / Northampton, 2011, 312- 337.

In this case, indeed quite simple, how the variations of well being experienced by each member of the various mentioned categories (and of the others potentially involved, the suppliers of the merged firms, for example) can be reliably measured? How can the algebraic sum of all these variations be calculated? We face here a calculation problem which is clearly insoluble, not only for practical reasons (lack of information about the amounts of the increases and decreases of welfare) but for deep theoretical reasons related to the well-known impossibility of adding or subtracting changes in well-being experienced by different individuals.

Even if we adopt the other alternative, and focus on the consumer welfare, leaving aside the welfare of the other potentially affected categories, the problems arising from the impossibility of adding up the increases and the decreases of well-being experienced by different people are far from disappearing.

In this perspective (only consumers count) it is obviously easier to imagine cases in which all, or almost all, are harmed by a practice (the so called “naked restraints” may provide some examples). But given that consumers have different, and often conflicting, interests, values, beliefs and ultimately preferences²¹ it is easy to realize that the majority of the practices relevant for antitrust law usually benefit some consumers and harm others.

The point can be illustrated by starting from some specific cases²², especially those involving conducts for which the efficiency theory has urged (and mostly got) an approach favouring the recognition of their legality.

We can illustrate the point starting with an example provided by *Kodak*²³, a symbolically “thick” case²⁴, in which purchasers of Kodak machines were forced to buy Kodak’s repair services and to service the copiers exclusively with the manufacturer’s original parts. One of the main problems was that of the ability of consumers to take into account (when purchasing the copier) the future costs of parts and services over the copier’s lifetime. Disregarding the peculiarities of the case (that was rather complex) we can note that in cases like this we usually have both, consumers able to exactly forecast these costs, who are consequently able to evaluate the convenience of the whole purchase (machine plus service), and, possibly, to benefit from the low price of the machine, and other consumers who miscalculate the future costs of the service and who, tempted by the low price of the machine, may make a very bad deal (for them).

We can then establish a first variable, which can ground the different effects that the same

²¹F. DENOZZA, *Aggregazioni arbitrarie v. “tipi” protetti: la nozione di benessere del consumatore deconstruita*, in *Giurisprudenza Commerciale*, 2009 I, 1057; see also Id., *Raising consumers’ costs as an antitrust problem*, in *Post-Chicago Developments in Antitrust Law*, ed. A. CUCINOTTA, R. PARDOLESI, R. VAN DEN BERGH, Edward Elgar 2002, 197.

²²An example, other than those below in the text, of conflict of interest between different classes of consumers (parallel trade in pharmaceuticals within the EU) is provided by J. DREXL, (nt.19), 319.

²³*Eastman Kodak Co. v. Image Tech. Servs. Inc.*, 504 U.S. 451, (1992).

²⁴Kodak could have been the first “post-chicago” decision. Instead it was one of the last of the U.S. Supreme Court in favour of the plaintiff (it took 17 years until 2010 in *NFL v. American Needle*, before another plaintiff finally won, M. HUFFMAN, *A Reluctant Standard-Bearer for Chicago-School Antitrust* available at SSRN: <https://ssrn.com/abstract=28067295>).

practice may have on various classes of consumers. It is the fact that different consumers have *different ability* of rationally calculating and forecasting , an ability which can be crucial to the wellbeing of consumers facing commercial offers that can prove convenient or harmful according to the occurrence, or non occurrence, of some future events.

In addition to differences in abilities, *differences in preferences* may be even more relevant. In the simplest cases, where only the price is considered, we can easily imagine that all consumers would prefer paying the lowest prices for the best quality (see however what will be observed below). In other, more complicated, cases, the assumed equality of preferences may not be upheld. Mostly relevant, especially in vertical restraints, is the difference between the preferences of the marginal consumer and those of the infra-marginal ones²⁵, for example with reference to the balance between retail price and level of services²⁶.

More in general, differences among the preferences of various classes of consumers can be relevant in many cases. An example is that of quality changes: in these cases the problem arising would be “how to balance a price increase that affects all consumers against a quality improvement that only some consumers demand”²⁷. Another example is provided by tying contracts, whose natural effect is that some combinations of goods become very expensive or disappear from the market (think of ships and sails: if ships are sold only with the sails produced by the seller, it becomes very difficult to have a ship made by A equipped with the sails made by B, or vice versa). We can easily imagine that some consumers will benefit from the (supposed) efficiencies made possible by the tie-in, but we cannot rule out the existence of other consumers who would have preferred a more expensive (in hypothesis), but for them more satisfying combination²⁸.

Another relevant factor (besides abilities and preferences)could be the *attitude towards risk*. Take for example the case of predatory pricing. We face here an alternative: preventing the dominant firm’s rebate of the price, or allowing the establishment of a price that, in case of the dominant firm’s succeeding in foreclosing the market, will be replaced by a monopolistic price yet higher than the price which existed before. Looking at the case from the viewpoint of the “consumer welfare” it is easy to discover that usually two different classes of

²⁵ W. COMANOR, *Vertical Price Fixing, Vertical Restrictions, and the New Antitrust Policy*, 98 *Harr. L. Rev* 1985, 983, 991”... societal gains or losses from changes in the product depend on the preferences of *all* consumers, not merely those at the margin. To the extent that such alterations fail to reflect the preferences of infra- marginal consumers, the interests of consumers in general may not be served”.

²⁶ P. REY, *Vertical restraints—an economic perspective*, Revised draft report (2012): 1, 14 “Firms and consumers may however disagree here on the desirable amount of retail services: the reason is that firms are primarily interested in the additional consumers they can attract by providing these services; they thus focus on marginal consumers, and tend to neglect the impact on infra-marginal consumers. Thus, if for example marginal consumers are willing to pay more for better services, whereas infra-marginal consumers would favour lower services and prices, then the firms may choose to increase the level of services (and the retail price, so as to cover the cost) even though doing so hurts the majority of consumers and decreases total welfare”. More in general, F. SCHERER, *The economics of vertical restraints*, 52 *Antitrust Law Journal*, 1983, 687-718.

²⁷ R. ALLENWORTH, *The commensurability myth in antitrust*, 69 *Vand. L. Rev.*, 2016, 1, 22.

²⁸ In addition, we can note that it is acknowledged that variable proportion tying contracts benefit some consumers while they harm others, H. HOVENKAMP, (nt. 19), 14.

consumers are present: risk adverse consumers, who prefer the status quo (and therefore the prohibition of any minimally dangerous attempt to monopolization) and risk taking consumers, who are eager to exploit the possibility of a decrease in the market price even at the risk of thereby encouraging a monopolization process. Given that the decision makers have no certainty about what will happen in the future (and even less about what may take place in markets dominated by large “predator” enterprises) and furthermore given that errors are statistically inevitable, it is evident that at the moment in which the decision makers choose whether to repress a practice of predatory prices, they will end up giving more weight to the preferences and to the well-being of one or of the other category of consumers.

We may further complicate the problems by introducing a “time factor”: how long will the low price last before the predator is able to recoup? How long will it take, before new competition moderates the monopoly price? The relevance of the time variable is evident: some consumers can more or less easily afford a year of monopolistic prices, for others nine months are already too much, and so on.

This perspective can be easily extended to other cases. The conflict between risk taking and risk adverse consumers²⁹ arises in all the cases in which the evaluation of the challenged conduct requires, as it is absolutely normal in antitrust matters, forecasts about the future performance of the market. As, for example, in the case of a merger which increases both, efficiencies and prices. In this case we are likely to have consumers who trust in the ability of future competition to compel a decrease of the prices and consumers who are not eager to take this risk. More in general, we can easily imagine that besides the consumers who are only interested in the increase of productive efficiency vaunted as a consequence of the merger, other consumers may legitimately be more concerned about the concentration of long-term economic and political power determined by the merger.

We examined cases in which consumers have different *abilities*, or *preferences*, or *attitudes* towards risk. There are eventually cases in which consumers can be imagined identical and nevertheless the reference to consumer welfare is still useless. An example is price discrimination, which involves charging different prices to different groups of consumers for the same good. Here we have a group benefitting from cheaper prices, whilst other consumers face higher prices. Usually, when price discrimination is prevented, the lower price (that charged in the first market) increases, whilst the higher price applied in the second market decreases. In other words, the non discrimination price lies usually in between the two prices under price discrimination. Therefore, consumers in the first market are made worse off, whilst consumers in the second market are made better off³⁰. The existence of an increase or a decrease of consumer welfare can not be established with absolute certainty.

²⁹ Note that the distinction is likely to stem much less from psychological attitudes, than from economic reasons linked to the different income of the different consumer.

³⁰ An exception may be provided by the possibility that the “...discrimination makes it possible to sell to markets that would not be served at all under single price monopoly”, see R. SCHMALENSEE, *Output and Welfare Implications of Monopolistic Third-Degree Price Discrimination*, 71 *Am. Econ. Rev.*, 1981, 242, 246.

4. How the efficiency theory made the antitrust myopic.

The above considerations show that the most important practices can usually benefit some consumers while harming others. Obviously this fact does not imply that all those practices are, from the antitrust viewpoint, equal, and that no good reason exists for prohibiting them. The point here is not that of denying that practices exist that, all things considered, are more favourable to consumers than others. The point is simply that even the practices more favourable to some consumers, may hurt a (more or less numerous, meritorious, worthy of consideration, etc.) group of other consumers. The consequence is that the final judgment is non technical (measuring whether consumer welfare increased or decreased) but political (evaluating the group of consumers that deserves protection and why). Every judgment on the welfare effects of a practice is unavoidably political in the sense that it ends up giving more value to the gains of some and lower value to the losses of others. It is a judgment of convenience about certain expected results and of preference for the interest of some people.

This does not imply the irrelevance of the welfare of consumers and of other individuals involved. The simple point is that increases and decreases of welfare cannot be calculated, but have to be evaluated according to the size of the group of the holders of the sacrificed interest, the worthiness of such interest, the magnitude of the sacrifice imposed, the amount of benefit received by the preferred interest holders, ecc. The efficiency theory hides the real nature of the antitrust evaluations by bragging as technical, judgments that are in fact political, and by making the antitrust blind to the most important factors which should guide its enforcement.

It is rather paradoxical that the goal of maximizing consumer welfare has been (and still is) presented as the goal able to give to coherence and certainty to the enforcement of antitrust law, where, instead, the notion of “consumer welfare” is undetermined. In the presence of consumers with conflicting interests the decision maker who wants to maximize “consumer welfare” should be able not just to *sum up* the increases and decreases that each decision might imply on the well-beings of the different consumers, but to *weigh* and *balance* the consequences that each possible solution may have on that of different consumer groups. This huge problem is usually avoided by simply replacing real consumers with a generic notion of consumer, imagined as a sort of “representative agent”. Consumers are portrayed “as a coherent, homogeneous and predictable mass”³¹, with the consequence of imagining the community comprising all consumers or, if you want (given that we are all consumers) the whole society, as a “big person”, as an organism within which we can imagine trade-offs between different needs, but not conflicts between different interests. As with reference to a human body no one could imagine an interest of the brain conflicting with the interest

³¹ N. OLSEN, *From Choice to Welfare: the concept of the consumer in the Chicago school of economics*, in *Modern Intellectual History*, Cambridge University Press , 2016.

of the stomach, so the efficiency theory is unable to perceive (even less to manage) a conflict between the interests of different classes of consumers. As Rawls³² noted for the utilitarianism, the efficiency theory ignores the separateness and distinctness of persons.

This reasoning comes at a price. The use of a notion of welfare which instead of promoting an analysis of the real situation of different groups of individuals, assumes that all differences can be superseded, in the blurred figure of a representative consumer, or, worst, in a conception of the whole society as an organism, is totally unacceptable and condemns the antitrust to ignore everything but the satisfaction of a mythical Leviathan.

The efficiency theory operates in fact as a blinder³³, making the antitrust blind to the complexity of the actual market and to the social, macroeconomic and systemic consequences of its enforcement.

5. A “disembedded” antitrust, blind to any social consequence.

One of the most claimed virtue of the efficiency theory is that of having freed antitrust law from the influence of arbitrary evaluations, by excising “fairness from the antitrust lexicon”³⁴ and disputable political objectives (as the protection of small business, the containment of private economic power, the defence of an economically pluralistic society, etc.) from the list of the goals of the law³⁵.

As I have already noted, the merit of having provided the enforcement of antitrust law with neutrality and certainty is totally usurped, for efficiency is a debatable objective and the enforcement of the law in accordance with this objective is no less uncertain and arbitrary than its enforcement in the light of the other goals branded as “political”.

Apart from this, we may wonder about the consequences of the exclusion of the “political” goals, and whether this exclusion is in fact a virtue.

From the viewpoint of the definition of the goals, the shift to the efficiency theory may be described (evoking a notion rich of theoretical implications) as a phenomenon of “disembedding”: the disembedding of antitrust law from the social structure, freeing its enforcement from any form of social concern.

I am aware that the relationship between economic and social values is in antitrust, even more than elsewhere, a very delicate matter. A coordination between the two orders of values can prove very problematic and it may also be maintained that the coordination is not

³² J. RAWLS, *A Theory of Justice*, Revised Edition, Harvard University Press, 1999, §§ 5 and 30.

³³ A. FOER, (nt. 15), 22.

³⁴ T. HORTON, *Fairness and Antitrust Reconsidered: An Evolutionary Perspective*, 44 *McGeorge Law Review*, 2013, 823, 824; D. BUSH, *Too Big To Bail: the Role o Antitrust in Distressed Industries*, 77 *Antitrust Law Journal*, 2010, 277, 279: any discussion of other motivations for antitrust enforcement, including concern about concentration of political power into the hands of a few large (multi-national) corporations, has been eliminated from antitrust discourse.

³⁵ F. BAXTER, *Responding to the Reaction: The Draftsman’s View*, 71 *Calif. L. Rev.* 1983, 618, 619 “... nonefficiency goals are too intractable to be used as enforcement standards”.

a task of the antitrust law, but a result that can be reached only through the combined intervention of many different institutions.

I think, however, that a complete disembedding of the antitrust law from social values and social concerns, has huge costs that are very well illustrated by the reflections of the author to whom we owe the most famous formulation of the concepts of embedded or disembedded economy.

In his most famous work Polanyi wrote “To allow the market mechanism to be sole director of the fate of human beings and their natural environment indeed, even of the amount and use of purchasing power, would result in the demolition of society”³⁶. This judgment is based especially on the fact that the market treats as commodities some “essential elements of industry”, labour, land and money, which are *not* commodities, in the sense that they are not produced for sale³⁷.

This phenomenon, the fact that “the commodity description of labor, land and money is entirely fictitious”³⁸, is the main source of the costs of disembedding antitrust law. By denying any weight to any kind of social needs, a disembedded antitrust law gives up every possibility of regarding labor, land and money not as commodities but as “human activity”, “nature” and “purchasing power”, respectively. In this way it participates in producing the effect of a disembedded economy, namely that, using Polanyi’s expression, of the demolition of society.

Leaving aside nature and money, it is easy to illustrate the point with reference to the fictitious commodity “labour”. As is well known, one of the most celebrated virtues of a competitive market is that of apportioning factors between different uses in accordance with the preferences of the consumers. If consumers prefer to ride horses rather than walk (and are able to pay for this luxury) the competitive market will provide incentives to breeding and selling horses to consumers. When consumers decide they prefer to go by car, the competitive market will provide incentives to slaughtering the existing horses that cannot be reused for more profitable purposes, and to manufacturing cars. And so on.

The problem reported by Polanyi is that the same logic cannot be applied to the workers employed in breeding horses and now made redundant by the use of robots in manufacturing cars. In Polanyi’s words “... the alleged commodity "labor power" cannot be shoved about, used indiscriminately, or even left unused, without affecting also the human individual who happens to be the bearer of this peculiar commodity. In disposing of a man's labor power the system would, incidentally, dispose of the physical, psychological, and moral entity "man" attached to that tag”³⁹.

³⁶ K. POLANYI, *The Great Transformation. The Political and Economic Origin of Our Time*, Beacon Press, 1957, 76.

³⁷ Id., 75.

³⁸ Id., 76.

³⁹ This is the reason why competition has the devastating effects on social cohesion highlighted by Polanyi and underestimated, or even ignored, by the current apologists of the market (even by those usually more attentive,

Antitrust law, in assuming efficiency as its sole goal, takes the responsibility of creating the conditions for the occurrence of just what is described by Polanyi. Efficiency, understood as optimal apportionment of factors according to the preferences of consumers, cannot be reached unless all resources, labour included, are treated as commodities. Treating labour as a commodity means that the needs of the human individuals who provide labour power are not taken into account and that those individuals have to be ready to be used at the least possible cost, to become superfluous, to be eliminated from the market, etc. In the end, they have to be ready to compete with one another like the different units of any other commodity⁴⁰.

May be, as I said, that this is not a problem that it is for antitrust law to solve. The question however remains whether it is appropriate that the issue be completely forgotten.

6. *An antitrust blind to macroeconomic consequences.*

One of the goals explicitly pursued, and largely achieved, by the proponents of the efficiency thesis, was that of decreasing the number of conducts forbidden by antitrust law⁴¹. In fact, many agreements and practices previously considered unlawful, were rehabilitated by the adherents to the efficiency thesis and considered as “per se” legal or subjected to a rule of reason evaluation very burdensome for the plaintiff, thereby becoming basically legal⁴². The overall result has been a marked reduction in the application of the antitrust⁴³.

as for example, M. LIBERTINI, *Competition and social cohesion*, *Rivista italiana di antitrust, Italian Antitrust Review*, 2014, 37).

⁴⁰ On the effect of unregulated monopoly power directly harming workers, see P. KRUGMAN, *Robots and robber barons*, *The New York Times*, Dec. 9, 2012: “We don’t talk much about monopoly power these days; antitrust enforcement largely collapsed during the Reagan years and has never really recovered. Yet Barry Lynn and Phillip Longman of the New America Foundation argue, persuasively in my view, that increasing business concentration could be an important factor in stagnating demand for labor, as corporations use their growing monopoly power to raise prices without passing the gains on to their employees”.

⁴¹ D. BUSH, (nt. 14), 297 the focus on traditional notion of efficiency “emphasizes price-fixing conspiracies as the dominant goal of antitrust, while ignoring mergers and other practices which might stifle innovation or other types of efficiencies”

⁴² For a list of examples see J. BAKER, *Economics and Politics: Perspectives on the Goals and Future of Antitrust*, 81 *Fordham Law Review*, 2013, 2175, 2184.

⁴³ M. WHITENER, *Editor’s Note: The End of Antitrust?*, *Antitrust*, Fall 2007, 5 :“The rhetoric and arguably, the enforcement records of the agencies — outside the cartel arena — are less activist now than at any time in recent years.”; D. GINSBURG, *Bork’s “legislative intent” and the courts*, 79 *Antitrust Law Journal*, 2014, 941, 950: “... judicial adherence to the consumer welfare standard has significantly narrowed the range of conduct within the condemnation of the Act.”; N. GIOCOLI, *Old Lady charm: explaining the persistent appeal of Chicago antitrust*, 6: “The outcome-based paradigm of the Chicago School was intended to minimize antitrust law, constraining its range to policing inefficient outcomes”; M. STUCKE, *Lessons from the Financial Crisis*, 77 *Antitrust Law Journal*, 2011, 313, 337: the importance of antitrust in the United States diminished during the Reagan administration and never recovered; D. BUSH, (nt. 14), 297.

The efficiency theory however claimed that the reduced application of antitrust law that it was proposing, would have increased, rather than diminished, the competitiveness of the market. In a substantial reversal of the traditional conception of the function of antitrust law, markets were imagined by the adherents to the efficiency theory as *normally and naturally tending* to increased efficiency and consumer welfare⁴⁴. In this vision, antitrust law should intervene only in the few and abnormal cases in which the spontaneous tendency of the market meets any obstruction. According to the scholars who share this vision, out of the cases of markets abnormally obstructed by any extraordinary factor, the intervention of antitrust law, far from ensuring the competitiveness of the market, will end up damaging it, along with consumer interest.

The paradoxical slogan, and prediction, of the efficiency theory is: less antitrust, more competition. Restricting application of antitrust law will result (this is the promise of the efficiency theory) in having more competitive markets and a greater dissemination of the benefits typically ensured by competitive markets.

Did the economic evolution actually occurred⁴⁵ in the recent decades of application of the efficiency theory recipe, validate this theory, along with its prediction and its promise? It does not seem to be so.

We can start from a fact whose occurrence in the last decades is beyond question, the fact that in this period of time inequality increased dramatically and consumers do not seem to have become collectively richer, as promised by the efficiency theory adherents⁴⁶.

Can we establish a causal link between lax antitrust enforcement, increase in market concentration⁴⁷ and inequality rise⁴⁸?

The first step (from lax antitrust to more concentration) can be easily established⁴⁹. We can note that the creation of the biggest firms is usually the effect of mergers much more than of internal growth⁵⁰, and antitrust would have all the weapons for fighting this phenomenon

⁴⁴ T. HORTON, *Fairness and Antitrust Reconsidered: An Evolutionary Perspective*, 44 *Mc George L. Rev.* 2014, 823, 830: “The Chicagoans believed that absent government interference and the injection of political, moral, and social goals into antitrust analyses, markets would naturally lead to increased efficiency and consumer welfare”.

⁴⁵ Economic evolution whose main features, as described by The White House, Council of Economic Advisers, Issue Brief, April 2016, *Benefits of Competition and Indicators of Market Power*, Apr. 2016, https://www.whitehouse.gov/sites/default/files/files/20160414cea_competition_issue_brief.pdf 6, are: “1) increasing concentration across a number of industries, 2) increasing rents, in the form of higher returns on invested capital, across a number of firms, and 3) decreasing business and labour dynamism”.

⁴⁶ A. ATKINSON, *Inequality*, Harvard University Press, Cambridge, London, 2015; E. WOLFF, *Household wealth trends in the United States, 1962-2013: What happened over the great recession?*, National Bureau of Economic Research, 2014; T. PIKETTY, *Le capital au XXIe siècle*, Seuil, Paris, 2013; J. STIGLITZ, *The Price of Inequality*, W.W. Norton & Company, New York – London, 2012;

⁴⁷ On the increase in concentration, see: T. FRANCIS, R. KNUTSON, *Wave of Megadeals Tests Antitrust Limits in U.S.*, *The Wall Street Journal*, updated Oct. 18, 2015 (A growing number of industries in the U.S. are dominated by a shrinking number of companies); T. HORTON, (nt. 44), 838 and note 111 (noticing a “... dramatic increase in concentration”).

⁴⁸ In the affirmative see L. KHAN, S. VAHEESAN, *Market Power and Inequality: The Antitrust Counterrevolution and its Discontents*, 11 *Harvard Law & Policy Review*, 2016, available at SSRN: <https://ssrn.com/abstract=2769132>; J. BAKER, S. SALOP, *Antitrust, Competition Policy and Inequality*, *Working Papers*. Paper 41 http://digitalcommons.wcl.american.edu/fac_works_papers/41; see also note 55 below.

⁴⁹ S. PEITZMAN, *Industrial Concentration under the Rule of Reason*. in *Journal of Law and Economics*, 2014, 101.

⁵⁰ The four largest U.S. banks (J.P. Morgan Chase, Bank of America, Wells Fargo and Citigroup) were the result

effectively⁵¹, without any need of envisaging new rules imposing deconcentration or other forms of “slimming”.

The second step is the most contested by the followers of the efficiency thesis. One of the cornerstone of the Chicago school, and of the efficiency thesis in general, is that markets are competitive regardless of the number of competitors, because entry barriers are supposed as typically small. Even a market with only one firm may be in this vision competitive, when it is contestable (entry in the market is quick and easy). In this case the firm, albeit monopolist, shall price competitively.

I think that what happened during the last decades does not fit the fairy tales of contestable markets⁵² (or of the extra profits fraternally shared between shareholders and employees). What really happened was a reduced application of antitrust law accompanied by high levels of concentration, increases in prices⁵³, high profits⁵⁴ and, eventually, by an increase of inequality just of the kind that can be theoretically predicted as a consequence of less competition⁵⁵.

Given that a solid theoretical relationship can be established between poorly competitive markets, supernormal profits and rising inequality⁵⁶, it seems at least very likely (if not even certain) that, lacking a strong antitrust enforcement, the supposed natural trend of the markets towards competitiveness has not been able to shelter consumers from monopolistic

of mergers, D. BAKER, *From Philadelphia National bank to too big to fail: how modern financial markets have outrun antitrust law as a source of useful structural remedies*, 80 *Antitrust law Journal*, 2015, 353.

⁵¹ Weapons that in recent years have not been used: see J. KOWKA, *Mergers, Mergers Control and Remedies: A Retrospective Analysis of U.S Policy*, MIT Press, 2005, 121: “All in all, both investigations and policy actions appear to err on the side of permissiveness, with the result that too few mergers are challenged, and too few of those that are challenged are subject to either adequate remedies or opposition by the antitrust agencies”.

⁵² A really contestable market is, in fact, a bit like a Phoenix. Even the contestability of the airline markets (once referred to as exemplary case) has been recanted. See E. BAILEY, W. BAUMOL, *Deregulation and the Theory of Contestable Markets*, 1 *Yale Jour. Of Reg.*, 1984, 111, 127; S. BORENSTEIN, *Airline Mergers, Airport Dominance, and Market Power*, 80 *Am. Ec. Rev.*, 1990, 400 (noting that airport dominance limits entrants' ability to attract passengers); S. BORENSTEIN, *Hubs and High Fares: Dominance and Market Power in the U.S. Airline Industry*, 20 *Rand J. Econ.* 1989, 344 (limited effect from potential competition); E. FRIEDMAN, *Airline Antitrust: Getting Past the Oligopoly Problem*, 9 *U. Miami Bus. L. Rev.* 2001, 121.

⁵³ The average outcome for the observations on postmerger prices made by J. KOWKA, (nt. 51), 155, is an increase in 4.3 percent.

⁵⁴ *Too much of a good thing: Profits are too high. America needs a giant dose of competition*, *The Economist*, Mar. 26, 2016; *The problem with profits: Big firms in the United States have never had it so good. Time for more competition*, *The Economist*, Mar. 26, 2016.

⁵⁵ The rise of inequality was originated especially by a shift of economic rents towards capital. J. STIGLITZ, *The Price of Inequality: How Today's Divided Society Endangers Our Future*. W. W. Norton & Company, 2012. In fact “the share of income going to capital has risen and the profit rate has risen” (J. FURMAN, P. ORSZAG, *A Firm-Level Perspective on the Role of Rents in the Rise in Inequality*, Presentation at “A Just Society” Centennial Event in Honor of Joseph Stiglitz Columbia University), which is just what a functioning competitive mechanism should prevent.

⁵⁶ On the ways in which high market concentration may increase inequality, see: J. BAKER, S. SALOP, *Antitrust, Competition Policy, and Inequality*, 104 *Geo. LJ Online*, 2015, 1, 9: “The returns from market power go disproportionately to the wealthy: increases in producer surplus from the exercise of market power accrue primarily to shareholders and the top executives, who are wealthier on average than the median consumer”; see also A. LEIGH, A. TRIGGS, *Markets, monopolies and moguls: The relationship between inequality and competition*, 49 *Australian Economic Review*, 2016, 389; S. VAHEESAN, *The Evolving Populisms of Antitrust*, 93 *Neb. L. Rev.*, 2014, 370.

exploitation. A vigorous antitrust enforcement could have contributed to ensure a broader distribution of the fruits of economic growth, thereby lessening the regressive wealth transfer occurred in the last three or four decades.

7. *An antitrust blind to systemic consequences.*

The emphasis on efficiency was accompanied by a shift of focus, from the consideration of the whole market structure, to the analysis of the effects of each specific practice. This is consistent with a more general shift of attention from the market to the individual transaction which characterizes neoliberal law as a whole⁵⁷.

In the antitrust law field, one of the specific (and tragic) effect of this shift has been the neglect of the general negative effects that the presence of very big firms can have on the functioning of the market, effects that the simplistic reference to efficiency, in the reductionist conception of maximizing welfare, is not able to grasp and to evaluate.

This is not the place to dwell on all forms of inefficiency related to the size and to the market power of business enterprises, from the so called X inefficiency⁵⁸ to the adverse impact on the incentives to innovate⁵⁹ (of the same monopolist and of the potential entrants).

It is sufficient here to recall the systemic problems posed by the rising market concentration and by the creation of firm too big to be allowed to fail. The financial crisis has shown that in a very concentrated market, the “hypothetical” existence of a strong competitive tension is not able to prevent the risks, especially in terms of lower market resilience⁶⁰, that are consequence of excessive concentration *per se*.⁶¹

Confidence that a minimum level of (supposed) market competitiveness is enough to prevent any trouble, led us to a financial crisis, which has been strongly exacerbated by the presence of firms “too big to fail” whose establishment had escaped out of control in terms of antitrust law⁶² (and, eventually, out of any control whatsoever). An antitrust blindly focused on the short - term impact of mergers proved unable to grasp the complexity of the phenomena⁶³

⁵⁷ F. DENOZZA, *La frammentazione del soggetto nel pensiero giuridico tardo-liberale*, *Riv.dir. comm.*, 2014, I, 13.

⁵⁸ R. FRANTZ, *X-efficiency and allocative efficiency: What have we learned?*? 82 *The American economic review*, 1992, 434; Id. *Antitrust and X-Efficiency*, 60 *The Antitrust Bulletin*, 2015, 221.

⁵⁹ S. AHN, *Competition, Innovation and Productivity Growth: A Review of Theory & Evidence* 5 (OECD Econ. Dep’t Working Paper No. 317, 2002) available at <http://dx.doi.org/10.1787/182144868>, 160.

⁶⁰ N. HAWKER, T. EDMONDS, *Avoiding the Efficiency Trap Resilience, Sustainability, and Antitrust*, 60 *The Antitrust Bulletin*, 2015, 208; R. ULANOWICZ, S. GOERNER, B. LIETAER, R. GOMEZ, *Quantifying sustainability: resilience, efficiency and the return of information theory*, 6 *Ecological complexity*, 2009, 27.

⁶¹ The negative effect of the market concentration in itself, regardless of the degree of competitiveness is very clear with regard to the financial services industry, but it is not exclusive to this market: M. STUCKE, *Lessons from the Financial Crisis*, 77 *Antitrust law Journal*, 2010, 313, 316.

⁶² R. KRAMER, *Mega-Mergers” in the Banking Industry* (Apr. 14, 1999), available at <http://www.justice.gov/atr/public/speeches/214845.pdf.> We heard numerous complaints that Citigroup would have an undue aggregation of resources--that the deal would create a firm too big to be allowed to fail. But, we essentially viewed this as primarily a regulatory issue to be considered by the FRB”.

⁶³ Especially with the paradoxical coexistence of a (supposed) intense competition (a fact that in the vision of the efficiency theory is in itself sufficient to rule out antitrust interventions) and high profits. J. CROTTY, *If*

and the longer - term risks and costs posed by the increase in concentration⁶⁴.

8. The antitrust enforcement: not a matter of “consumer welfare”, but a matter of balancing the interests of some consumers against the interests of other consumers.

Now we can go back to the general problems of the interpretation of antitrust law and to that specific to *Huawei*.

The efficiency theory admits that often, especially when (as it is in *Huawei*) innovation is involved, the evaluation of possible anticompetitive conducts is not a matter of calculating and adding, but a matter of balancing and weighing⁶⁵. Today⁶⁶ is commonly accepted that antitrust interventions promoting static efficiency may erode the firms' rents that stimulate and finance innovation thereby contrasting with the goal of sustaining and promoting dynamic efficiency. In the efficiency theory vision, a balancing is needed between boosting the so called dynamic efficiency, with the possible consequence of tolerating the exploitation of market power positions that are supposed necessary to induce innovation, and preserving the allocative efficiency, that would require the demolition (or, at least, the reduction of the profitability) of the market power positions⁶⁷.

financial market competition is intense, why are financial firm profits so high? Reflections on the current ‘golden age’ of finance, 12 *Competition & Change*, 2008, 167-183.

⁶⁴ M. STUCKE, (nt. 61), 322.

⁶⁵ D. CRANE, *Rationales for Antitrust*, *The Oxford Handbook of International Antitrust Economics* 1, 2014, 1.5 (acknowledging that in some instances antitrust interventions may improve economic efficiency in the short run but stymie innovation in the long run); M. SCHILLING, *Towards Dynamic Efficiency: Innovation and its Implications for Antitrust*, 60 *The Antitrust Bulletin*, 2015, 191,192, antitrust laws must pursue “an appropriate balance between short-run static efficiencies such as reducing costs and maximizing consumer surplus (productive efficiency and allocative efficiency) with longer-term efficiencies that arise from innovation”; G. GUNDLACH, D. MOSS, *The Role of Efficiencies in Antitrust Law: Introduction and Overview*, 60 *The Antitrust Bulletin* 2015, 91, 95 (“...different operationalizations of the efficiency standard are advanced in antitrust based on different weights to be given to each type of efficiency...”); W. KOLASKY, A. DICK, *The Merger Guidelines and the Integration of Efficiencies into Antitrust Review of Horizontal Mergers*, 71 *Antitrust L.J.* 2003, 207, 247-48: “The dynamic efficiency principle, most closely associated with Austrian economist Joseph Schumpeter, suggests that the short-run costs associated with allocative and productive inefficiencies stemming from market power can more than be offset by benefits from encouraging dynamic efficiencies through ‘creative destruction’ ”; D. J. SIDAK, D. TEECE, *Dynamic Competition in Antitrust Law*, 5 *J. Competition L. & Econ.*, 2009, 581; See A. DEVLIN, M. JACOBS, B. PEIXOTO, *Success, Dominance, and Interoperability*, 84 *Ind. L.J.*, 2009, 1157, 1196-97;

⁶⁶ At the beginning the central idea of the efficiency theory was that of maximizing the (consumer or total) welfare by improving the allocation of existing resources. The dominant conception of efficiency was essentially static. Bork (nt. 8), 91, 104-106, considers productive efficiency (which is a type of static efficiency, G. GUNDLACH, D. MOSS, 93) but is not concerned with dynamic efficiency, innovation, etc. (Schumpeter is not even present in the subject index). Very soon it was yet necessary to come to terms with the obvious consideration that the “true” maximization depends much more on creation of new resources (especially by technical progress) than on simple reallocation of those existing. Hence the evolution, towards an increased importance of innovation, perceived by someone as the “tectonic rumblings shaking the very ground that has supported antitrust since the mid – 1970”, so R. PERITZ, *Dynamic efficiency and US antitrust policy, Post-Chicago Developments in Antitrust Law*, Edward Elgar, 2002,108.

⁶⁷ Basically, the theoretical model underpinning the intellectual property laws (market power as a means to compensate and stimulating innovators) is generalized and extended to any form and kind of innovation and in fact the tension between static and dynamic efficiency becomes more apparent in cases involving the exercise

This way of framing the relevant balancing as a balance between static v. dynamic efficiency, is rather misleading. Consistent with the flawed theoretical vision which inspires the efficiency theory, the relevant balancing is presented as if it originated from a trade-off between two different alternatives regarding the satisfaction of the needs of just a same, unique, person. Society at large, or consumers, are imagined as a single individual who has to goals is therefore framed as an evaluation of the *different effects* that each choice can have on the *unique* interest of the same individual.

I maintain instead that the ascertainment of antitrust violations, including the specific case of the conflict between patent and antitrust, involves a balancing not of *effects* but of *conflicting interests* pertaining to *different classes of consumers*.⁶⁸

The flawed assumption of the efficiency theory is that all consumers are equally interested both in encouraging innovation and in preserving competition. Given this assumption, the existence of a universally shared goal (that of having as much innovation as possible, consistent with the preservation of a given degree of competitiveness) can be imagined, and the patent/antitrust conflict can be understood as a matter of looking for the right mix of incentives and disincentives.

The assumption of a universally shared goal is in my opinion untenable. We are not all equally interested in innovation⁶⁹ and, above all, as we will immediately see, we are not interested in the same *type* of innovation

Notoriously innovation is fostered by two different mechanisms, that impact very differently on the interests of different classes of consumers⁷⁰. The first is the competitive process itself,

of intellectual property rights and most probably reaches its peak in case of dominant firms refusing to license patents or to supply patented products, category in which even *Huawei*, albeit with all its peculiarities, falls.

Obviously this orientation is heavily in debt to the theories of Schumpeter, who notoriously maintained that in respect to economic progress "... perfect competition is ... inferior, and has no title to being set up as a model of ideal efficiency", J. SCHUMPETER, *Capitalism, Socialism, and Democracy*, Harper, 1950, third edition, p. 106.

⁶⁸ With the consequence that the existence of a common parameter provided by the notion of *consumer welfare* or *consumer harm* (notions that are obviously empty and inappropriate where the problem is just that of resolving cases in which conflicts *between* groups of consumers exist) is simply an illusion.

⁶⁹ Innovation has costs, namely the costs arising from the discontinuation of old products, old production techniques, old organizational structures, etc. Innovation has huge intrinsic costs, so that, as is well known, Schumpeter characterized it as a process of creative *destruction* (the fact that today dominates the tendency to put in shadow the importance of the second term of the binomial, is not a good reason for completely ignoring it!).

Given that society must bear the costs of "destruction", it follows that innovation cannot be considered as an objective as such (its desirability depends on the magnitude of the costs of the "destruction" implied by the process) and that consumers cannot be presumed to be all equally interested in innovation (it depends on the distribution of the "destruction" costs). The optimal level of innovation does not correspond to the maximum attainable level and cannot be established a priori.

The fact that "...the optimal amount and rate of advancement through innovation for a given economic system or firm is not well understood" is widely acknowledged, see e.g. G. GUNDLACH, D. MOSS, (65), 94.

⁷⁰ For a survey of the literature on the sources of innovation and on the relationship between competition and innovation, see C. SHAPIRO, *Competition and innovation: did arrow hit the bull's eye?* In: *The rate and direction of inventive activity revisited*. NBER, Cambridge MA, 2011; C. SYVERTON, *What Determines Productivity?* 49 *Journal of Economic*

where firms innovate as competition forces them to do so, given that the firms that do not innovate (or do not rush to imitate the innovations made by other firms) are most likely doomed to be expelled from the market⁷¹. Where this mechanism obtains, firms innovate for fear of the punishment that the market imposes on the firms that do not do so⁷². A second mechanism is the incentive provided by the possibility to create innovations that competitors cannot imitate. Here firms innovate because they are attracted by the premium (the extra-profit) that the market mechanisms, possibly boosted by the establishment of intellectual property rights, guarantee to firms in a monopolistic position⁷³.

A difference between the two mechanisms is that whilst innovation generated through competition is funded by the gains guaranteed to the innovating firms by the erosion of the profit margins of firms that are not able to innovate with the same speed, innovation produced by monopolistic positions is financed by consumers. In this context, the assumption that the latter mechanism increases the level of innovation provided by the first (an assumption which is by no means certain⁷⁴), is very far from implying that the “monopolistic” mechanism meets the interests of all consumers.⁷⁵ In fact, in the patent

Literature 2011, 326; see also M. PENEDED, M. WORTER, *Competition, R&D and Innovation: Testing the Inverted-U in a Simultaneous System*, WIFO Working Papers, No. 448, 2013.

⁷¹ For a general survey of the literature, see R. GILBERT, *Competition and Innovation*, 27-1-2007, at <http://www.escholarship.org/uc/item/9xh5p5p9>. A well-known issue in the theory of industrial organization is whether there exists a direct (K.J. ARROW, *Economic welfare and the allocation of resources for invention*, in *The Rate and Direction of Inventive Activity*, R. NELSON, ed., Princeton University Press, 1962) an inverse (according to the so-called Schumpeterian hypothesis), or an inverted-U (P. AGHION, N. BLOOM, R. BLUNDEL, R. GRITH, P. HOWITT *Competition and Innovation: An inverted-U relationship*, *Quarterly Journal of Economics*, May 2005, pages 701-728, 2005) relationship between the intensity of competition and the pace of technical progress. In any case, apart from the debate over what market structure is the most efficacious, the fact that competition itself acts as a spur to innovation seems undeniable, see M. BOLDWIN, D. K. LEVINE, *Perfectly Competitive Innovation*, (rev. 2006) available at http://levine.sscnet.ucla.edu/papers/pci_august06.pdf; (underlining “the plain fact that competitive innovation is pervasive in history and nowadays”); for a review of economic evidence M. LEMLEY, *Property, Intellectual Property, and Free Riding*, 83 *Texas Law Rev.*, 2005, 1031.

⁷² “It is competitive pressure that forces firms to run as fast as they can in an innovation race just to keep up with the others”, W. BAUMOL, *The Free-Market Innovation Machine*, Princeton University Press, 2002, 50;

⁷³ Even if one accepts the view that innovation must be encouraged by ensuring special reward to innovators, the problem of keeping a certain degree of competitiveness remains. First of all, because “the incentive to perform R&D depends not on the rents of a successful innovator *per se* but rather on the innovator’s *incremental rents*” therefore a monopolist enjoying monopoly rents has a weaker incentive to innovate, P. AGHION, C. HARRIS, P. HOWITT, J. VICKERS, *Competition, Imitation and Growth with Step-by-Step Innovation*, 68 *Review of Economic Studies*, 2001, 467, at 468. Secondly, because lacking competitive pressure, the majority of the benefits of innovation are likely to be captured by the monopolist in the form of additional economic profits, see M. REKSULAK, W. SHUGARTII, R. TOLLISON, *Innovation and the Opportunity Cost of Monopoly*, 29 *Managerial and Decision Economics*, 2008, 619, at 623.

⁷⁴ J. BARNETT, *Property as Process: How Innovation Markets Select Innovation Regimes*, 119 *Yale Law Journal*, 2009, 386, quoting the famous statement delivered in 1958 by Fritz Machlup to a Senate subcommittee (“if we do not have a patent system, it would be irresponsible...to recommend instituting one. But since we have had a patent system for a long time, it would be irresponsible... to recommend to abolish it”) and noting that “while we certainly have a considerably improved theoretical and empirical understanding on localized points of interest” the Machlup’s statement “still characterizes our current understanding of the net social value of the intellectual property system as a general matter”.

⁷⁵ “It is clear that the innovation compensated by the monopoly profits favours those consumers that can afford to pay the extra-profit, while it harms those consumers that cannot afford the innovation at a monopoly price. It harms namely categories of people that cannot access that resource supplied on the market” M.

system, patent holders appropriate, along with the patented inventions, the innovation that is “latent” in the common knowledge and the inventions that would have been made in any case, also in the absence of the patent incentive⁷⁶. Therefore we can easily imagine that many consumers may prefer the innovation granted by the mechanism of competition, which proceeds (hypothetically) more slowly, but is less expensive for them, than the faster (in hypothesis), but more expensive innovation that is fostered by the search for profitable market power positions. With a consequent, obvious conflict between the interests of the two groups of consumers.

I maintain in conclusion that reference to innovation is not able to provide the basis for the construction of a higher principle capable of transforming a conflict between interests and principles, into a conflict between effects. The conflict between the protection of a patent holder and the defence of an appropriate level of rivalry among competing firms, is not akin to an intra-individual conflict of incompatible goals. On the contrary, it is a conflict between different classes of consumers bearing opposing interests⁷⁷. The balancing between protecting the patent holder and defending the competitiveness of the market, is therefore not a balancing of effects, but a balancing of interests pertaining to two different social groups.

9. Concluding remarks: the main question missing in the *Huawei* reasoning.

Influenced by a widespread culture that has concealed all material conflict of interests, the Court in *Huawei* thought that the description of a series of moves and countermoves were

MAUGERI, *Abuse of Dominant Position: A System of Undistorted Competition or Social Protection?*, 2 *European Review of Contract Law*, 2006, 250 at 255.

⁷⁶ F. MACHLUP, *Knowledge. Its creation, Distribution and Economic Significance*, Vol. III, Princeton, 1984, 164: “many of the inventions filed with the patent office may have been made in any case that is also in the absence of a patent system and many others would have been made only a little later, so that the patent incentive could be credited at best for the gains due to the earlier emergence of the invention”.

Is therefore not true which is so often repeated, namely that the patent owner appropriates something not existing before. The patent system deprives the public domain of the benefit of the slower (in hypothesis), but inevitable progress that would still occur even in the absence of the patent system. The magnitude of this effect depends largely on the requirements for patentability. The appropriation of latent knowledge that characterizes the system of non obviousness would have been much more difficult in a system requiring a “flash of creative genius”. The problems related to this aspect of the patent protection are well discussed in the famous Thurman Arnold’s opinion in *Potts v. Coe*, 145 F.2d 27 (D.C. Cir. 1944): “... we apply the fundamental principles of the patent law to the actual facts of the complex modern technology of corporate research laboratories. These principles are (1) that a discovery which is the result of step-by-step experimentation does not rise to the level of invention; (2) that invention must rise above the level of accomplishment of the ordinary skilled technicians engaged in the art..... Unless we do so the patent law may become a cloak under which a corporate group may prevent the independent use of modern technical information by obtaining patents on the step-by-step progress of scientific knowledge”.

⁷⁷ “...to argue that antitrust intervention is horribly dangerous because one cannot exclude that an intervention today may probably hinder or postpone innovations in the future, is not far away from asking consumers today to pay the bill for hoped-for innovations of already very powerful companies which will probably never materialise” C. EWALD, *Competition and Innovation: Dangerous Myopia of Economists in Antitrust?* 4 *Competition Policy International*, 253, at 262, (2008).

able to solve the problem, as if its task was that of dictating the rules of a ballet. So the European Court did not even address the fundamental question that should have been answered. The question here is not whether to protect the interest of Huawei (the patent holder) thereby boosting innovation, or of ZTE (the maker) thereby promoting competition. The real important question is whether in this specific case the consumers who prefer less innovation, intensely competitive markets and cheaper goods, or the consumers who prefer more innovation, even at the cost of having less competitive markets and, consequently, higher prices, are more worthy of protection. Further choices, as that of ensuring the patent holder higher (lower) royalties or stiffer (more lax) protection, depend on this basic judgment.

As any judgment based on balancing even the antitrust balancing in general and that in *Huawei* in particular, should be subjected to the “Law of Balancing” which, in its simplest and more efficacious description, implies that “the greater the degree of non - satisfaction of, or detriment to, one right or principle, the greater must be the importance of satisfying the other”⁷⁸. In the present context, correctly defined as a field of conflicts between the two categories of consumers that we have described before (consumers preferring a fast and expensive, and others preferring a slower and cheaper, innovation) we should consider that giving the patent holder the right of seeking an injunction, that can prevent the entry in the market of a new potential maker⁷⁹, carries out an extraordinary degree of non - satisfaction of the interest of the latter group of consumers. In this hypothesis the consumers have to bear a situation of market power without even having the possibility of resorting to a second best (compared to the patented product) alternative, excluded by the fact that it is not technically possible to make devices which comply with a standard without infringing the respective SEPs. This extreme level of non- satisfaction, if acceptable at all, should be permitted only in the most exceptional cases in which the importance of satisfying the opposed interest is enormous, which occurs just where the technical value of the standard essential patent is in itself very large, where its technical superiority to non-patented products (or to other patents) is very high, and where its commercial value is not simply due to the fact that it was chosen as a SEP.

In conclusion, in cases of injunctions requested by holders of FRAND – pledged SEPs against makers ready to pay a fair royalty, the general rule that accessing the court is a fundamental right ensuring the rule of law and “it is only in wholly exceptional circumstances that the fact that legal proceedings are brought is capable of constituting an abuse of a dominant position...”⁸⁰ should be, simply, reversed. The abusive nature of applying for an

⁷⁸ R. ALEXY, *On Balancing and Subsumption. A Structural Comparison*, 16 *Ratio Juris*, 2003, 433, 436.

⁷⁹ An injunction notoriously would have “devastating effects” on the implementer’s business (see e.g. D. GERARDIN, *Frand arbitration: the determination of fair, reasonable and non-discriminatory rates for seps by arbitral tribunals*, *Competition Policy International*, September 2016).

⁸⁰ *ITT Promedia NV v. Commission*, T-111/96, EU:T:1998:183; *Huawei v ZTE*, 46 – 47. See also European Commission, Case AT.39985 - *Motorola - Enforcement of GPRS standard essential patents*, 29 April 2014, C(2014) 2892 final, par.278 “Finally, a patent holder, including a holder of SEPs, is generally entitled to seek and enforce injunctions as part of the exercise of its IP rights. The seeking and enforcement of injunctions cannot therefore,

injunction by a patent holder in a dominant position arising from the fact that its patent has been chosen as SEP, ought to be excluded only in the exceptional cases of patents on very important inventions.

in itself, constitute an abuse of a dominant position. The exercise of an exclusive right by its owner may, however, in exceptional circumstances and absent any objective justification involve abusive conduct. The list of exceptional circumstances is not exhaustive”.

THE CJEU JUDGMENT IN THE HUAWEI/ZTE CASE: GETTING AROUND THE PROBLEM OF FRAND COMMITMENTS AND COMPETITION LAW

VINCENZO MELI*

Sommario: 1. The context. – 2. The CJEU and the issue of dominance of SEP holders. – 3. The construction of the abuse. The approaches of the German case-law and the EU Commission. – 4. The assessment of the abuse by the CJEU.

1. *The context.*

The Huawei preliminary ruling of the CJEU⁽¹⁾ originates from a dispute before a German court, initiated by Huawei, which sued another Chinese firm, ZTE, for patent infringement, seeking an injunction, as well as compensation for damages, product recall, and the disclosure of accounting data relating to the unauthorized use of a patent. The

* Professore ordinario, Università di Palermo.

¹ CJEU (Fifth Chamber) 16.07.2015, Case C-170/13, Request of a preliminary ruling under Article 267 TFEU from the Landgericht Düsseldorf (Germany), made by decision of 21 March 2013, received at the Court on 5 April 2013, in proceedings Huawei Technologies Co. Ltd v. ZTE Corp., ZTE Deutschland GmbH. The five questions the German court addressed to the Court were the following:

"1) Does the proprietor of [an SEP] which informs a standardisation body that it is willing to grant any third party a licence on [FRAND] terms abuse its dominant market position if it brings an action for an injunction against a patent infringer even though the infringer has declared that it is willing to negotiate concerning such a licence?

or

Is an abuse of the dominant market position to be presumed only where the infringer has submitted to the proprietor of the [SEP] an acceptable, unconditional offer to conclude a licensing agreement which the patentee cannot refuse without unfairly impeding the infringer or breaching the prohibition of discrimination, and the infringer fulfils its contractual obligations for acts of use already performed in anticipation of the licence to be granted?

(2) If abuse of a dominant market position is already to be presumed as a consequence of the infringer's willingness to negotiate:

Does Article 102 TFEU lay down particular qualitative and/or time requirements in relation to the willingness to negotiate? In particular, can willingness to negotiate be presumed where the patent infringer has merely stated (orally) in a general way that it is prepared to enter into negotiations, or must the infringer already have entered into negotiations by, for example, submitting specific conditions upon which it is prepared to conclude a licensing agreement?

(3) If the submission of an acceptable, unconditional offer to conclude a licensing agreement is a prerequisite for abuse of a dominant market position:

Does Article 102 TFEU lay down particular qualitative and/or time requirements in relation to that offer? Must the offer contain all the provisions which are normally included in licensing agreements in the field of technology in question? In particular, may the offer be made subject to the condition that the [SEP] is actually used and/or is shown to be valid?

(4) If the fulfilment of the infringer's obligations arising from the licence that is to be granted is a prerequisite for the abuse of a dominant market position:

Does Article 102 TFEU lay down particular requirements with regard to those acts of fulfilment? Is the infringer particularly required to render an account for past acts of use and/or to pay royalties? May an obligation to pay royalties be discharged, if necessary, by depositing a security?

(5) Do the conditions under which the abuse of a dominant position by the proprietor of a[n SEP] is to be presumed apply also to an action on the ground of other claims (for rendering of accounts, recall of products, damages) arising from a patent infringement?"

patent in question had been declared essential for the implementation of the LTE standard (a 4G wireless broadband technology) developed by ETSI (European Telecommunications Standard Institute), and in compliance with ETSI Rules of Procedure Huawei had committed to license it on fair, reasonable, and not discriminatory (FRAND) terms (²). The defendant had requested the license, and the plaintiff, at least in principle, did not refuse it, but the parties did not agree on the conditions. Countering the judicial initiative of Huawei, the defendant claimed this was an abuse of dominant position under German competition law (GWB).

In recent years, several similar disputes where alleged infringement of essential patents is no ordinary patent forgery, but the consequence of failure to implement FRAND commitments, have been brought before the courts of some Member States. The solutions proposed and the conceptual tools used to address these conflicts are various. With an extreme simplification, three main approaches can be distinguished and sometimes they may even coexist in the same judgment:

- a) the contractual approach, which essentially focuses on the binding effect of FRAND commitments under contract law (³);
- b) the IP law approach, which handles the alleged violation of FRAND commitments in terms of possible patent misuse (⁴);
- c) the antitrust approach, which focuses on the possible infringement of Article 102 TFEU (or a similar national norm) by the SEP holder.

² Article 4.1. of ETSI Rules of Procedure provides that “... each MEMBER shall use its reasonable endeavours, in particular during the development of a STANDARD or TECHNICAL SPECIFICATION where it participates, to inform ETSI of ESSENTIAL IPRs in a timely fashion. In particular, a MEMBER submitting a technical proposal for a STANDARD or TECHNICAL SPECIFICATION shall, on a bona fide basis, draw the attention of ETSI to any of that MEMBER's IPR which might be ESSENTIAL if that proposal is adopted”; on this basis Article 6.1 states that “When an ESSENTIAL IPR relating to a particular STANDARD or TECHNICAL SPECIFICATION is brought to the attention of ETSI, the Director-General of ETSI shall immediately request the owner to give within three months an irrevocable undertaking in writing that it is prepared to grant irrevocable licences on fair, reasonable and non-discriminatory (“FRAND”) terms and conditions under such IPR to at least the following extent:

- MANUFACTURE, including the right to make or have made customized components and sub-systems to the licensee's own design for use in MANUFACTURE;
- sell, lease, or otherwise dispose of EQUIPMENT so MANUFACTURED;
- repair, use, or operate EQUIPMENT; and
- use METHODS.

The above undertaking may be made subject to the condition that those who seek licences agree to reciprocate”.

³ The issue of the legal nature of FRAND commitments under contract law is widely debated in Europe. German legal scholars and courts are internally divided. Some courts held that the FRAND declaration must be equated to a *pactum de non petendo*, i.e. a commitment to not sue the SEP users until the subscription of a license agreement; others think that it commits the SEP holder to grant a license. Among legal scholars the view has also been expressed that the FRAND declaration has no relevance as an obligation, and that it is a contract for the benefit of a third party (see T. KÖRBER, *Standardessentielle Patente. FRAND-Verpflichtungen und Kartellrecht – Standard Essential Patents, FRAND Commitments and Competition Law*, Nomos Verlag, Berlin, 2013, 38 ff., (188 ff.)). In Italy, M. LIBERTINI, *Autonomia individuale e autonomia d'impresa*, in M. MAUGERI, G. GITTI, M. NOTARI (eds.), *I contratti per l'impresa. I. Produzione, circolazione, gestione, garanzia*, Il Mulino, Bologna, 2013, 57 s., and M. MAUGERI, *Standardization and Italian Law of Contracts: F/RAND Commitments*, in *Osservatorio del diritto civile e commerciale*, 1/2014, pp. 99-138, have dealt with the issue and both have expressed the view that FRAND commitments are contractual obligations.

⁴ See D. LYM, *Patent Misuse and Antitrust Law: Empirical, Doctrinal and Policy Perspectives*, 2013, p. 203 ff.

An overview of the case-law in the Member States reveals that the practicability of the latter is not unanimously agreed upon. It has been particularly embraced by a conspicuous German case-law, but a strong support to this approach comes from the EU Commission, which in recent years has been very active in countering possible abuses of dominance by SEP holders (⁵). The last decisions were adopted in 2014 against Motorola and Samsung (⁶). Regardless of the legal provisions whose application is required, the judicial assessment in these disputes cannot neglect the conduct of the parties in the negotiation, nor can it ignore the determination of what “fairness” and “reasonability” of the negotiated conditions mean. This is especially relevant where the dispute - following the defendant’s exception - was hinged on the framework of antitrust law. Despite the strong criticism this model has met in the legal and economic literature (⁷), in the view of the Commission FRAND commitments play a crucial role in the balance between the benefits in terms of welfare and the competitive risks of standardization agreements (⁸).

⁵ See the *press releases* of 31 January 2012, IP/12/89 (http://europa.eu/rapid/press-release_IP-12-89_en.htm); 21 December 2012, IP/12/1448 (http://europa.eu/rapid/press-release_IP-12-1448_en.htm); 3 April 2012, IP/12/345 (http://europa.eu/rapid/press-release_IP-12-345_en.htm); 6 May 2013, IP/13/406, available at http://europa.eu/rapid/press-release_IP-13-406_en.htm. See also the memo (MEMO/13/403 at http://europa.eu/rapid/press-release_MEMO-13-403_en.htm), which exposes the policy of the Commission on the topic in the form of questions & answers.

Previously the Commission had initiated some proceedings without reaching a decision. In particular, because of the lack of evidence and the withdrawal of complaints, it had abandoned an investigation (initiated on 1 October 2007) against Qualcomm regarding the level of fees requested by the firm to grant a license on SEPs (see MEMO/09/516, of 24 November 2009); it had closed a similar case initiated against Rambus with commitments (see MEMO/09/544, of 9 December 2009); eventually, because of the withdrawal of complaints by Nokia and the assumption of the commitment to grant a license on FRAND terms, it had closed a case against IPCOM (see MEMO/09/549, of 10 December 2009).

⁶ EU Commission, 29 April 2014, Case AT.39985 — Motorola-Enforcement of GPRS standard essential patents, and Case AT.39939 – Samsung-Enforcement of GPRS standard essential patents. Both decisions are identical. Therefore, from now on we will quote only the first.

⁷ See J. LERNER, J. TIROLE, *Standard-Essential Patents*, in *Journal of Political Economy*, Vol. 123, n. 3, June 2015, 547; M. LEMLEY, C. SHAPIRO, *Patent Holdup and Royalty Stacking*, in 85 *Texas L. Rev.* 1991 (2007); J. FARRELL, J. HAYES, C. SHAPIRO, T. SULLIVAN, *Standard Setting, Patents, and Hold-up*, 74 *Antitrust L. J.* 603 (2007); E. ELHAUGE, *Do Patent Holdup and Royalty Stacking Lead to Systematically Excessive Royalties?*, in *Journal of Competition Law and Economics*, 2008, 535; J. G. SIDAK, *Patent Holdup and Oligopsonistic Collusion in Standard-setting Organizations*, in *Journal of Competition Law & Economics*, 2009, 123; T.F. COTTER, *Patent Holdup, Patent Remedies, and Antitrust Responses*, in *The Journal of Corporation Law*, 2010, 1151; A.L. FARRAR, A.J. PADILLA, *Assessing the Link Between Standard Setting and Market Power*, in *International Journal of IT Standards and Standardization Research*, 9(2), 19-49, July-December 2011; C. SHAPIRO, *Injunctions, Hold-Up, and Patent Royalties*, in *Am. Law and Economics Rev.*, 2010, 1. For a critical review, see D. GERADIN, M. RATO, *Can Standard-Setting lead to Exploitative Abuse? A Dissonant View on Patent Hold-Up, Royalty Stacking and the Meaning of FRAND*, in *European Competition Journal*, 2007, 101. For an overview on the subject of FRAND commitments, see, most recently, T. F. COTTER, *The Comparative Law and Economics of Standard-Essential Patents and FRAND Royalties*, in *Texas Intellectual Property Law Journal*, 2014, 311. On RAND commitments, see J.S. MILLER, *Standard Setting, Patents, and Access Lock-In: RAND Licensing and the Theory of the Firm*, 40 *Ind. L. Rev.* 351 (2007); D. LICHTMAN, *Understanding the RAND Commitment*, in 47 *Hous. L. Rev.* 102 (2010); C. TAPIA, *Industrial Property Rights, Technical Standards and Licensing Practices (FRAND) in the Telecommunications Industry*, Heymann Verlag, Köln, 2010.

⁸ See the Guidelines on the applicability of Article 101 of the Treaty on the Functioning of the European Union to horizontal cooperation agreements (2011/C 11/01), para. 288 ff. (on the critical issues unresolved by the Commission, see J. TEMPLE LANG, *Eight Important Questions on Standards under European Competition Law*, in *Comp. Law Int'l*, 2011, 32).

Nevertheless, the Commission has given poor guidance on the determination of FRAND license conditions. In its Guidelines on horizontal cooperation agreements, after reviewing some possible methods (⁹), it was keen to point out that “*These guidelines do not seek to provide an exhaustive list of appropriate methods to assess whether the royalty fees are excessive*” (¹⁰), and that “*it should be emphasized that nothing in these Guidelines prejudices the possibility for parties to resolve their disputes about the level of FRAND royalty rates by having recourse to the competent civil or commercial courts*” (¹¹). Moreover, the Commission excludes that there is an obligation of the SSOs to “*verify whether licensing terms of participants fulfil the FRAND commitment. Participants will have to assess for themselves whether the licensing terms and in particular the fees they charge fulfil the FRAND commitment*”, concluding “*Therefore, when deciding whether to commit to FRAND for a particular IPR, participants will need to anticipate the implications of the FRAND commitment, notably on their ability to freely set the level of their fees*” (¹²).

It is then unsurprising that not many SSOs oblige their members to disclose in advance the conditions under which they are willing to grant licenses on their essential patents, nor do they provide a procedural framework to solve the disputes between SEP holders and license seekers (i.e. arbitration clauses or similar) (¹³).

More surprising is that this seminal question has been neglect by national case-law. As will be seen later, the German case-law seems totally focused on setting the rules of the ‘duel’ between the parties negotiating a license (which party should make the first move, how the other party should reply, etc.), ignoring the rest.

In this problematic context, the CJEU preliminary ruling does not make any headway in solving the competitive questions that remain open.

In my opinion, the Court of Justice has missed an opportunity to address the critical relationship between competition law and intellectual property rights when these are

The Commission had already addressed the issue of the relationship between standardization and intellectual property with the Communication on *Intellectual property rights and standardization*, COM (92) 445 final, Brussels, 27 October 1992. The theme was considered even in the Guidelines on the application of Article 81 of the EC Treaty to technology transfer agreements (2004 / C 101/02), in particular at para. 210-226 and in Reg. (EU) No. 1025/2012 of the European Parliament and of the Council of 25 October 2012 on European standardization, regarding patent pools.

⁹ Para. 289-290: “*In general, there are various methods available to make this assessment. In principle, cost-based methods are not well adapted to this context because of the difficulty in assessing the costs attributable to the development of a particular patent or groups of patents. Instead, it may be possible to compare the licensing fees charged by the company in question for the relevant patents in a competitive environment before the industry has been locked into the standard (ex ante) with those charged after the industry has been locked in (ex post). This assumes that the comparison can be made in a consistent and reliable manner.*

¹⁰ Another method could be to obtain an independent expert assessment of the objective centrality and essentiality to the standard at issue of the relevant IPR portfolio. In an appropriate case, it may also be possible to refer to ex ante disclosures of licensing terms in the context of a specific standard-setting process. This also assumes that the comparison can be made in a consistent and reliable manner. The royalty rates charged for the same IPR in other comparable standards may also provide an indication for FRAND royalty rates”.

¹¹ Guidelines 2011, para. 290.

¹² Guidelines 2011, para. 291.

¹³ Guidelines 2011, para. 289.

¹⁴ Nor are such provisions set by ETSI, which had adopted the standard in question in the Huawei/ZTE dispute. On its homepage, it is pointed out that “*There is no obligation for any ETSI member to disclose any licensing terms related to any of its IPRs. We maintain a list of IPR owners (licensors), along with links to their disclosed licensing terms. We do not directly provide any detailed licensing terms*”.

patents become essential in the framework of *de jure* standardization. By doing so, the Court has essentially agreed to limit the issue to a conflict between two parties, the holder of essential patents and the license seeker, which may be solved by defining a behavioral scheme – something like a fairness code - that must be applied serially. This is an approach which, if not equating to the pedantry of the German courts, substantially accepts their methodology.

2. The CJEU and the issue of dominance of SEP holders.

A theoretical discussion on the possibility of assessing the request for an injunction by an SEP holder in the legal framework of Article 102 TFEU is of little relevance⁽¹⁴⁾. Undoubtedly, every activity which can be defined as an ‘undertaking’ under EU competition law may be subject to the scrutiny of the Commission and the antitrust authorities as well as the judges of the Member States. Instead, the specific behaviors and the context must be analyzed to evaluate if all the requirements for the identification of an abuse of dominant position are met.

The first step is, of course, the evaluation of the alleged dominance of the SEP holder. Considering both practice and case-law, this requires the prior identification of a relevant product market. It is not necessary to recall that without dominance there cannot be any abuse under Article 102 TFUE.

It is true that a specific question about the relevant product market and the dominance had not been submitted to the CJEU by the referring judge, but the choice made in this respect by the Court sounds odd. The Court has actually mentioned the question of dominance, but has bypassed it⁽¹⁵⁾, shelving it through an unfaithful exposition of the order for reference, stating: “*As the referring court states in the order for reference, the existence of a dominant position has not been contested before it by the parties to the dispute in the main proceedings. Given that the questions posed by the referring court relate only to the existence of an abuse, the analysis must be confined to the latter criterion*”⁽¹⁶⁾. But this statement does not exist in the order for reference! The LG Düsseldorf had instead opined that anyone who holds an essential patent, thanks to his power to obtain an injunction against the patent users enjoys a strong negotiating position that must not be abused⁽¹⁷⁾.

¹⁴ Of course, a different question concerns the convenience of addressing the conflict with antitrust law instruments. The Advocate General points out that his Opinion is specifically focused on questions related to competition law but “*That does not mean, however, that the matters at issue in the dispute before the referring court, which, in my view, stem largely from a lack of clarity as to what is meant by FRAND terms and as to the requisite content of such terms, could not be adequately — if not better — resolved in the context of other branches of law or by mechanisms other than the rules of competition law*” (Opinion of Advocate General Wathelet, delivered on 20 November 2014).

¹⁵ See G. COLANGELO, *Il mercato dell’innovazione: brevetti, standards e antitrust*, Milano, 2016, 273 s.

¹⁶ Para. 43.

¹⁷ Para. 89 of the order for reference: “*It is, however, to be acknowledged that the holder of a standardized patent enjoys a powerful position in the negotiation of licenses because of the market-dominant position conferred on him by the standard. This shall not be used in an abusive manner with the aim of pushing a competitor or a licensee into a license which is not FRAND. In particular, it must be ensured that the holder of a standardized patent cannot impose an unreasonably high license fee*”.

Advocate General Wathelet, recalling the observations submitted by the Dutch Government, criticized this apodictic presumption, observing “*it should be noted that the referring court did not state in the order for reference that it had arrived at its finding that the SEP-holder in the present case unquestionably holds a dominant position after it had examined all the circumstances and the specific context of the case. I share the view expressed by the Netherlands Government that the fact that an undertaking owns an SEP does not necessarily mean that it holds a dominant position within the meaning of Article 102 TFEU, and that it is for the national court to determine, on a case-by-case basis, whether that is indeed the situation*”¹⁸. And argued: “*Given that a finding that an undertaking has a dominant position imposes on the undertaking concerned a special responsibility not to allow its conduct to impair genuine competition, that finding cannot be based on hypotheses*”, concluding on the point “*If the fact that anyone who uses a standard set by a standardisation body must necessarily make use of the teaching of an SEP, thus requiring a licence from the owner of that patent, could give rise to a rebuttable presumption that the owner of that patent holds a dominant position, it must, in my view, be possible to rebut that presumption with specific, detailed evidence*”¹⁹.

The Opinion, which recalls the established practice of the Commission²⁰, sounds like an implicit criticism of the incomplete formulation of the order for reference, which glossed over a fundamental precondition for the assessment of an abuse. Though not clearly expressed, doubt is cast on whether this gap might affect the relevance of the preliminary question for the purposes of the judgment²¹.

The issue of the possible dominance of an SEP holder is by no means trivial, and it marks a first, fundamental, difference between the Commission's practice and the national case-law considered²². The former is very clear on this point, while, oddly enough, the latter mostly neglects this step.

This aspect deserves some consideration.

The principle invoked by the Advocate General was confirmed by the Commission in the 2014 Motorola and Samsung decisions, in which a detailed regular analysis was carried out to ascertain the relevant market²³, identified in the licenses of essential patents for GPRS technology, that had been chosen as the standard in Europe. Once more, the Commission affirmed - again through an accurate economic analysis - the existence of a dominant

¹⁸ Opinion of Advocate General Wathelet, delivered on 20 November 2014, paras. 53 – 58.

¹⁹ Guidelines 2011, para. 269.

²⁰ According to settled case-law, the Court of justice has no jurisdiction to give a preliminary ruling on a question submitted by a national court where it is quite obvious that the interpretation of Community law sought by that court bears no relation to the actual facts of the main action or to its purpose, or where the problem is hypothetical and the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it (see, for example, CJEU, 9 October 1997, Case C-291/96, Grado and Bashir). Developing the argument mentioned by the Advocate General Wathelet, since there is no evidence of a dominant position, the questions on the abuse may be irrelevant.

²¹ Even in the literature the issue is strongly debated. See the lively debate between P. CHAPPATTE, *Frond Commitments – The Case for Antitrust Intervention*, in *European Competition Journal*, 2009, 319 and *Frond Commitments and EC Competition Law. A Rejoinder*, 2012, 175, and D. GERADIN, M. RATO, *Can Standard-Setting Lead to Exploitative Abuse? A Dissonant View on Patent Hold-up, Royalty Stacking and the Meaning of FRAND*, in *European Competition Journal*, 2007, 101 and *Frond Commitments and EC Competition Law: A Reply to Philippe Chappatte*, 2010, 129 ff.

²² Decision of 29 April 2014, Paras. 181-213.

position of Motorola in this market. The Commission pointed out that “*Motorola’s mere holding or exercise of its rights under the Cudak GPRS SEP does not, however, confer dominance on its own. This must be assessed on the basis of all relevant factors. Two factors are of particular importance for this assessment: first, the indispensability of the GPRS standard on which Motorola’s Cudak GPRS SEP reads for manufacturers of standard-compliant products, and, second, the industry lock-in to that standard*”⁽²³⁾.

As to the national case-law, relevant market and dominance are generally fleetingly – and sometimes not at all – mentioned.

In the German case-law considered it is easy to witness a real regression of the theme. In the Standard Spundfass judgment of 2004, the first case of any significance brought by SEP holders against license seekers, the Bundesgerichtshof had identified the market of licenses on essential patents as the relevant market⁽²⁴⁾. The German Supreme Court had also considered the effect that the dominance on that market could produce in the downstream market of the products compliant to the standard⁽²⁵⁾.

It is in the subsequent development that the issue disappears from consideration. Almost nothing is said on the point in the 2009 judgement on the Orange Book Standard⁽²⁶⁾, in which the BGH considers only the abusiveness of the attempt to prevent the use of a patent (equated with a refusal to grant a license) or discriminatory licensing, *presuming* dominance⁽²⁷⁾. The German Supreme Court appears to be fully focused on identifying the conditions under which a license request can be considered to have been made effectively for a request for an injunction by the SEP holder to be deemed legitimate.

Paradoxically, although the Orange Book Standard judgment concerned a *de facto* standard, and thus had nothing to do with FRAND commitments, it has become a true milestone case, deeply influencing the following case-law on *de jure* standards⁽²⁸⁾, and the gap highlighted by the order for reference of the LG Düsseldorf conforms to this trend.

Thus, the reluctance of the Court of Justice to stress the lack of consideration for dominance by the referring court can scarcely be understood. Maybe the abuse issue had become too topical to be dismissed, raising objections on an aspect that for the national case-law in question is not significant.

If this glossing over the first precondition for the application of Article 102 TFEU represents the first concession to the ‘German approach’ to the vexing question of the

²³ Decision of 29 April 2014, Paras. 221 - 270.

²⁴ BGH 13.07.2004, cit., in which it is stated (A.III.2) that Art. 20(1) GWB is to be applied to the refusal of the licenses in question, “*because that of the licenses on the patent is a separate product market and the plaintiff, being the sole supplier, dominates it*”.

²⁵ *Ibidem*: “*If the design of a product protected by intellectual property rights is standardized by an industrial standard or by another rule which has been observed by the demanders as a standard, then the granting of rights which allows the potential suppliers to bring the product into the marketplace generally represents a distinct upstream market in relation to the market of the product. Therefore, the acquisition of such rights is irreplaceable for a firm that wants to produce or distribute the standardized product.*”

²⁶ BGH 06.05.2009, KZR 39/06.

²⁷ Para. 27 ff.

²⁸ See LG Mannheim 02.05.2012, 2 O 240/11 e 2 O 376/11, BeckRS 2012, 11804 e11805; OLG Karlsruhe 23.01.2012, 6 U 136/11.

alleged abusiveness of the inhibitory action undertaken by a SEP holder, the assessment of the abuse amounts to a real surrender to that approach.

3. The construction of the abuse. The approaches of the German case-law and the EU Commission.

Setting aside the question of dominance, in relation to the issue of its possible abuse two distinct methodological approaches can be noted, once again on the part of the German courts and the Commission, respectively.

As to the first, with the Orange Book Standard judgment, the BGH has provided a kind of handbook of negotiating rules, which, if ignored, lead to an assessment of abuse of a dominant position. The German Supreme Court held that "*(a) A defendant sued on the basis of a patent is able to defend himself against the claim for injunctive relief asserted by the patent holder filing the action by pleading that the latter abuses a dominant position on the market if he refuses to conclude a patent license agreement with the defendant on non-discriminatory and non-restrictive terms and conditions.* *(b) Yet the patent proprietor is only culpable of abusive behavior if the defendant has made him an unconditional offer to conclude a license agreement which the patent proprietor cannot reject without violating the prohibition of discrimination or anti-competitive behavior, and if the defendant, for the time that he is already using the subject matter of the patent, complies with the obligations that the license agreement yet to be concluded imposes in return for the use of the licensed subject matter.* *(c) If the defendant considers the patent proprietor's license demands to be excessive or if the patent proprietor refuses to quantify the royalties, an offer to conclude a license agreement in which the licensor determines the amount of royalties according to its own reasonable discretion meets the requirement of such an unconditional offer*".

A distinctive feature of the Orange Book Standard approach is the inclusion, in the context of the application of antitrust law, of assessment indices drawn from different legal sectors. In the said judgment, the BGH, identifying the antitrust violation with the breach of an obligation to grant SEP licenses (²⁹), also invokes a criterion of good faith based on the Civil Code (³⁰), without leaving aside national patent law considerations (³¹). The result sounds puzzling: in a case centered on the application of antitrust law (specifically, Art. 19 and 20.1 GWB) not only, as noted above, is there no assessment of dominance, but the assessment of the abuse is characterized by a weak consideration of antitrust aspects and no attention is paid to the content of FRAND commitments.

Indeed, looking at the European context, the Commission's approach to the topic seems to be a compromise solution, as is evident in the above-mentioned Motorola and Samsung decisions.

²⁹ In this sense, it seems to prove the claim (BGH, 06.05.2009, para. 27) that it is abusive to try to inhibit the access to a market that the SEP holder "is obliged to open".

³⁰ In this sense, it proves the claim (BGH, 06.05.2009, para. 26, in reference to what is stated in para. 25) that the Court in principle agrees "that the proposed licensee illegally behaves, if he uses the patent without the patentee's consent, that the patentee nevertheless could not seek an injunction, because with the injunctive relief he something claims, that he (in the form of a patent licence) has to allow (dolo petit, qui petit quod statim redditurus est), thus acting in violation of the principle of good faith (§ 242 BGB)".

³¹ See BGH, 06.05.2009, para. 28, recalling Article 31 Trips.

The Commission is consistent with a typical method of applying Article 102 TFEU adopted in recent years, which is characterized by an extensive use of economic evaluation of behaviors and their effects on the market. After having ascertained dominance, the Commission holds that to seek an injunction against a license seeker generally is a legitimate course of action, but there may be an abuse when, 1) in the presence of exceptional circumstances, 2) in the absence of an objective justification, it may produce anticompetitive effects. In the specific case, the exceptional circumstances were the GPRS standard-setting process and Motorola's commitment to license the GPRS SEP on FRAND terms and conditions; the absence of an objective justification related to the fact that Apple was not unwilling to enter into a license agreement on FRAND terms and conditions; the anti-competitive effects were (i) a temporary ban on the online sale of Apple's GPRS-compatible products in Germany, (ii) the inclusion in the Settlement agreement of licensing terms, disadvantageous to Apple, and (iii) a negative impact on standard-setting.

The Commission states that an SEP holder which has given a commitment to license on FRAND terms and conditions is entitled to take reasonable steps to protect its interests by seeking and enforcing an injunction against a potential licensee, for example, if the potential licensee is in financial distress and unable to pay its debts; the potential licensee's assets are located in jurisdictions that do not provide for adequate means of enforcement of damages; or the potential licensee is unwilling to enter into a license agreement on FRAND terms and conditions, with the result that the SEP holder will not be appropriately remunerated for the use of its SEPs. The corollary of a patent holder committing, in the standardization context, to license its SEPs on FRAND terms and conditions is that a potential licensee should not be unwilling to enter into a license agreement on FRAND terms and conditions for the SEPs in question.

Of course, the Commission *also* considers the parties' behavior – for example taking account of the fact that Apple had submitted six different offers complying with the Orange-Book-Standard scheme – but it avoids formulating a checklist of the negotiating steps each party should make, and prefers to give a substantive and flexible interpretation of the willingness of the parties to negotiate. Clearly, the antitrust core of the argumentation does not lie in this part of the Motorola Decision. Nevertheless, this is the only aspect of the Commission's position the referring Court is interested in. It observes that European Commission considers that seeking an injunction is already abusive under Article 102 of the TFEU if the patent holder has declared to the standardization organization his willingness to grant licenses at FRAND conditions, and the patent infringer has declared his readiness to negotiate, while "*In applying the criteria laid down by the Bundesgerichtshof the antitrust compulsory license objection of the defendant would meet no success and the action for the infringement would be upheld*"³²). The remaining doubt is that, reduced to such terms, the question has little or nothing to do with the interpretation of Art. 102 TFEU.

³² LG Düsseldorf, 21.03.2013, para. 65 and 68.

Moreover, the same could be said of the BGH Orange Book judgement in relation to the GWB.

It is true that the only information available at the time on the Motorola and Samsung decisions were the press releases, but even in such a short statement the competitive side of the matter was somehow considered⁽³³⁾. It goes without saying that the problem of FRAND conditions – which, as seen, could not arise in the Orange Book Standard dispute – remains unassessed.

4. The assessment of the abuse by the CJEU.

The Court begins with the usual reference to the traditional dicta on abuse of dominance, recalling the statement that only in exceptional circumstances may the exercise of an exclusive right linked to intellectual property be abusive. It then makes a couple of general considerations on SEPs and FRAND commitments and then exposes mixed arguments. There are some antitrust-style remarks: for instance, the statement that “*Although the proprietor of the essential patent at issue has the right to bring an action for a prohibitory injunction or for the recall of products, the fact that that patent has obtained SEP status means that its proprietor can prevent products manufactured by competitors from appearing or remaining on the market and, thereby, reserve to itself the manufacture of the products in question*”⁽³⁴⁾ and “*the fact that that patent has obtained SEP status means that its proprietor can prevent products manufactured by competitors from appearing or remaining on the market and, thereby, reserve to itself the manufacture of the products in question*” (which is not necessarily true in general, but has to be verified case by case: there may also be competition between different standards!). But these remarks play a secondary role in the argumentation of the alleged abuse, whose core regards, as said above, provisions on the way the negotiation of license conditions has to go on, that do not seem to have much to do with antitrust considerations.

The Court considers, in particular, that “*having regard to the fact that an undertaking to grant licences on FRAND terms creates legitimate expectations on the part of third parties that the proprietor of the SEP will in fact grant licences on such terms, a refusal by the proprietor of the SEP to grant a licence on those terms may, in principle, constitute an abuse within the meaning of Article 102 TFEU*”⁽³⁵⁾.

This statement sounds odd. What has ultimately been considered abusive? An unfair negotiating behavior? Unfulfilled competitor expectations? Whatever the answer, it is

³³ See press release IP/14/489. In this document, the ruling against MMH was explained as follows: «*Seeking injunctions before courts is generally a legitimate remedy for patent holders in case of patent infringements. However, the seeking of an injunction based on SEPs may constitute an abuse of a dominant position if a SEP holder has given a voluntary commitment to license its SEPs on FRAND terms and where the company against which an injunction is sought is willing to enter into a licence agreement on such FRAND terms. Since injunctions generally involve a prohibition of the product infringing the patent being sold, seeking SEP-based injunctions against a willing licensee could risk excluding products from the market. Such a threat can therefore distort licensing negotiations and lead to anticompetitive licensing terms that the licensee of the SEP would not have accepted absent the seeking of the injunction. Such an anticompetitive outcome would be detrimental to innovation and could harm consumers.*

³⁴ Paras. 52-56.

³⁵ Para. 53 of the Judgement.

unclear how this complies with the established case-law, also recalled by the CJEU (³⁶), according to which “*the concept of an abuse of a dominant position within the meaning of Article 102 TFEU is an objective concept relating to the conduct of a dominant undertaking which, on a market where the degree of competition is already weakened precisely because of the presence of the undertaking concerned, through recourse to methods different from those governing normal competition in products or services on the basis of the transactions of commercial operators, has the effect of hindering the maintenance of the degree of competition still existing in the market or the growth of that competition*”.

Equally unclear is how this judgement complies with the traditional statement that EU antitrust law aims at protecting competition and not solely competitors (³⁷). And, furthermore, how is it possible to impose an obligation to grant licenses on FRAND terms on the SEP holder, without giving some general guidance about what “fair” and “reasonable” mean, but stating “*In this connection, due account must be taken of the specific legal and factual circumstances in the case*” (³⁸)? In general: is it possible to handle FRAND commitments in the framework of Article 102 TFUE without clearly including them in a frank discussion on all of the competitive issues involved?

Instead of doing that, the Court states that when the parties are not in agreement on this point “*in order to prevent an action for a prohibitory injunction or for the recall of products from being regarded as abusive, the proprietor of an SEP must comply with conditions which seek to ensure a fair balance between the interests concerned*” (³⁹). Hence, the problem is reduced to the setting of a negotiation procedure. In this regard, the CJEU proposes a sort of mitigated Orange Book Standard test (⁴⁰), and concludes, regarding the first four questions submitted by the referring Court:

“*Article 102 TFEU must be interpreted as meaning that the proprietor of a patent essential to a standard established by a standardisation body, which has given an irrevocable undertaking to that body to grant a licence to third parties on fair, reasonable and non-discriminatory ('FRAND') terms, does not abuse its dominant position, within the meaning of that article, by bringing an action for infringement seeking an injunction prohibiting the infringement of its patent or seeking the recall of products for the manufacture of which that patent has been used, as long as:*

- *prior to bringing that action, the proprietor has, first, alerted the alleged infringer of the infringement complained about by designating that patent and specifying the way in which it has been infringed, and, secondly, after the alleged infringer has expressed its willingness to conclude a licensing agreement on FRAND terms, presented to that infringer a specific, written offer for a licence on such terms, specifying, in particular, the royalty and the way in which it is to be calculated, and*
- *where the alleged infringer continues to use the patent in question, the alleged infringer has not diligently responded to that offer, in accordance with recognised commercial practices in the field and in good*

³⁶ Para. 45 of the Judgement.

³⁷ See, e.g., CJEU, 6 October 2009, Glaxo Smith Kline Services Unlimited, Joint Cases C-501/06-P, C-513/06-P, C-515/06-P, C-519/06-P.

³⁸ Para. 55 of the Judgement.

³⁹ Paras. 74-75 of the Judgement.

⁴⁰ It is remarkable that even after the Huawei rulings the German courts have maintained an approach less favorable to the licence seekers, insisting in the ‘decalogue’; see G. COLANGELO, (nt. 15), 277 s.

faith, this being a matter which must be established on the basis of objective factors and which implies, in particular, that there are no delaying tactics” (⁴¹).

To summarize: the question is not *what* the parties communicate to each other, and what this has to do with antitrust issues, but *how* this communication begins (essentially, who has to make the first move and how it has to be made) and continues.

The Court finally addresses the fifth question: the referring judge asked whether it may be considered abusive for a SEP holder to initiate legal proceedings in order to obtain the presentation of accounting data or compensation for damages against the alleged infringer of the SEP. The question sounded strange. Maybe it was implicitly referred to the so called ‘vexatious litigation’ as a possible abuse of dominant position (⁴²), but it is obvious that this issue is only part of the general problem of the abusiveness of the action brought by a SEP holder.

The answer provided by the CJEU is correct, considered the vagueness of the issue: according to the description set out in the order for reference, the actions for infringement brought by the proprietor of an SEP, seeking the rendering of accounts in relation to past acts of use of that SEP or an award of damages in respect of those acts of use, do not have a direct impact on products complying with the standard in question manufactured by competitors appearing or remaining on the market (⁴³). But this response too suffers the lack of adequate consideration of the main conditions for the application of Article 102 TFEU.

⁴¹ Para. 71 of the Judgement.

⁴² Vexatious litigation (or sham litigation) in competition law refers to the behavior of a dominant firm which brings actions devoid of reasonable foundation, whose sole purpose is to target competitors. In this regard, the Commission, with the decision ITT Promedia, dictated a two-part test, according to which the case would be where the action i) cannot reasonably be considered as an attempt to establish the rights of the undertaking and therefore can only serve the aim to harass the opposite party and; (ii) it is conceived in the framework of a plan, whose goal is to eliminate competition (Commission, 21 May 1996, Case IV/35/268, Promedia/Belgacom, not published; the Commission's position is reported by the Court of justice, 17 July 1998, ITT Promedia NV v. EC Commission, Case T-111/96 in ECR, 1998, II-2937; in the same terms, see General Court, 13 September 2012, Protégé International Ltd v. Commission, Case T- 119/09, paras. 48-49). The sham litigation is defined by the US Supreme Court [see Professional Real Estate Investors v. Columbia Pictures Indus., 508 US 49, 123 L. Ed. 611 at 625, 113 SCt 1920, (1993)] as the “*pursuit of claims so baseless that no reasonable litigant could realistically expect to secure favorable relief*”. On the subject, see H. HOVENKAMP, *Federal Antitrust Policy. The Law of Competition and Its Practice*, West Publishing Company, St. Paul (Minn.), 4th ed., 2011, 356. Even the Supreme Court adopts a two-part test: if the action is objectively baseless, the actor's subjective motivation should be examined, considering whether it is attributable to an “*attempt to interfere directly with the business relationship of a competitor*”.

Such hypotheses have often occurred regarding the enforcement of patents which are invalid or obtained fraudulently (see CJEU, 6 December 2012, AstraZeneca c. EU Commission, case C-457/10-P, ECR 2012. The Italian Competition Authority has dealt with a case in some ways analogous: see the decision no. 23194, 11 January 2012, A431 - Ratiopharm/Pfizer). Similar proceedings have taken place also in the USA; see J. WALLACE, *Rambus v. FTC in the Context of Standard-Setting Organizations, Antitrust, and the Patent Hold-up Problem*, 24 *Berkeley Tech. LJ* 661 (2009).

⁴³ Paras. 74-75 of the Judgement.

IL CASO HUAWEI: ANCORA SUL DIRITTO DELLA CONCORRENZA COME CLAUSOLA GENERALE DEL DIRITTO CIVILE

CRISTOFORO OSTI*

Sommario: 1. La Corte applica il diritto della concorrenza senza analizzare la concorrenza stessa. – 2. Né ci soccorre l’interpretazione. – 3. La Corte ignora la sua stessa giurisprudenza. – 4. Vengono in aiuto le conclusioni dell’Avvocato Generale. - 5. La discussione del principio di buona fede. - 6. I problemi che la sentenza non risolve.

1. La Corte applica il diritto della concorrenza senza analizzare la concorrenza stessa.

L’aspetto più interessante per non dire curioso della sentenza nel caso Huawei è che questa, per essere una decisione fondata sul diritto della concorrenza (e in particolare sulla sua più complessa disposizione, l’art. 102 TFUE che prevede il divieto di abuso di posizione dominante), in pratica:

- (a) mai affronta un’analisi dell’impatto concorrenziale dei comportamenti indagati;
- (c) mai discute della sua stessa giurisprudenza in tema di abuso di posizione dominante, vuoi quella sorta in tema di abuso attraverso un contenzioso giudiziario (Huawei aveva richiesto una misura di urgenza nei confronti di ZTE, ed è da tale richiesta che origina la questione), vuoi quella elaborata in tema di rifiuto di contrarre (a parte tutto, l’effetto pratico della posizione di Huawei è che essa non concede il diritto richiesto o da richiedersi da parte di ZTE).

Di questo ci si convince facilmente, a solo leggere la sentenza:

(a) al punto 45 la corte riproduce il ragionamento, già fatto in numerosi precedenti, secondo il quale la fattispecie dell’abuso di posizione dominante ha natura oggettiva (formula leggermente fuorviante questa, se si pensa che in molte circostanze l’intenzione che si nasconde dietro ai comportamenti contestati è un elemento di prova decisivo) ed enuncia, come già fatto in tali precedenti, la tesi secondo la quale ciò che caratterizza un comportamento abusivo rispetto ad un comportamento concorrenziale, sta nel ricorso, che caratterizza il primo, a “mezzi diversi da quelli che reggono una normale competizione”;

(b) successivamente (§§ 45-47) si ricorda che l’esercizio di un diritto di proprietà intellettuale non può di per sé costituire un abuso, salvo che si tratti di un “caso eccezionale”.

(c) la Corte, esaurito questo prologo, nei punti successivi (§§ 48-53) distingue il caso in esame da quelli sui quali si è formata la sua giurisprudenza in tema di concorrenza ‘non sui meriti’

* Professore ordinario Università di Salerno

e di abuso da ricorso a diritti di proprietà intellettuale. E ciò fa in base ai due elementi (già individuati dall’Avvocato Generale): (a) natura essenziale del brevetto in questione e (b) impegno pregresso da parte di Huawei (come contropartita alla possibilità di partecipare alla conferenza con un brevetto essenziale) a concedere tale diritto in licenza a condizioni eque, ragionevoli e non discriminatorie (c.d. impegni ERENDA o FRAND, dalle iniziali dei corrispondenti termini in lingua inglese) ai terzi interessati; e ci ricorda che, trattandosi appunto di brevetto ‘essenziale’, il rifiuto di concederlo in licenza non potrà mancare di generare un’esclusiva a favore del titolare, il quale otterrà di “riservare a sé la fabbricazione di tali prodotti”;

(d) a questo punto ci si aspetterebbe un’analisi dettagliata dell’applicabilità dell’art. 102 alla fattispecie, asseritamente diversa da quelle che hanno formato l’oggetto dei suoi precedenti in tema di concorrenza e proprietà intellettuale. Una volta sottolineate, come fa la Corte, insomma, le differenze tra questa fattispecie e quelle che avrebbero formato l’oggetto della precedente giurisprudenza, ci si aspetterebbe un ragionamento che spiegasse in che cosa tali differenze giustificano un diverso trattamento e magari anche in che cosa consista la diversità del trattamento; in realtà, la Corte si limita ad affermare quanto segue (§§ 53):

“Ciò posto, e dato che un impegno a rilasciare licenze a condizioni FRAND crea nei terzi legittime aspettative a che il titolare del BEN [il brevetto essenziale per lo standard in questione] conceda loro in concreto licenze a tali condizioni, un rifiuto del titolare del BEN di concedere una licenza a questo tipo di condizioni può costituire, in via di principio, un abuso ai sensi dell’articolo 102 TFUE”.

Ora, ai più sfugge completamente perché “ciò posto” (si ricorda, l’unica cosa che la Corte ha ‘posto’ sono le differenze con le situazioni esaminate nella giurisprudenza precedente, e cioè ... BEN ed ERENDA) il comportamento in questione rappresenti un abuso di posizione dominante. E l’inciso “dato che un impegno ... FRAND crea nei terzi legittime aspettative” non migliora la comprensione, dato che non risulta che non venire pienamente incontro alle ‘legittime aspettative’ di un aspirante licenziatario rappresenti, in sé, un abuso di posizione dominante, o quanto meno non risulta in base alle ben povere argomentazioni messe in fila dalla Corte nei paragrafi precedenti.

Tutto si riassume, in definitiva, in un “ciò posto”. Un vizio logico del tipo: *sine hoc ergo propter hoc*. La differenza tra i due gruppi di fattispecie spiegherebbe la diversa soluzione giuridica proposta, ma in realtà nessuno ci spiega perché tale differenza (se esiste, il che pure non è provato) rilevi al punto da importare una differente soluzione.

Si osservi al proposito che la giurisprudenza americana ha preso espressamente la posizione contraria, secondo la quale la fattispecie delle ingiunzioni potenzialmente abusive deve essere considerata in base ai medesimi principi giuridici, indipendentemente dal fatto che la norma

in questione sia stata considerata essenziale e dunque un impegno EREN si sia stato concesso¹.

2. Né ci soccorre l'interpretazione.

Neppure si risolve la situazione cercando di riempire le lacune del ragionamento della Corte. L'ingiunzione, o il potenziale rifiuto a concedere una licenza, potrà forse considerarsi un problema per ZTE, ma non è chiaro dove sia il pregiudizio (anche potenziale) alla concorrenza. Premesso che, paradossalmente, nel diritto della concorrenza non è sempre chiaro ... cosa si intenda per concorrenza, il pregiudizio alla concorrenza viene di solito ricostruito ricorrendo a due teorie (alternative). La prima, quella del (danno al, e cioè della diminuzione del) benessere del consumatore, intendendosi per tale una diminuzione della efficienza allocativa che consegua, anche potenzialmente, alla pratica anticoncorrenziale. Chiaro che per poter seppur anche molto vagamente tratteggiare una simile ricostruzione occorrerebbe chiedersi quali possano essere gli effetti (sui prezzi, o sulla qualità, o sulle quantità, o sull'innovazione, o sulla varietà ...) del comportamento in parola. Ed è sufficientemente chiaro che la Corte nemmeno si pone la questione.

La teoria alternativa (al momento decisamente prevalente nella giurisprudenza europea) è quella della concorrenza come bene tutelabile in sé, e in particolare della concorrenza come *processo* dal quale possano ipoteticamente seguire (ma parecchio meno forte è l'onere probatorio che incombe sull'autorità di concorrenza) i benefici, in termini appunto di prezzi, qualità, quantità, varietà, innovazione, sopra richiamati. E anche qui, occorre candidamente ammettere, che al processo concorrenziale, e più in particolare al contributo che il comportamento di Huawei porterebbe a tale processo non viene in alcun modo fatto riferimento.

Ché anzi vi è più di una ragione per dubitare che, nel caso di specie, un tale danno (al benessere del consumatore o al processo concorrenziale, che creder si voglia) sussistesasse affatto.

Addirittura, nei fatti, non è nemmeno chiaro se la richiesta di ingiunzione sia seguita ad un comportamento in un qualche modo ostruzionistico del titolare del brevetto. La sentenza si limita infatti a considerare (§§ 24-26) che in un periodo di cinque mesi circa le due società “hanno avviato discussioni vertenti, in particolare, sulla contraffazione del brevetto e sulla

¹ Cfr., United States Court of Appeals for the Federal Circuit, Apple Inc. e Next Software, Inc. v. Motorola, Inc., 757 F.3d 1286 (2014), in materia di brevetti BEN, che fa riferimento al più importante precedente della Corte Suprema in tema di inibitorie brevettuali, eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388 (2006). La sentenza è particolarmente interessante anche perché riforma in buona parte la sentenza del grado inferiore, redatta dal giudice Posner.

possibilità di concludere un contratto di licenza a condizioni FRAND”; che Huawei ha “indicato [un] importo” mentre ZTE “propendeva per una concessione reciproca di licenze”. In ogni caso “non si è pervenuti alla finalizzazione di alcuna proposta relativa a un contratto di licenza” e “nondimeno” la ZTE ha commercializzato prodotti funzionanti sulla base del brevetto Huawei. A questo punto Huawei ha richiesto l’ingiunzione. Da questa sola breve e non chiarissima descrizione (Huawei propone un corrispettivo, ZTE risponde richiedendo una cosa affatto diversa, cioè una licenza incrociata, comunque non fa alcuna proposta concreta di sfruttamento del brevetto e continua tranquillamente ad utilizzarlo per la sua produzione, come se nulla fosse) non sembra che ZTE abbia nemmeno fatto lo sforzo di venire incontro ai legittimi desideri di Huawei, di ottenere un corrispettivo per lo sfruttamento di un suo diritto. E nemmeno sembra che il dissidio vertesse sulle condizioni offerte da Huawei, e tampoco sulla loro equità.

3. La Corte ignora la sua stessa giurisprudenza

Altro aspetto assai peculiare della sentenza in esame, cui sopra si accennava, è rappresentato dal fatto che la Corte giunge alle sue conclusioni senza ripercorrere i propri precedenti o quelli del Tribunale, cosa altamente inconsueta, come sa chi conosce la struttura tipica del giudicare delle Corti europee, fortemente improntato ad un metodo casistico. Così, nelle sentenze *Promedia* e *Protégé* il Tribunale ha affrontato il problema dell’applicazione dell’art 102 a comportamenti dell’impresa dominante che si estrinsecano in azioni giudiziali. Il che parrebbe rilevante in una situazione nella quale a Huawei si contesta, in essenza, di aver ricercato abusivamente il rilascio di un’ingiunzione nei confronti di ZTE. Or bene, di tale giurisprudenza e dei limiti da essa posti per irrogare il divieto — piuttosto ristretti in considerazione anche del *favor* all’accesso alle corti - nella sentenza in esame non si parla affatto².

Simili considerazioni possono farsi in merito alla possibile configurazione del comportamento in questione come abuso che consiste nel rifiuto di concedere una licenza di brevetto. Al riguardo esiste una sufficientemente delineata linea giurisprudenziale (le più recenti manifestazioni della quale sono verosimilmente le decisioni della Corte nel caso *IMS*³ e del Tribunale nel caso *Microsoft*⁴), che identifica una serie di requisiti perché possa darsi un abuso da rifiuto. E ciò partendo dalla stessa premessa dalla quale pure muove la Corte, e cioè che solo

² Sentenza del Tribunale del 17 luglio 1998, *ITTPromedia c. Commissione*, causa T-111/96, EU:T:1998:183; sentenza del Tribunale del 13 settembre 2012, *Protégé International c. Commissione*, causa T-119/09, EU:T:2012:421.

³ Sentenza della Corte del 29 aprile 2004, *IMS Health GmbH & Co. OHG e NDC Health GmbH & Co. KG*, causa C-418/01, ECLI:EU:C:2004:257.

⁴ Sentenza del Tribunale del 27 giugno 2012, causa T-167/08, *Microsoft Corp. c. Commissione*, ECLI:EU:T:2012:323.

in ‘casi eccezionali’ (§ 47) si giustifichi l’applicazione del divieto previsto all’art. 102 in situazioni di esercizio di un diritto di proprietà intellettuale. Ora, laddove appunto la citata giurisprudenza individua tali circostanze eccezionali (in particolare: che sia identificabile un mercato separato; che il rifiuto impedisca l’emergere di un prodotto nuovo, per il quale esiste una domanda dei consumatori; che come conseguenza la concorrenza su quel mercato sia eliminata), la sentenza in esame si segnala appunto per il fatto che alla giurisprudenza in parola, alla quale pure fa riferimento (in particolare è citata la sentenza nel caso *IMS*) ed ai criteri da essa delineati viene accordata ben poca attenzione. La sentenza infatti si limita, come già detto, sulla scorta di quanto affermato dall’Avvocato Generale, a considerare l’‘essenzialità’ del brevetto e l’impegno a concedere una licenza ERENED a sostenere che tali fatti (in particolare, si deve ritenere, l’impegno alla licenza) creano una ‘legittima aspettativa’ nel potenziale licenziatario onde il rifiuto a concedere la licenza “può costituire, in via di principio, un abuso ai sensi dell’articolo 102 TFUE”. Il che equivale, in sostanza, a sostituire i piuttosto restrittivi, almeno in linea teorica⁵, ‘casi eccezionali’ previsti dalla giurisprudenza *IMS* con l’assai ampia ed estremamente vaga fattispecie delle ‘leggitive aspettative’.

Con l’occasione si noti anche che la Corte, oltre a sorvolare sui propri precedenti, sembra anche ignorare del tutto le elaborazioni offerte sul tema dalla Commissione Europea. Questa, infatti, nelle sue *Linee Direttive sugli Accordi di Cooperazione Orizzontale* dedica un’approfondita analisi ai problemi concorrenziali scaturenti dagli accordi di standardizzazione (e cioè partitamente: la collusione tra le imprese partecipanti; la limitazione dello sviluppo tecnico e dell’innovazione; la preclusione ai danni delle imprese escluse) ed individua le situazioni ove il divieto posto dalle regole di concorrenza è ineludibile, quelle in cui tali accordi possono

⁵ Va osservato che la stessa giurisprudenza del caso *IMS* è in pratica assai meno restrittiva di quanto potrebbe apparire in prima impressione, soprattutto quando ammette che il mercato separato di cui è questione possa essere anche un mercato (tuttora non esistente ma) potenziale e in una situazione in cui il ‘prodotto nuovo’ — la offerta del quale, ricordiamo, il rifiuto del titolare deve impedire perché si possa configurare l’abuso - nei fatti, si limitava ad essere una imitazione piuttosto scialba di un prodotto esistente: tanto che il giudice di rinvio risolse definitivamente la questione accertando che, pur in presenza di un valido diritto di autore di *IMS* sul prodotto licenziando, non poteva impedirsi alla convenuta di sviluppare ed offrire sul mercato un prodotto con caratteristiche del tutto analoghe, onde il rifiuto del titolare di concedere una licenza non rappresentava più un ostacolo in quanto l’utilizzatore poteva procedere ad offrire il suo prodotto senza licenza alcuna. Per tale ragione la Commissione revocò le misure di urgenza disposte a favore dell’utilizzatore: Decisione della Commissione del 13 agosto 2003 relativa a un procedimento a norma dell’articolo 82 del trattato CE, *NDC Health/IMS Health: misure provvisorie*, GUCE n. L 268 del 2003, p. 69.

sfuggire all'applicazione delle regole di concorrenza e quelle infine ove può rendersi applicabile l'esenzione posta all'art. 101.3. Tra le peculiarità della sentenza in esame vi è dunque anche quella di ignorare completamente tale qualificata elaborazione⁶.

Infine, è notevole il fatto che la Corte (e l'Avvocato Generale con essa) ignori completamente la giurisprudenza che nel sistema americano si è formata sugli stessi temi, coinvolgendo anche la Corte Suprema⁷. Per quanto non vi sia nulla di male (a modesto avviso di chi scrive) nel formarsi di una 'via europea' al diritto concorrenziale nonché della proprietà intellettuale, l'assenza assoluta di dialogo è, tanto dal punto di vista del risultato giudiziario quanto in genere dell'impoverimento intellettuale conseguente, deplorevole e preoccupante (nonché nuova in quanto i *grands arrêts* della Corte di Giustizia in materia di concorrenza tradizionalmente non mancavano se non altro di considerare il punto di vista della giurisprudenza americana).

4. Vengono in aiuto le conclusioni dell'Avvocato Generale.

Le ragioni della decisione, nella estrema sinteticità delle sue motivazioni, divengono un po' più chiare se ci si riferisce alle conclusioni dell'Avvocato Generale Wathelet che, come peraltro in più punti ammesso dalla Corte, costituiscono la sua vera fonte di ispirazione. Queste peraltro sono tanto più utili in quanto l'Avvocato Generale affronta tutta la questione con estremo candore.

Da una parte, afferma infatti, abbiamo la sentenza della Corte Suprema Federale Germanica nel caso *Orange Book*⁸ e dall'altra l'intervento della Commissione nel caso *Samsung* (risoltosi in base al rilascio di impegni⁹).

Nel primo caso il BGH aveva descritto le condizioni che solo avrebbero giustificato l'applicazione dell'art. 102, tra le quali, in particolare, l'offerta *incondizionata* da parte del convenuto della conclusione del contratto di licenza e il versamento quanto meno in deposito del corrispettivo (non si sa bene come quantificato). Onde come osserva lo stesso giudice di rinvio, applicandosi tale giurisprudenza ai rapporti Huawei/ZTE esso avrebbe dovuto concedere

⁶ Comunicazione della Commissione, *Linee direttive sull'applicabilità dell'articolo 101 del trattato sul funzionamento dell'Unione europea agli accordi di cooperazione orizzontale*, GUCE n. C 11 del 2011, p. 1: cfr. in particolare i §§ 263 ss.

⁷ Cfr. la giurisprudenza cit. a nt. 1.

⁸ Bundesgerichtshof, sentenza del 6 maggio 2009, *Orange Book*, KZR 39/06.

⁹ Decisione della Commissione del 29 aprile 2014, relativa ad un procedimento a norma dell'articolo 102 del trattato sul funzionamento dell'Unione europea e dell'articolo 54 dell'accordo SEE, *Samsung — Esecuzione di brevetti essenziali per lo standard UMTS*, GUCE n. C 350 del 2014, p. 8.

l’ingiunzione richiesta da Huawei (§ 34 delle Conclusioni), se non altro perché di offerta incondizionata nel caso non vi è traccia.

E tuttavia nel caso Samsung la Commissione aveva ritenuto che costituisse violazione del divieto di abuso di posizione dominante richiedere l’ingiunzione laddove l’utilizzatore avesse semplicemente manifestato la propria disponibilità a negoziare la licenza. Osservato che in tale caso (a differenza che in quello considerato dalla pronuncia *Orange Book*) si trattava pure di un brevetto essenziale e di una situazione ove il titolare aveva assunto l’impegno di contrattare a condizioni EREN, il giudice di rinvio considera comprensibilmente che, a voler seguire Samsung piuttosto che *Orange Book*, esso avrebbe dovuto ritenere per il caso dell’abuso, datosi appunto che ZTE aveva manifestato la propria disponibilità a negoziare (§ 37). Da cui il suo comprensibile smarrimento (smarrimento ancor più rilevante in quanto *Orange Book* è comunque una sentenza della sua Corte Suprema).

L’Avvocato Generale osserva, da una parte, che i principi di *Orange Book* non possono applicarsi al caso di specie in ragione delle più volte ricordate differenze fattuali (alle quali, come si è visto, farà riferimento la Corte stessa nella sentenza) e che, dall’altra, la posizione della Commissione in *Samsung* pure non sarebbe applicabile, non tanto per differenze nella fattispecie ma, questa volta, proprio perché l’AG la ritiene errata in sé: infatti, egli considera: “mi sembra tuttavia che una semplice disponibilità del contraffattore a negoziare, di natura estremamente vaga e non vincolante, non può essere in nessun caso sufficiente a limitare il diritto del titolare del BEN a esperire un’azione inhibitoria” (§ 50). Ne consegue che dai due precedenti “derivino situazioni di sovra o sotto tutela, rispettivamente, del titolare di un BEN, degli utilizzatori del metodo dei brevetti o dei consumatori” (§ 51).

Arrivato a questa conclusione, l’Avvocato Generale si incarica di trovare una soluzione: “Risulta quindi necessario individuare una soluzione intermedia”. Il caso, e la sentenza della Corte che, a parte alcuni tecnicismi complessivamente piuttosto irrilevanti, segue perfettamente l’impostazione dell’AG, sta tutto qui.

5. La discussione del principio di buona fede.

La “soluzione intermedia” proposta dall’AG Wathelet (e poi seguita dalla Corte) non sta, come si è visto, nell’affermazione di una violazione (o dell’assenza di una violazione) di una qualche regola o principio del diritto della concorrenza. E non attribuisce dunque la responsabilità del comportamento all’una o all’altra parte. Ché anzi, come pure si è visto, evita scienzientemente di affermare che una responsabilità, e che una violazione, vi sia. Ciò che la Corte fa è, piuttosto, creare un quadro negoziale che deve essere seguito diligentemente dalle parti.

Ricordiamolo per completezza: (i) il titolare dovrà avvertire l'utilizzatore del fatto che sta utilizzando il suo diritto, specificandone il modo (§ 61); tale informazione è ritenuta necessaria in un sistema in cui, come sottolinea lo stesso Avvocato Generale (il quale osserva ad esempio che per la norma tecnica cui partecipava il brevetto Huawei fossero stati notificati “come essenziali più di 4700 brevetti e che, per un’alta percentuale, tali brevetti po[tesser]o non essere validi o essenziali ai fini dell’applicazione della norma”: § 81) è ben possibile che l’utilizzatore non fosse nemmeno consapevole di stare utilizzando e quindi violando un brevetto altrui; (ii) l’utilizzatore dovrà comunicare “la sua volontà di stipulare un contratto di licenza a condizioni FRAND”; (iii) a questo punto il titolare dovrà trasmettere “una proposta di licenza concreta e scritta a condizioni FRAND [...]” specificando, in particolare, il corrispettivo e le sue modalità di calcolo” (§ 63); (iv) l’utilizzatore dovrà “dare seguito a tale proposta con diligenza, conformemente agli usi commerciali riconosciuti in materia e alla buona fede” e in particolare senza ricorrere ad alcuna “tattica dilatoria” (§ 65); (v) ovvero potrà formulare una controproposta, sempre a condizioni FRAND; (vi) eventualmente costituendo una appropriata garanzia qualora intenda utilizzare il brevetto prima della conclusione del contratto (§ 67), e infine (vii) le parti “possono”, “di comune accordo” chiedere che il corrispettivo sia determinato da un terzo indipendente (§ 68).

Se questo le parti faranno esse, da una parte, sfuggiranno ad ogni responsabilità per violazione dell’art. 102 (a carico del titolare, nonché delle regole brevettuali, per il caso dell’utilizzatore). E, dall’altra, nel quadro di tale sistema negoziale obbligato, creato dalla Corte, e sotto il controllo delle autorità giudiziarie o arbitrali, esse, si auspica, non mancheranno di trovare una soluzione pratica al problema di riempire di contenuti concreti l’impegno EREN, di identificare cioè quei termini “equi ragionevoli e non discriminatori” che possano soddisfare entrambi nonché, per così dire, il mercato.

In altri termini, la soluzione intermedia, innovativa se si vuole e certamente piuttosto audace nell’ignorare deliberatamente l’applicazione pura e semplice delle regole di concorrenza, è quella di (non risolvere la questione direttamente ma) creare “regole procedurali di buona gestione” della controversia¹⁰.

Il modo in cui la Corte raggiunge tecnicamente il risultato voluto, quello cioè di creare un quadro istituzionale è, formalmente, quello di stabilire che, in sostanza, laddove le parti integrugliscano in qualsivoglia modo diverso da quello prescritto dalla Corte questo, di per sé, creerà una presunzione di violazione dell’art. 102 da parte del titolare del brevetto (laddove sia questi a non conformarsi), ovvero lo libererà da ogni responsabilità: e verosimilmente farà

¹⁰ B. LUNDQVIST, *Post Danmark II, now concluded by the ECJ: clarification of the rebate abuse, but how do we marry Post Danmark I with Post Danmark II?*”, in *European Competition Journal*, 2016, 557; in tal senso cfr. anche N. PETIT, *EU Competition Law Analysis of FRAND Disputes*, 2016, https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2884749.

insorgere una presunzione di violazione del diritto brevettuale in capo all'utilizzatore laddove sia quest'ultimo a discostarsi dal quadro negoziale delineato dalla Corte.

Come più volte sottolineato, la Corte manca di descrivere nella sentenza il sillogismo giuridico che le consente di affermare perché vi sia stata o vi possa essere una violazione dell'art. 102 da parte del titolare del brevetto che non si conformi alle norme comportamentali fissate dalla Corte stessa. Ma sono numerosi nel testo della sentenza gli indici che ci permettono di individuare nel ricorso al cavallo di battaglia di ogni giurisprudenza creativa, la clausola di buona fede, la chiave della quale la Corte si serve per fissare la sua nuova regolazione¹¹.

In primo luogo, si può ricordare che all'art. 242 (la regola del codice civile germanico che, come a tutti noto, appunto di buona fede o *Treu und Glauben*, tratta) fanno espresso riferimento sia la sentenza nel caso *Orange Book*, sia il giudice di rinvio in questo caso *Huawei*. In entrambi, al concetto di buona fede si fa riferimento nell'ambito dell'abuso di diritto, in una delle sue figure sintomatiche nel sistema germanico (e nel diritto comune prima di quello), quella del *dolo petit qui petit quod statim redditurus est*¹². Questa, come si sa, è la situazione di chi agisce per ottenere soddisfazione di una pretesa alla quale sa di dover rinunciare subito dopo (*statim*). Nella specie tale figura sarebbe stata applicabile ad un titolare del brevetto che agisce per inibire l'utilizzazione di tale diritto pur sapendo che tale agire concreta una violazione della regola concorrenziale che gli impedirà, a stretto giro, di esercitare appunto quel diritto. Situazione della quale non è forse nemmeno il caso di rilevare l'elemento paradossale, considerato che proprio nella promozione di tale azione si concretrebbe l'abuso (concorrenziale nonché di diritto, appunto).

A ben vedere, il comportamento in questione sembra meglio rientrare in una diversa forma tipizzata dell'abuso di diritto, quella cioè c.d. del *venire contra factum proprium*: in questa il comportamento, pur in sé perfettamente legittimo e lecito, contraddice ad un comportamento (o inerzia) precedente della stessa parte che, spesso per il fatto di avere generato un affidamento nell'altro, provoca un aggravamento della posizione di questi¹³. Questo è in sostanza quanto

¹¹ Per non annoiare eccessivamente il lettore mi limito qui a fare riferimento, per una discussione più compiuta del tema della buona fede nel diritto della concorrenza, ai miei *Nuovi Obblighi a Contrarre*, Giappichelli, Torino, 2004 e *What's in a name, The Concept of Abuse in Sui Generis Abuses*, in G. PITRUZZELLA, G. MUSCOLO (a cura di), *Competition and Patent Law in the Pharmaceutical Sector, An International Perspective*, Kluwer, Alphen aan den Rjin, 2016.

¹² J. DREXL, *Zugang zu standardessenzuellen Patenten als moderne Regulierungsaufgabe: Wie reagiert das EU-Kartellrecht auf Patentkriege zwischen chinesischen Unternehmen?*, Max Planck Institute for Innovation and Competition, Discussion Paper no. 5, 2016.

¹³ La letteratura come si sa è sterminata: cfr. in primisima battuta K. LARENZ, M. WOLF, *Allgemeiner Teil des Bürgerlichen Rechts*, C.H. Beck, Monaco, 2012, § 34 para 49; D. Looschelders, D. Olzen, in *Staudingers Kommentar* (2005) § 242 paras 107–9; D. LOOSCHELDERS, D. OLZEN, G SCHNEEMANN (a cura di), *J. v. Staudingers Kommentar zum Bürgerlichen Gesetzbuch*, Berlino, 2005, ad § 242, n. 107 ss., 286 ss.

la Corte esprime laddove, come ricordato, considera che la violazione dell'art. 102 possa discendere dal fatto che l'impegno alla licenza EREN “crea nei terzi legittime aspettative a che il titolare del BEN conceda loro in concreto licenze a tali condizioni”, aspettative violate poi dal rifiuto del titolare di concedere la licenza in questione.

Se questo è forse il più evidente richiamo all'abuso di diritto, i riferimenti diretti ed indiretti alla buona fede sono sparsi qua e là nella sentenza. Questo è vero ad esempio quando, nella descrizione del quadro procedimentale, si prescrive l'obbligo dell'utilizzatore di dare seguito alla proposta del titolare “con diligenza, conformemente agli usi commerciali riconosciuti in materia e alla buona fede”, nonché in “assenza di ogni tattica dilatoria” (§ 65).

Ancora, al § 55 si ricorda che il titolare del brevetto essenziale “deve rispettare taluni requisiti volti a garantire un giusto equilibrio degli interessi in gioco”: espressione questa che non lascia spazio ad equivoci.

Resta ovviamente da chiedersi il perché del ricorso alle regole di concorrenza per procedimentalizzare un quadro negoziale tra le parti, improntato al principio di buona fede. Riper-correndo quanto già a su tempo sostenuto, la mia personale convinzione è che l'utilizzazione delle regole di concorrenza debba la sua popolarità: (i) alla versatilità e adattabilità di queste, (ii) alla loro potenza di fuoco datosi che, con i loro divieti, le loro previsioni di nullità, le pesanti sanzioni, i poteri di diffida, poteri tutti spesso delegati ad autorità amministrative assai bene attrezzate, ed il loro sempre più stretto collegamento alla risarcibilità dei danni, tali norme apprestano un insieme di strumenti del tutto unici per varietà e per incisività. Tutto questo a fronte di un diritto privato bloccato su di un sistema di attuazione largamente obsoleto, pietrificato sul fronte della autonomia privata ed estremamente restio a concedere qualsiasi spazio di discrezionalità al giudice; (iii) tale amplificata discrezionalità si fa forte anche del fatto che le regole di concorrenza, potendosi avvalere dei principi e spesso degli strumenti della scienza microeconomica e per altri versi potendosi richiamare ai precedenti delle corti europee, provvedono a che l'intervento del giudice possa ispirarsi a parametri scientifici, e sorretto dai molti argini eretti dalle istituzioni europee, giudiziarie ed amministrative. Quel giudice, in altri termini, laddove ricorre alle regole concorrenziali, non soggiace a quelle condizioni di istituzionale debolezza ed ai condizionamenti culturali che lo affliggono tipicamente quando, nell'intervenire sul delicato equilibrio dei rapporti tra privati, voglia utilizzare gli strumenti del diritto civile. Egli/ella, al contrario, sale sulle spalle di fonti e parametri circondati da un prestigio intellettuale e istituzionale ancora in larga parte indiscusso. Da qui appunto l'idea di un diritto della concorrenza che riempie la funzione di clausola generale del diritto civile¹⁴.

Un interessante crocevia di teorie giuridiche è, d'altronde, la stessa fattispecie del conten-zioso vessatorio. Si è detto sopra che una delle peculiarità della sentenza in esame è quella di

¹⁴ Sulla quale devo nuovamente rinviare al mio *Nuovi Obblighi a Contrarre* (nt. 11).

aver ignorato i precedenti delle corti europee in materia di applicazione del diritto concorrenziale alle pratiche escludenti (fatte rientrare nella categoria della ‘predazione non sul prezzo’) attuate attraverso il contenzioso vessatorio (o temerario, o pretestuoso): e questo in una situazione nella quale l’addebito nei confronti di Huawei sorge per l’appunto dalla richiesta di questa di misure inibitorie nei confronti del “presunto contraffattore”, come ZTE è a più riprese definita nella sentenza.

Ora, non solo, come appunto si è visto, esiste una fattispecie del diritto concorrenziale che descrive quella che nel diritto americano viene definita “*sham*” o “*vexatious*”, *litigation*. Ma tale comportamento può ricadere anche nell’abuso di diritto propriamente inteso (nella forma dello svilimento di potere, cioè a dire l’utilizzazione di un diritto per una finalità divergente da quella che la legge ha posto alla base della concessione di quel diritto). Nonché nella forma della concorrenza sleale¹⁵, considerato che il contenzioso temerario o vessatorio ne può rappresentare una fattispecie. Il collegamento tra concorrenza sleale e concorrenza in senso stretto è d’altronde piuttosto stretto in questa area, se si pensa che lo stesso concetto di “concorrenza sui meriti” ovvero di concorrenza che fa “ricorso a mezzi diversi da quelli che reggono una normale competizione”, al quale le corti spesso si rifanno (e così pure, si è visto, fa la sentenza in parola, al § 45) per sceverare i comportamenti concorrenzialmente leciti da quelli illeciti, specie in presenza di condotte ambigue in quanto (come è vero appunto per la promozione di un contenzioso) espressione altrimenti di un diritto spettante alla parte, nasce storicamente proprio nell’ambito della concorrenza sleale per distinguere i comportamenti commerciali (magari aggressivi ma comunque) leciti, da quelli illeciti¹⁶.

Infine, se è il caso di dirlo, la buona fede è, in più modi, intrinseca allo stesso concetto di impegno “equo e ragionevole” (*fair and reasonable*). E’ chiaro infatti che l’equità di cui si parla non è solo quella del processo di negoziazione che dovrebbe condurre all’accordo (*fair* dunque in senso di *fair dealing*) ma anche proprio l’equità (e la ragionevolezza) sostanziale, del prezzo e delle condizioni: concetto questo ulteriormente rafforzato dal connotato di ‘non discriminatorio’ e dall’obbligo dunque di non discriminazione.

Nel caso di specie, conviene brevemente osservare, la via della buona fede e della creatività giurisprudenziale è ancora più irresistibile in quanto, ai condizionamenti che il diritto civile pone tradizionalmente al giudice che voglia intervenire nei rapporti tra le parti, si accompagna il fallimento regolatorio e in generale la situazione caotica che caratterizza, anche in paesi organizzati in modo più efficiente del nostro, l’area brevettuale, tanto più che la posta in

¹⁵ Questo è certamente vero nel contesto di molti sistemi giuridici nazionali. Cfr. L. H. SALGADO, G. FERRERO ZUCOLOTO, *Study on the Anti-competitive enforcement of Intellectual Property Rights: Sham Litigation*, 2011, http://www.wipo.int/export/sites/www/meetings/en/2011/wipo_ip_ge_11/docs/study.pdf.

¹⁶ Se non altro per esigenze di spazio anche qui sono costretto a rinviare al mio *What’s in a Name* (nt. 11).

gioco è spesso estremamente alta. Si è detto ad esempio della posizione della Corte e dell’Avvocato Generale, che credibilmente sostengono che nel caso di specie, ZTE avrebbe anche potuto non sapere che il suo comportamento stesse violando la privativa di Huawei. Situazione senza dubbio verificatasi anche per il numero fantasmagorico di brevetti BEN che si affollano su una stessa norma tecnica comune. D’altra parte, il lettore non specialista non può non rimanere basito quando apprende che la ‘essenzialità’ del brevetto non è acclarata in esito ad un processo di valutazione competente e obiettivo: ad esempio, come spiega la Corte stessa (al § 20), l’ETSI, e cioè la organizzazione della quale si tratta in questo caso “non controlla né la validità né il carattere essenziale del diritto di proprietà intellettuale della cui necessità di utilizzo è stato informato da parte di uno dei suoi membri”. Senza contare che un brevetto potrebbe essere essenziale per una certa versione che può non essere quella utilizzata per il prodotto che il convenuto desidera immettere sul mercato, così come in genere è possibile che quello stesso prodotto possa fabbricarsi senza utilizzare tutti i brevetti, essenziali o meno, riuniti nello standard¹⁷.

E si consideri che, in una situazione nella quale le innovazioni (i) affiorano a getto continuo, (ii) sono spesso caratterizzate da una complessità tecnica stupefacente, (iii) si pongono altrettanto spesso solo come innovazioni incrementali e derivate rispetto a brevetti esistenti — rilasciati allo stesso richiedente o peggio ad un suo diretto concorrente (iv) non possono sopportare tempi lunghi di attesa nel passaggio da invenzione a commercializzazione (almeno in assenza di esigenze gravi e imprescindibili, quali quelle di sicurezza che caratterizzano la innovazione farmaceutica); in tale situazione, insomma, capita spesso che gli uffici brevetti, anche quelli dei paesi più attrezzati, non siano obiettivamente in grado di valutare in modo definitivo la validità degli stessi brevetti che essi congedano. In breve: l’utilizzatore non sa se sta violando un qualche diritto di privativa; non è comunque certo che quel diritto sia essenziale e nemmeno se davvero sia valido. E, cosa ancora più paradossale, almeno negli ultimi due casi, questa nebbia informativa avvolge lo stesso titolare.

Onde il quadro negoziale approvato dalla Corte risponde tanto all’esigenza del mercato (di consentire che l’innovazione affluisca al mercato con la rapidità richiesta) quanto a quella degli stessi operatori, che spesso e volentieri non sono nemmeno in grado di valutare preventivamente se il loro stesso brevetto (per non parlare di quelli dei concorrenti) sia valido ed essenziale. L’impegno EREN ed il conseguente consegnarsi alla decisione finale dell’organo giudiziario sono insomma l’unico modo — in assenza almeno di una riforma regolatoria di ampia portata — per consentire al mercato di funzionare in modo più o meno adeguato.

Tale aspetto è ancora più evidente se si pensa che, in una situazione nella quale, come si è detto, i brevetti che ruotano attorno ad una stessa norma tecnica possono essere migliaia,

¹⁷ Cfr. M. RATO, M. ENGLISH, *An Assessment of Injunctions, Patents, and Standards Following the Court of Justice’s Huawei/ZTE Ruling*, in *Journal of European Competition Law & Practice*, 2016, 103 ss.

accade che le parti siano in posizione di potenziale concedente e licenziatario per uno o più brevetti e nella posizione reciproca per uno o più altri (e si ricorda che nella fattispecie concreta ZTE aveva reagito alla richiesta di Huawei insistendo su di una licenza incrociata che, evidentemente, coinvolgeva qualche altro *suo* brevetto). E' chiaro dunque che in tale situazione di dipendenza reciproca le parti saranno portate naturalmente a trovare una soluzione negoziale — con l'aiuto del quadro procedurale messo a punto dalla Corte - piuttosto che ricercare una soluzione giudiziale che potrebbe potenzialmente paralizzarne l'attività.

In una situazione nella quale, dunque, entrambe le parti sono assistite da un significativo potenziale ricattatorio, la negoziazione e preventivamente la regolazione e l'ottimizzazione del quadro nel quale essa si volge è l'unica soluzione.

6. *I problemi che la sentenza non risolve*

Venendo ora a quanto la sentenza lascia irrisolto, non può mancarsi di rilevare, riallacciandosi a quanto detto, che la sentenza stessa non dice in primo luogo che cosa sia ERENDA né ci fornisce veramente gli strumenti perché siano le parti o il terzo indipendente a farlo. Il problema è amplificato dal fatto che, concedendo la corte stessa all'utilizzatore la possibilità di rispondere al titolare che abbia formulato un'offerta ERENDA, con un'altra offerta ERENDA, non si tratta solo di stabilire se un'offerta sia equa e ragionevole, e nemmeno se lo sia la controfferta, ma se il fatto in sé che la controfferta sia ERENDA assicura all'utilizzatore di poter disporre impunemente del diritto, considerato anche che l'impegno assunto dal titolare nei confronti dell'organizzazione di normazione non è certamente stato quello di formulare un'offerta equa e ragionevole *che soddisfacesse* l'utilizzatore o fosse a lui particolarmente favorevole, ma solo e comprensibilmente che fosse equa e ragionevole in sé.

I problemi che si possono immaginare sono quasi infiniti in numero: cosa succede se la questione viene deferita al terzo indipendente ma le parti non raggiungono un accordo in proposito, ad esempio sulla persona del terzo o sulle istruzioni in base alle quali egli/ella dovrà decidere? Oppure: laddove l'offerta del titolare non sia ERENDA, sarà tenuto l'utilizzatore comunque a replicare con una controfferta 'equa e ragionevole'? Ovvero: laddove l'utilizzatore non formuli una controfferta ma accetti di designare un terzo, tale posizione è da considerarsi ERENDA in sé, pur in mancanza di una controfferta o dell'accettazione della prima offerta? Ovvero: che fare se questi risponde con una offerta che si estende ad un ambito (merceologico o geografico) diverso¹⁸?

In verità, la Corte crea a bella posta una struttura negoziale che possa condurre ad un esito equo e ragionevole, sotto il controllo della corte nazionale e con l'eventuale ausilio del terzo

¹⁸ N. PETIT (nt. 10).

indipendente. Ma evita, a mio avviso del tutto opportunamente, di entrare direttamente nella definizione del corrispettivo e dei termini dell'accordo¹⁹.

E' possibile che in tal senso possano venirci in aiuto i recenti casi nei quali le autorità nazionali si sono risolte ad applicare l'art. 102 con riferimento a fattispecie di prezzo eccessivo²⁰. Se tali casi pongono di regola un'enfasi particolare su certi comportamenti contraddittori o improntati ad apparente scorrettezza — quali l'improvviso significativo aumento del prezzo del farmaco o la negoziazione aggressiva dei prezzi con le autorità regolatorie - essi applicano il criterio stabilito nella assai risalente giurisprudenza nel caso *United Brands*²¹, e cioè in particolare quello della sussistenza di un “ragionevole rapporto con il valore economico della prestazione fornita”. Tale rapporto, sempre a seguire *United Brands*, potrebbe essere calcolato in base al “raffronto tra il prezzo di vendita del prodotto in questione e il suo costo di produzione”. O forse più propriamente ed in alternativa in base al valore di mercato di prodotti, e cioè nella fattispecie concreta dei brevetti, comparabili — salvo quanto si dirà subito per ciò che concerne la loro conoscibilità²².

Nel diritto americano, ad esempio, si è ritenuto che la via per raggiungere la determinazione del prezzo ERENDA sia quella di simulare una negoziazione tra licenziante e licenziatario. Secondo tale impostazione, in particolare, la corte è tenuta a “ricreare, nel miglior modo possibile, la situazione che caratterizzava ex ante la negoziazione della licenza, e a descrivere l'accordo risultante”²³. I parametri di riferimento, che spesso prevedibilmente si fondano sulla comparazione con casi analoghi, adottati dalla corte sono innumerevoli e rappresentano un adattamento di quelli elaborati precedentemente dalle corti federali in materia brevettuale²⁴. Ma i passaggi pratici utilizzati in quel caso, nell'interpretazione di un giudice successivo, sono: la determinazione della rilevanza del brevetto in questione [nel portafoglio di brevetti del quale fa parte e del portafoglio] rispetto allo standard; la rilevanza del brevetto in

¹⁹ In tal senso anche DREXL (nt. 12). Sul punto cfr. estensivamente M. MAUGERI, *Standardizzazione e disciplina del contratto: i F/RAND commitments*, in *Annuario del Contratto 2014* (a cura di A. D'Angelo e V. Roppo), Giappichelli, Torino, 2014, 48 ss.

²⁰ Cfr. in particolare, per l'Autorità italiana: A 480 *Incremento Prezzi Farmaci Aspen*, del 29 settembre 2016, in Bollettino n. 36/2016; nonché la decisione della CMA nel caso *Phenytoin sodium capsules* del 7 dicembre 2016, CE/9742-13.

²¹ Sentenza della Corte di giustizia del 14 febbraio 1978, causa 27/76, *United Brands Company e United Brands Continental BV c. Commissione*, ECLI:EU:C:1978:22.

²² §§ 250 s.

²³ Microsoft Corp. v. Motorola, Inc., 864 F. Supp. 2 ed. 1023 (W.D. Wash. 2012), 1325. Cfr. in genere, K. K. WONG-ERVIN, *Methodologies For Calculating FRAND Damages*, in law360.com, 2014.

²⁴ Nel caso Georgia-Pacific Corp. v. US Plywood Corp., 318 F. Supp. 1116 (S.D.N.Y. 1970).

questione rispetto al prodotto dell'attore; la quantificazione dei canoni stabiliti per contratti di licenza paragonabili a quello²⁵.

Recentemente, poi, è stata approvata la valutazione di un brevetto BEN con riferimento ai canoni pattuiti per brevetti di simile funzionalità, anche laddove tali canoni non riflettessero necessariamente il valore del brevetto nella considerazione del consumatore finale²⁶.

Anche per valutare il terzo termine della sigla EREN, la ‘non discriminazione’, occorre che prodotti/brevetti comparabili siano stati concessi in licenza sul mercato, e che si possa risalire ai corrispettivi pattuiti, cosa non sempre semplice in una situazione nella quale il più delle volte i relativi accordi saranno coperti da clausole di riservatezza.

Altre questioni nascono dalla fattispecie considerata e dalla possibilità che la soluzione offerta dalla Corte si estenda anche a situazioni diverse da quella. Così, ci si può legittimamente chiedere se la soluzione giuridica offerta dalla Corte si estenda anche a situazioni ove la misura inibitoria richiesta non ha come oggetto il ritiro del prodotto — ma ad esempio misure meno incisive come la presentazione della contabilità o il risarcimento dei danni - ovvero laddove le parti non siano concorrenti, considerato che appunto la Corte fa spesso riferimento, nel descrivere la soluzione proposta, ai rapporti tra ‘concorrenti’ (cfr. in particolare §§ 50, 52, 64 e 73).

Meno complessa ci pare la questione di stabilire se i principi espressi dalla Corte si possano applicare anche al caso di un brevetto ‘non essenziale’²⁷: pur nella sua forma piuttosto ellittica, infatti, la Corte pare esplicita nel considerare che la scorciatoia da essa delineata - comprensiva dunque dell’attribuita irrilevanza alla giurisprudenza IMS e sue ramificazioni - possa trovare applicazione solo nel caso in cui lo standard in questione sia appunto BEN, e in cui il titolare abbia offerto (ma questa è una necessaria conseguenza di quello, nell’ambito delle organizzazioni di normazione comune) un impegno EREN. Soluzione questa pure che, abbiamo visto, è diversa da quella divisata dal giudice americano.

Infine, ci si è chiesti chi (se l’autorità giudiziale nazionale, il terzo arbitratore o altro organismo) e quando (se prima o dopo il dispiegarsi della struttura negoziale articolata dalla Corte) debba stabilire tanto sulla validità quanto sulla ‘essenzialità’ del brevetto stesso che, abbiamo

²⁵ In re Innovatio IP Ventures LLC Patent Litig., (N.D. Ill. Oct. 3, 2013).

²⁶ Apple Inc. e Next Software, Inc. v. Motorola, Inc. (nt. 1).

²⁷ Rato (nt. 17).

visto, di questa giurisprudenza costituisce condizione necessaria²⁸. Ove la posizione ragionevole sembra essere che il giudizio vada esperito prima di ogni altra azione e che sia lo stesso giudice nazionale a condurlo nonché in genere a stabilirne le condizioni ed i tempi²⁹.

²⁸ N. PETIT, *Antitrust Claims in a Standards Context*, presentazione alla ASPI-LES APEB conference, Parigi, 14 giugno 2016.

²⁹ R. JACOB, *Lessons from Huawei v. ZTE*, 4iP Council, October 2016, <http://www.4ipcouncil.com/application/files/6314/7928/6022/Lessons%20from%20Huawei%20v%20ZTE%20-%20RJacob%20-%2024-10-16.pdf>.

THE HUAWEI CASE. PATENTS AND COMPETITION RECONCILED?

GABRIELLA MUSCOLO*

Summary: 1. The intersection between Intellectual Property and Competition and the litigation issue. – 2. Standard Essential Patents at the crossroad between the right of access to Courts, the abuse of litigation and the abuse of dominance. – 3. The abusive litigation doctrine and tests before Huawei. – 4. The Huawei case: the doctrine and the tests. – 5. The post Huawei case law. – 6. The role of enforcers and the role of the policy makers.

1. The intersection between Intellectual Property and Competition and the litigation issue.

According to current legal and economic theory,¹ the intellectual property (“IP”) system and competition law do not have conflicting goals, nor the grant of intellectual property rights (“IPRs”) contrasts with the competitive market model. On the contrary, the IP and antitrust systems play a complementary role in ensuring the correct functioning of the market; indeed, through different means, both of them contribute to the maximization of consumer welfare. In particular, from a general perspective, the protection of intellectual property is coherent with the macro-economic goal of promoting product differentiation, prevents the imitation of products by competitors and thereby eliminates the risk that investments in the market concentrate on already successful products.²

In addition, IPRs enforcement provides incentives to produce and commercialize inventions and creations and, by granting an exclusive right, allows the title-holder to appropriate the benefits and profits deriving from the use of his/her invention or creation³.

Competition law aims at ensuring the correct functioning of the market, by preserving the competitive process and favoring the maximization of consumer welfare. The development and commercialization of innovative products represent a key driver of economic growth and an important mean of rivalry among firms and enhance consumer welfare.

The IP system contains several provisions directed at stimulating competition, and in particular at favoring the circulation of innovative information, such as the duty to describe

* Commissioner at the Italian Competition Authority. Email: gabriella.muscolo@agcm.it. I would like to thank Gianluca Pastuglia and Amalia Luzzato, stagiare at the Italian Competition Authority, for their help in the broad research of international precedents.

¹ See e.g. D. HULL, *The Application of EU Competition Law in the Pharmaceutical Sector*, *Journal of European Competition Law & Practice*, Vol. 6, No. 1, 2015, pp. 61 ff., as well as S. VEZZOSO, *Towards an EU Doctrine of Anticompetitive IPRelated Litigation*, *Journal of European Competition Law & Practice*, Vol. 3, No. 6, 2012, pp. 521 ff.. See also the document prepared by the World Intellectual Property Organization (WIPO) in 2014 titled *Patent Pools and Antitrust – Comparative analysis*, available at www.wipo.int.

² See, e.g. D. SARTI, *Proprietà intellettuale, interessi protetti e diritto antitrust*, *Riv. dir. ind.* 2002, I, pp. 543 ff.; J. DREXL, *Is There a ‘More Economic Approach’ to Intellectual Property and Competition Law?*, in J. DREXL (eds), *Research Handbook on Intellectual Property and Competition Law*, Cheltenham, Edward Elgar, 2008, pp. 27 ff..

³ See e.g. W.S. BOWMAN, *Patent and Antitrust Law: A Legal and Economic Appraisal*, Chicago, University of Chicago Press, 1973, pp. 55 ff.

and disclose the invention in the database of the patent office.⁴ In certain circumstances, however, IP holders may use their rights so as to restrict rivalry in the market, violate competition and thereby reducing consumer welfare.

The issue of the abuse of IPRs as an antitrust violation has been discussed mostly in the context of the application of the rules on abuses of dominant position. However, the emergence of certain trends in the market, such as standardization and patent pooling, raised the question of the application of the prohibition against anti-competitive agreements.

The administrative, judicial and para-judicial enforcement of IPRs constitutes an important form of their exercise by the holder. Nevertheless, such right may be abused.

The issue of abusive IP enforcement and litigation is intertwined with the debate on the relationship between the IP system and competition law, since, under certain conditions, such enforcement and litigation may constitute an abuse of dominant position.

In the vast majority of legal systems, access to Court is a fundamental right, protected at the constitutional level⁵⁶. Some authors⁷ have underlined that, in balancing conflicting concerns, the prestige of such constitutional right tends to outweigh most vexatious concerns.

Also IPRs, and notably Patent Rights - due to their proprietary nature - have been qualified as fundamental rights, protected by national Constitutions and by the Convention of Human Rights.⁸

The competition principle has different legal value across national jurisdictions around the world.⁹ Probably, the highest level of protection is granted by the Treaty on the Functioning of the European Union.

Apart from the legal value of each of the above-mentioned rights and principles, a conflict between different interests - all of the utmost importance - emerges in cases involving patent protection and competition enforcement.

First of all, it has to be acknowledged the mentioned tension between IPRs and Competition.

⁴ See e.g. M. BERTANI, *Proprietà intellettuale, antitrust e rifiuto di licenze*, Milano, Giuffrè, 2004, pp. 18 ff..

⁵ On the right to health as a fundamental right to be balanced with patent protection and competition enforcement see B. CARAVITA, *Balancing the Human Right to Health with the Competition Law and the Intellectual Property Regime*, in G. PITRUZZELLA and G. MUSCOLO (eds), *Competition and Patent Law in the Pharmaceutical Sector. An International Perspective*, Alphen aan den Rijn, Wolters Kluwer, 2016, 53 et seq..

⁶ In the Italian Constitution, the right of petition is provided for in article 24. The Constitutional Court has developed a significant case law on the provision. With regard to the European Convention of Human Rights (ECHR), the right of petition may be inferred from article 6 .The principle is moreover stated by the European General Court in ITT Promedia: see EU General Court, 17 July 1998, case T-111/96, *ITT Promedia NV vs. Commission of the European Communities*.

⁷ See D. BORGES BARBOSA. L.H. SALGADO, G. FERRERO ZUCOLOTO, *Study on the Anti-Competitive Enforcement of Intellectual Property (IP) Rights: Sham Litigation* (2012), WIPO document prepared by the Institute for Applied Economic Research (IPEA), p. 11-12, available at www.wipo.int.

⁸ Article 42 of the Italian Constitution protects property rights. Article 1 of Protocol No. 1 of the ECHR added the right to the peaceful enjoyment of possessions in the ECHR.

⁹ The text of Italian Constitution expressly mentions “competition” only in article 117, which concerns the boundary line between the legislative powers of the State and of the Regions. A theory considers the freedom to compete as a feature of the freedom of enterprise, which is protected by article 41. A doctrine argues that the protection of the competitive market is a principle enshrined in the so called “Substantial Constitution”.

Secondly, several scholars highlighted the emergence of «a necrotic disease of the Intellectual Property system»¹⁰: notably patents, although also the copyright protection rationale, have been deeply criticized.¹¹

Finally, in several sectors, the intersection between IPRs and competition concerns, on one side, and fundamental rights - such as the right to health or the right to be informed as a feature of the freedom of thought -, on the other side, is at stake¹².

As far as absolute rights are concerned, the question arises if they can be interfered with lawfully, no matter how important the conflicting interests may be.

If a balancing process is admitted, the delimitation of the borderline between the use and the abuse of the mentioned rights becomes crucial in striking the balance among all potentially conflicting interests.

The legal community has been dealing with the interpretation of the “abuse of rights” doctrine since several decades¹³: we do not intend to enter the theoretical debate, but only to discuss such doctrine in relation to the abuse of process - to protect IPRs - as an anticompetitive issue.

In this respect, three general remarks may be done: the first one is that the abuse of an intellectual property right may directly harm competition, as well as it may be part of a more complex damageable practice.

Such remark applies also to vexatious litigation in the enforcement of IPRs: it may be used as a means in itself, but also be part of a broader anticompetitive strategy

The second remark is that, in cases in which the IP abuse is itself the cause of a tort to - effective or potential - competition, questions arise whether the legal use of the exclusive right does exclude by itself the possibility of anticompetitive effects or such use may be unlawful.

In this regard, on one hand, it has been argued that the IP system provides for inherent filters against the misuse of IPRs. On the other hand, however, external constraints - like antitrust or procedural rules - are considered as essential remedies to otherwise possible abuses.

Thirdly, it has been claimed that also the antitrust realm is crowded by opportunistic and anti-competitive lawsuits: in light of this, it has been questioned whether competition law may effectively constitute a cure to vexatious IP litigation.

In this latter regard, scholars highlighted, however, that antitrust law has taken stronger steps to mitigate rent-seeking through litigation and suggest to follow the same path in order to control opportunistic and anti-competitive intellectual property lawsuits. In such scenario,

¹⁰ See D. BORGES BARBOSA. *The basics: Vexing through IP*, 2013, p. 3, available at denisbarbosa.addr.com.

¹¹ See e.g. F. LÉVÈQUE, Y. MÉNIÈRE, *The Economics of Patents and Copyright*, 2004, available at services.bepress.com.

¹² See B. CARAVITA, (nt. 5), pp. 53 et seq..

¹³ See e.g. R. DE LA FERIA, S. VOGENAUER (eds.), *Prohibition of Abuse of Law: A New General Principle of EC Law?*, Oxford, Hart Publishing, 2009; A. GAMBARO, *Abuse of Rights in Civil Law Tradition*, European Review of Private Law, 1995, Vol. 3, Issue 4, pp. 561, 566; K. COATES, *The Estoppel Abuse* (October 2013), available at www.twentyfirstcenturycompetition.com.

the economic perspective can be helpful, as it stresses the effect of sham litigation on competition, therefore, on consumer welfare and economic efficiency¹⁴.

A paradigmatic example of the complex relationship between patent law and competition is the regime of the so-called Standard Essential Patents (“SEPs”) encumbered with obligations to license on fair, reasonable and non-discriminatory (“FRAND”) terms.

This article concerns the legal issues surrounding FRAND encumbered SEPs and the *Huawei* judgment. In particular, it addresses such issues in the context of the debate on the relationship between the IP systems and competition law and focuses on the abuse of injunctions as an abuse of dominant position.

The conclusions regards the different roles played by various decision makers and policy makers in assessing such controversial issues and underlines the major role to be attributed to enforcers, first of all Courts, but also Competition Authorities, in the balancing process to be based on a case by case approach.

2. Standard Essential Patents at the crossroad between the right of access to Courts, the abuse of litigation and the abuse of dominance.

According to the OECD definition,¹⁵ «Standard setting is the process of determining a common set of characteristics for a good or service» and technical standards «concern the establishment of norms and requirement for technical systems, specifying standard engineering criteria, methodologies or processes».

There are several classifications of standards. For instance, as explained by OECD, standards may arise from industry collaboration or uncoordinated processes¹⁶. Also, standards may be classified as *de jure* or *de facto* standards. According to the International Organization for Standardization (ISO) and the European Telecommunications Standard Institute (ETSI) – two of the most distinguished standard-setting organizations (“SSOs”) – a *de jure* standard may be described as «a document, established by consensus and approved by a recognized body, that provides, for common and repeated use, rules, guidelines or characteristics for activities or their results, aimed at the achievement of the optimum degree of order in a given context»¹⁷.

A technology constitutes, instead, a *de facto* standard, if it has been developed by one or more companies and, due to certain peculiar factors or events, it is adopted and implemented by

¹⁴ On the convergence of Law and Economics in this area see M.J. MEURER, *Controlling Opportunistic and Anti-Competitive Intellectual Property Litigation*, *Boston College Law Review*, 2003, Vol. 44, Issue 2, pp. 509 ff., who also indicates methods to discourage rent seeking activity by reducing the credibility of weak lawsuits and, more extremely, by restricting or eliminating certain intellectual property rights that generate relatively little direct social benefit. Also, of interest is the report drafted by BORGES BARBOSA, L.H. SALGADO, G. FERRERO ZUCOLOTO, (nt. 7), pp. 1 ff., who investigate sham litigation as a type of no-price predation in the light of the Game Theory .

¹⁵ See OECD, *Intellectual Property and Standard Setting, Background note by the Secretariat*, 2014.

¹⁶ See OECD, *Background Note by the Secretariat, Policy Roundtables. Standard Setting*, 2010, pp. 23 ff., available at www.oecd.org. As explained in the Background Note, standards may be set by governments.

¹⁷ See www.etsi.org/standards/what-are-standards.

most market actors. Indeed, sometimes private innovations are adopted with such universality that they become *de facto* standards.

Normally, standards arising from industry collaboration are agreed by standard-setting organisations, such as ISO and ETSI, in which patent holders and manufacturers of standard-compliant products participate. As a general rule, they may be classified as *de jure standards*.

In the context of SSOs, participation in the standard setting process is often unrestricted and transparent. Standards are frequently set through consensus after wide discussion among members.

SEPs are patents essential to implement a specific industry standard. This means that it is impossible to manufacture standard-compliant products – such as smartphones or tablets – without using technologies that are covered by said patents.

Standardization creates a specific context from the perspective of competition enforcement: on one hand, it implies benefits, favours economies of scale and reduce barriers to entry by fostering interoperability.

On the other hand, however, it may raise antitrust risks, facilitate the choice of one technology to the exclusion of others and give market power to the SEP owner, which would not have existed absent the standard, and which can be exploited.

In order to keep the benefits of standardization and to protect against its risks, several mechanisms can be implemented.

The first mechanism is the *ex-ante* disclosure of essential patents, which allows informed decisions by the participants in the standard setting process and protects against patent ambush.

Secondly, measures can be adopted in order to increase the level of transparency into SEPs ownership, thereby limiting the risk of high transaction costs and royalty rates.

Thirdly, SEPs owners are obliged to licence their SEPs on FRAND conditions, thereby ensuring access to the standard for all.

However, several problems related to the mentioned remedies may arise, such as the blanket disclosure of SEPs, the undisclosed transfer of SEP ownership, the so-called hold up or reverse hold up, disputes on the meaning of FRAND terms. Also, should FRAND-encumbered patents be transferred, it has been questioned whether the FRAND commitments apply also to the transferee.

Let us focus now on the FRAND issue and especially on its relation to question of the abuse of litigation and abuse of dominance .

In line with the Horizontal Cooperation Guidelines¹⁸, SSOs require the owners of patents that are essential for the implementation of a standard to commit to license these patents on FRAND terms.

¹⁸ Paragraph 287 of the Guidelines on the applicability of Article 101 TFUE to horizontal co-operation agreements provides as follows: «FRAND commitments are designed to ensure that essential IPR protected technology incorporated in a standard is accessible to the users of that standard on fair, reasonable and non-discriminatory terms and conditions. In particular, FRAND commitments can prevent IPR holders from making the implementation of a standard difficult by refusing to license or by requesting unfair or unreasonable

These commitments are mere contractual obligations and not statutory rules. Therefore, non-compliance with FRAND commitments can be addressed, for instance, as a breach of contract, under contract law, or, in case of dominant firms, as an abuse of dominance under antitrust law.

As for dominance, the holding of SEPs may mean market power. Nevertheless, neither IPRs nor standards can be presumed to confer dominance: market power has to be assessed on a case by case basis. In this regard, one should, firstly, define the relevant market, and, secondly, assess the power of the company in such market. In this regard, substitutability, market shares, indispensability, lock-in, countervailing buyer power are concurrent concepts and criteria to be applied.

In the Horizontal Cooperation Guidelines, the Commission acknowledges that there is no presumption that holding a SEP implies the existence of market power.¹⁹

Moreover, a patent which has been declared essential to a standard may turn out to be invalid or non-essential to implement the same standard.

As for the abuse, the refusal to offer SEPs on FRAND conditions may constitute an exclusionary abuse by vertically integrated competitors or an exploitative abuse, if the patent holder does not compete with licensees.

However, FRAND commitments does not imply the obligation to license independently of the economic conditions of the licensing agreement. Therefore, determining what fair, reasonable and non discriminatory means in practice appears as a core issue.

Moreover, the provision of the FRAND safe harbour within EU guidelines does not automatically imply that non-compliance with FRAND commitments amounts automatically to an infringement of either art. 101 or art. 102 TFEU.²⁰

Moving to SEP-based injunctions as a particular case of abuse, injunctions as a measure to enforce IPRs are in themselves a legitimate remedy, protected at the constitutional level in a large majority of legal systems.

However, due to the specific context created by standardisation, bringing an action for injunction to protect a FRAND encumbered SEP may amount to an abuse, if the defendant is a licensee willing to enter into a FRAND licence.

In this context, in a number of jurisdictions, some significant body of law and case law have been developed to regulate the abusive use of legal means and even a set of tests has been adopted to assess the abuse of litigation²¹. Let us examine the abusive litigation doctrine and tests applied to SEPs, before and after the Huawei case.

3. The abusive litigation doctrine and tests before Huawei.

fees (in other words excessive fees) after the industry has been locked-in to the standard or by charging discriminatory royalty fees».

¹⁹ See European Commission, *Guidelines on the applicability of Article 101 of the Treaty on the Functioning of the European Union to horizontal co-operation agreements*, (nt. 18) 2011, para. 269,

²⁰ See G. BRUZZONE, M. BOCCACCIO, *Standards under EU Competition Law: The Open Issues*, in G. CAGGIANO, G. MUSCOLO, M. TAVASSI (eds), *Competition Law and Intellectual Property. A European Perspective*, Alphen an den Rijn, Wolters Kluwer, 2012, 104.

²¹ See BORGES BARBOSA, L.H. SALGADO, G. FERRERO ZUCOLOTO, (nt. 7), pp. 27, 28

Some of the most active jurisdictions in developing sham litigation doctrines are US and EU and their positions – in this field - are singularly close.

Under the Noerr-Pennington doctrine,²² the first question to be answered is whether - according to an objective standard - the plaintiff reasonably could be held to believe it had rights to be protected. Secondly, it has to be assessed the intent of the same plaintiff and in particular whether the lawsuit was conceived as part of a plan aimed at eliminating competition.

Moreover, when dealing with a number of lawsuits, the question is not whether one or more of them have merit, but whether they are initiated without regard to the merit of the case and for the purpose of injuring a competitor.

The Noerr-Pennington and sham litigation doctrines developed by US Courts have been criticized by scholars on the grounds that they fail to consider relevant constitutional principles other than the right to petition, which may shift the current balance. As a result, the right to petition is strongly protected and such doctrines are rarely applied in practice.

In the European Union, the ITT Promedia²³ cumulative criteria have been applied: the bringing of a lawsuit by a dominant company is abusive if such lawsuit (i) cannot reasonably be considered as an attempt to enforce its rights and can therefore only serve to harass the opposite party, (ii) is «manifestly unfounded» and (iii) is «conceived in the framework of a plan whose goal is to eliminate competition».

²² See, *inter alia*, *E. R.R. Presidents Conference v. Noerr Motor Freight, Inc.*, 365 U.S. 127 (1961) (“Noerr”); *United Mine Workers of Am. v. Pennington*, 381 U.S. 657 (1965) (“Pennington”) (the so called Noerr-Pennington doctrine is named after these Supreme Court cases); *City of Colum. v. Omni Outdoor Adver, Inc.*, 499 U.S. 365, 379 (1991) (“it is obviously peculiar in a democracy, and perhaps in derogation of the constitutional right ‘to petition the Government for a redress of grievances,’ U.S. Const., Amdt. 1, to establish a category of lawful state action that citizens are not permitted to urge”); *Vibro Corp. v. Conway*, 669 F.3d 675, 683-84 (6th Cir. 2012) (explaining that Noerr-Pennington protects the constitutional right to petition the government embodied in the Petition Clause of the First Amendment); *Mercatus Grp., LLC v. Lake Forest Hosp.*, 641 F.3d 834, 846 (7th Cir. 2011) (“Noerr-Pennington was crafted to protect the freedom to petition guaranteed under the First Amendment.”)

²³ See EU General Court, (nt. 6). In ITT Promedia case, Belgacom had the exclusive right to publish the listing of its subscribers as part of its telephone concession. Once this right was excluded in 1994 by a supervening law, a company (ITT Promedia) requested access to the database to publish a specialized, commercial edition of the same listing. Belgacom refused Promedia the requested access. ITT then went to a Belgian court to claim the access to the database; eventually, the case was settled. Belgacom, however, initiated a new action in court, arguing a number of rights it alleged to remain in force from the prior contract; such rights referred to various items of data, commercial know-how and intellectual property rights. The court took position against Belgacom, stating that the rights alleged by plaintiff contravened the 1994 law. ITT defended itself by asserting that Belgacom suit was vexatious and therefore illegal, but such claim was refused by the court. In pursuance of the same argument, ITT filed a case before the Commission of the European Communities, at the time acting as the administrative antitrust agency within the European environment. According to ITT claim, Belgacom had abused a dominant position, contrary to Article 86 of the Treaty, by initiating that suit before the Belgian courts, when it should be classified as a vexatious litigation. The Commission understood that Belgacom had not abused its dominant position by so raising in court the intellectual property claims. To ascertain such result, it proposed a two-thronged test (ITT Promedia test). ITT filed before the European Court of First Instance (now General Court) a request of review of the Commission’s finding. The sham litigation test adopted by the Commission and upheld by the Court is structured as follows. In order to find an infringement of article 86, a dominant undertaking should file a lawsuit i) which cannot reasonably be considered as an attempt to establish its rights and can therefore only serve to harass the opposite party; the suit must be «manifestly unfounded»; and ii) which is conceived in the framework of a plan whose goal is to eliminate competition.

A substantive analysis of the tests leads to the conclusion that also EU authorities adopted a very narrow definition of vexatious litigation, as referring only to unmeritorious, groundless litigation. Under such test, the bringing of a lawsuit may not be considered abusive if there is only a likelihood that the party aimed at achieving an illegitimate result.

Even in jurisdictions without specific precedents on abusive litigation, the vexatious nature of lawsuits is assessed, considering the possibility of pathological use of the right of petition and the need to prevent evident harms to the competition environment.

It is worth noting that, even in those systems where a substantially objective standard seems to prevail, demonstration of unlawful intent is frequently required due to the particular nature of the discussed tests. The «too much subjectivity» issue represents one of sham litigation doctrines' most critical aspects and, indeed, the role of intent in current tests is often criticized²⁴.

In the litigation doctrine, different conducts have been examined and studied. However - in the field of Intellectual Property - particular attention has been paid to the abuse of preliminary and permanent injunctions, due to the qualitative and quantitative significance of such remedies in the IP framework.

In the US, in the *MercExchange* case,²⁵ the Court established a four-step test in order to assess whether injunctions are appropriate. In order to obtain injunctive relief, it should be demonstrated that: (i) the plaintiff suffered irreparable harm; (ii) monetary damages are inadequate; (iii) the injunction is warranted in view of the balance of hardships between the plaintiff and defendant; (iv) it serves the public interest.

In Europe, the Commission opened up the debate with the *Motorola* landmark case,²⁶ and affirmed several principles related to the abuse of dominance and the abuse of litigation issues in the FRAND encumbered SEPs realm.

²⁴ See V. GUIMARÃES DE LIMA E SILVA, (nt. 23), pp. 455 ff..

²⁵ See *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006).

²⁶ See European Commission, 29 April 2014, case AT.39985, *Motorola - Enforcement of GPRS standard essential patents*. In the case at hand, the Commission started an investigation against Motorola Mobility for a potential abuse of dominance under Article 102 TFEU, by seeking and enforcing an injunction against Apple in Germany in relation to a smartphone SEP covering GPRS standard. The Motorola Mobility SEPs in question relate to the ETSI GPRS standard, part of the GSM standard, which is a key industry standard for mobile and wireless communications. When this standard was adopted in Europe, Motorola Mobility declared some of its patents as being essential and gave a commitment that it would license such patents on FRAND terms. Motorola sought to enforce the injunction, despite Apple agreeing to be bound by a determination of FRAND royalties by the German court. The Commission concluded its investigation, finding that Motorola has abused its dominant position under Article 102 TFEU on two accounts: (i) by seeking and enforcing an injunction against Apple on the basis of a SEP which it had committed to license on FRAND terms, and where Apple had agreed to take a licence and be bound by a determination of the FRAND royalties by the relevant German court; (ii) by insisting, under threat of enforcement of the injunction, that Apple give up its right to challenge the validity or infringement by Apple's mobile devices of Motorola's SEPs. No fines have been imposed on Motorola on the basis that there is no EU case law available on the application of Article 102 TFEU to SEP based injunctions, and that national courts have so far reached diverging conclusions on the issue.

As far as the definition of the relevant market is concerned, the Commission differentiates between: (a) an input market, which is the market for the licensing of the technology; and (b) an output market, which is the market for the products incorporating that technology.²⁷

The Commission identified the relevant market on the basis of the criteria of demand-side and supply-side substitutability.²⁸ It reached the conclusion that «there are no viable substitutes to the GPRS standard in the European Economic Area. In order to manufacture and sell lawfully a GPRS-compliant product, an implementer of the GPRS standard must therefore obtain a licence to the technology, as specified in the GPRS standard technical specifications, on which Motorola's Cudak GPRS»²⁹

With respect to the issue of dominance, the Commission affirmed the principle, according to which the mere holding or exercise of SEP rights does not confer dominance on its own, but market power must be assessed on the basis of all relevant factors. Three factors are given particular importance in this assessment: (i) the indispensability of the standard; (ii) the industry lock-in to that standard; (iii) the absence of countervailing bargaining power.³⁰

²⁷ Idem, at para. 183, that recalls the *Guidelines on technology transfer agreements* (see European Commission, *Guidelines on the application of Article 101 of the Treaty on the Functioning of the European Union to technology transfer agreements*, 2014, available at eur-lex.europa.eu). See European Commission, *Motorola – Enforcement*, (nt. 29), at para. 184-191: «For the purposes of this Decision, the relevant input market is the market for the licensing of the technology, as specified in the GPRS standard technical specifications, on which Motorola's Cudak GPRS SEP reads, and the relevant output market comprises the downstream products on which GPRS standard-compliant products, such as chipsets and mobile devices, are sold. [...] this Decision focusses on the market for the licensing of the technology, as specified in the GPRS standard technical specifications, on which Motorola's Cudak GPRS SEP reads. [...] The definition of technology markets follows the same methodology as that for general product market definition. Technology markets consist of the technology and the IP protecting that technology and its close substitutes, i.e. other technologies and related IP rights which customers could use as alternatives. [...] The relevant technology market in this case encompasses the technology, as specified in the GPRS standard technical specifications, on which Motorola's Cudak GPRS SEP reads, and other technologies to which customers could switch in response to a small but permanent increase in relative prices of Motorola's technology».

²⁸ Idem, at para. 193-210: «For the purposes of this Decision, the Commission has reached the conclusion that for manufacturers of mobile devices in the EEA, there are no substitutes to Motorola's technology, as specified in the GPRS standard technical specifications, on which Motorola's Cudak GPRS SEP reads. This conclusion is based on the following three elements: (i) GPRS, part of the GSM mobile telecommunication technology (2G/2.5G technology), cannot be substituted by mobile standards of other generations, such as UMTS (3G technology) or LTE (4G technology); (ii) GPRS cannot be substituted by any other 2G standard; and (iii) GPRS cannot be lawfully implemented without having access to the Cudak patent. [...] In the present case, there is a lack of supply-side substitutability due to the fact that the technology on which the Cudak GPRS SEP reads is part of the GPRS standard. It is impossible for any other holder of SEPs (relating to GPRS or any other standard) to provide customers with alternatives to the technology, as specified in the GPRS standard technical specifications, on which Motorola's Cudak GPRS SEP reads. The holders of other technologies, whether patented or not, cannot supply technologies fulfilling the same function within GPRS due to the nature of the technology, as specified in the GPRS standard technical specifications, on which Motorola's Cudak GPRS SEP reads».

²⁹ Idem, at para. 212.

³⁰ Idem, at para. 225-241: «Motorola holds a 100% share of the market for the licensing of the technology, as specified in the GPRS standard technical specifications, on which Motorola's Cudak GPRS SEP reads. Motorola's mere holding or exercise of its rights under the Cudak GPRS SEP does not, however, confer dominance on its own. This must be assessed on the basis of all relevant factors. Two factors are of particular importance for this assessment: first, the indispensability of the GPRS standard on which Motorola's Cudak GPRS SEP reads for manufacturers of standard-compliant products, and, second, the industry lock-in to that standard. Due to the widespread adoption of the GPRS standard, it is indispensable for manufacturers of

Finally, in relation to the abusive nature of the conduct, the Commission underlined that seeking injunctions before courts is generally a legitimate remedy for patent holders in case of patent infringements. However, seeking an injunction based on SEPs may constitute an abuse of a dominant position, if a SEP holder has given a voluntary commitment to license its SEPs on FRAND terms and where the company against which an injunction is sought is willing to enter into a licence agreement on such FRAND terms.

Exceptional circumstances in this case may be: (i) standard setting; (ii) commitment to license on FRAND terms; (iii) the existence of a dominant position;³¹ (iv) no objective justification for the bringing of the lawsuit against a willing licensee.

The Commission argued that, since injunctions generally involve a prohibition of the product infringing the patent being sold, seeking SEP-based injunctions against a willing licensee could imply the risk of excluding products from the market. Such a threat against the standard implementer can therefore distort licensing negotiations and lead to anticompetitive licensing terms that such implementer would not have accepted absent the seeking of the injunction.

As a conclusion, according to the Commission, such an anticompetitive outcome would be detrimental to innovation and could harm consumers.

The Commission has faced the above-mentioned issues in several other cases, such as the Google/Motorola Mobility merger case,³² in which the Commission approved acquisition of Motorola Mobility by Google and reaffirmed the above-described principles³³.

mobile devices to comply with that standard. The widespread adoption of GPRS is mainly due to its inclusion into the GSM standards specifications in GSM Release 97 (and subsequent versions) and the wide implementation of that standard by networks operators in their 2G networks. [...] Due to the wide adoption of GPRS in the EEA and the need of operators and device manufacturers to base their services and products on the same air interface technology, so that devices can communicate with the network, industry players are locked-in to the GPRS technology. [...] Therefore, the Commission's assessment of whether Motorola enjoys a dominant position is based on the economic strength Motorola enjoys as the holder of the Cudak GPRS SEP vis-à-vis the market as a whole, and not on the basis of its negotiating position vis-à-vis one or more customers such as Apple».

³¹ Note that commitment to license on FRAND terms can be used to influence the adoption of a certain industry standard. For instance, if there's competition between two alternative standards, the commitment to license on FRAND, by lowering (ex-ante) transaction costs, can drive the industry toward the adoption of the FRAND-encumbered standard.

³² See European Commission, 13 February 2012, Case COMP/M.6381, *Google/ Motorola Mobility*.

³³ «Depending on the circumstances, it may be that the threat of injunction, the seeking of an injunction or indeed the actual enforcement of an injunction granted against a good faith potential licensee, may significantly impede effective competition by, for example, forcing the potential licensee into agreeing to potentially onerous licensing terms which it would otherwise not have agreed to» It also repeated that «the seeking or enforcement of injunctions on the basis of SEPs is also not, of itself, anti-competitive. In particular, and depending on the circumstances, it may be legitimate for the holder of SEPs to seek an injunction against a potential licensee which is not willing to negotiate in good faith on FRAND terms» See European Commission, *Google/ Motorola Mobility*, (nt. 32), paras. 107 and 126.

In the Samsung case,³⁴ according to the commitments accepted by the Commission, Samsung will not seek injunctions in Europe on the basis of its SEPs on smartphones and tablets against licensees who sign up to a specified licensing framework.³⁵

Several national courts have dealt with the above-mentioned issues and adopted different legal solutions: as a general remark, preliminary injunctions have been usually denied when FRAND encumbered SEPs were involved and courts typically have taken into consideration whether the parties were negotiating in good faith.

In Italy, in the Samsung-Apple case,³⁶ the Intellectual Property Specialized Court of Milan rejected the request for a preliminary injunction for alleged infringement of FRAND encumbered SEPs, taking into account that serious negotiations had already taken place between the parties. However, the Court did not find bad faith in the conduct of the parties and this was deemed sufficient to exclude, in the preliminary ruling, that the SEP holder had committed an abuse of dominance by seeking injunctive relief.

In Germany, in the Orange Book Standard case,³⁷ the German Federal Court of Justice adopted an approach more favourable to patent-owners. In order to avoid an injunction, the license seeker: i) must have made an unconditional binding offer for the conclusion of a license that the patent owner cannot refuse without being in breach of its obligations; ii) must satisfy in advance the obligations ensuing from the license agreement that is being concluded. These criteria have been further specified by German lower courts, which adopted a less favourable approach towards license seekers.

In the French Samsung/Apple case,³⁸ the Court declined Samsung's claim on factual grounds and stated that the measure of the injunction would be manifestly disproportionate. However, it also rejected Apple's counterclaim for damages for abuse of process.

³⁴ See European Commission, 29 April 2014, case AT.39939, *Samsung - Enforcement of UMTS standard essential patents*.

³⁵ Under this framework, any dispute over what are FRAND terms for the SEPs in question will be determined by a court, or if both parties agree, by an arbitrator. The commitments therefore provide a "safe harbour" for all potential licensees of the relevant Samsung SEPs. Indeed, potential licensees that sign up to the licensing framework will be protected against SEP-based injunctions by Samsung. To address the Commission's concerns, Samsung has for a period of five years committed not to seek any injunctions in the European Economic Area (EEA) on the basis of any of its SEPs, present and future, that relate to technologies implemented in smartphones and tablets against any company that agrees to a particular framework for licensing the relevant SEPs. The licensing framework provides for: i) a negotiation period of up to 12 months; ii) and if no agreement is reached, a third party determination of FRAND terms by a court if either party chooses, or by an arbitrator, if both parties agree on this.

³⁶ See Court of Milan, order dated January 5, 2012, in *Giur. it.* 2013, pp. 86 ff.

³⁷ See BGH, May 6, 2009, case n. 39/06, *Orange Book Standard*, available at www.bundesgerichtshof.de.

³⁸ See Tribunal de Grande Instance of Paris, 8 December 2011,(Docket No. 11/58301). The judgment has been issued in the context of a worldwide dispute between the companies Samsung and Apple. Samsung initiated an action for preliminary injunction before the Court of Paris against Apple, alleging the infringement of its SEP by the chips contained in Apple's products. Apple, by way of defense, contested the adversary claims on the following grounds: 1. the occurred exhaustion of Samsung's IP rights related to the chips at issue; 2. Apple companies were already granted a "FRAND" user license for Samsung patents by virtue of the rules of ETSI, including Article 6-1 of IPR Policy; in the alternative, Samsung's irrevocable undertaking pursuant to Article 6-1 of the ETSI IPR Policy constitutes an irrevocable granting offer; 3. the invalidity of the patents at stake for lack of novelty and/or of inventive step (in this regard, it should be noted that such patents have been limited by Samsung before EPO); 4. the enforcement of the patents in the present case constituted an abuse of a dominant position. The Court of Paris rejected Samsung's claims, upholding Apple's objection concerning the

Also, a few National Competition Authorities have tackled the issue: in the United States, in the Google case,³⁹ the Federal Trade Commission (FTC) stated that Google, by seeking injunctions for infringement of FRAND-encumbered SEPs for mobile phones, video codec, and wireless LAN standard's against willing licensees, engaged in unfair methods of competition and committed a violation of the Sherman Act. Under the settlement reached with the FTC, Google has undertaken not to request preliminary injunctions, except for IP proceedings against a potential licensee who: 1.is outside the jurisdiction of US District Courts; 2. refuses to enter a license agreement covering the FRAND-encumbered Patent on terms that have been set in the final ruling of a Court or through binding arbitration; 3. does not provide the written acceptance of the arbitration offer.

In the Robert Bosch case,⁴⁰ the FTC alleged that SPX has failed to honor the commitment to license on FRAND terms by seeking injunctions against willing licensees of patents and, having ascertained an unfair method of competition, as well as a Sherman Act violation, closed the proceedings with a settlement. In particular, on the basis of such settlement, Bosch has agreed to abandon claims for injunctive relief related to SEPs owned by SPX. Only in the following two cases, Bosch is entitled to continue IP enforcement proceedings: 1.a Court finds that the SEP is used by a competitor for a purpose other than the implementation; 2. the counterparty has stated in writing that it will not require a license or comply with the FRAND terms agreed between the parties / determined by the Court.

However, although the US Department of Justice (DoJ) and the FTC have just published an updated version of the Antitrust Guidelines for the Licensing of Intellectual Property,⁴¹ the topic of standard essential patents remains unaddressed in such text.

In China, on February 10, 2015, the National Development and Reform Commission (NDRC) condemned Qualcomm to pay a fine for abusive licensing practices. In particular, Qualcomm, owner of several SEPs, adopted the following anticompetitive conducts: i) Charging unfairly high patent royalties; ii) Bundling SEPs and Non-SEPs without justification; iii) Imposing unreasonable terms on the sale of baseband chips.⁴²

exhaustion of Samsung's rights. According to the Court, Samsung has failed to prove that the objected chips were supplied by a company, which did not obtain a license for the patents at stake. Conversely, Apple had demonstrated that the chips were supplied by Qualcomm. The agreement between Qualcomm and Samsung, which provides Samsung's undertaking not to enforce its patent rights against Qualcomm's clients, should be deemed as a license, despite this is expressly excluded by a specific clause therein. As for the others three arguments raised by Samsung, they have not been taken into account by the judge (points 1-3). Indeed, the judge deems that, in the light of the above, it was not necessary to rule on the validity of patents, the abuse of dominant position and the FRAND offer. This last point should be evaluated within a proceeding on the merit.

³⁹ See Us Federal Trade Commission, Order dated July 23, 2013- Docket No. C-4410, *Google v. FTC*.

⁴⁰ See Federal Trade Commission, Order dated US April 23, 2013- Docket No. C-4377, *Robert Bosch v SPX*. The case concerns Robert Bosch GmbH's acquisition of the SPX Service Solutions business of SPX Corporation. Said latter company, which was the owner of several SEPs, made a commitment to license on FRAND terms.

⁴¹ See FTC and DoJ, *Antitrust Guidelines for the Licensing of Intellectual Property*, 2017, available at www.justice.gov, especially para 2.2. on Intellectual Property and Market Power. It should be remembered that the US Supreme Court held in its 2006 ruling in *Illinois Tool Works v Independent Ink* that patents do not necessarily confer market power.

⁴² Unofficial press release of the decision in English is available at <http://www.linklaters.com/pdfs/mkt/beijing/A19534114.pdf>.

On October 19, 2015, the Ministry of Commerce (MOFCOM) approved the merger of Alcatel-Lucent and Nokia, in accordance with anti-monopoly laws, provided that Nokia undertakes to license SEPs on FRAND terms.⁴³

On April 7, 2015,⁴⁴ the State Administration for Industry and Commerce (SAIC) adopted a regulation aimed at prohibiting the abuse of IPR to exclude or restrict competition (i.e. Order No. 74).⁴⁵

A similar guidance has been recently amended by the Japan Fair Trade Commission (JFTC) on matters related to FRAND-encumbered SEPs, such as the seeking of an injunction by holders of FRAND-encumbered SEPs.

4. The Huawei case: the doctrine and the tests.

Taking into account the different approaches followed by the Commission and the German Courts, on 21 March 2013, the District Court of Düsseldorf referred five questions to the European Court of Justice ("ECJ"):⁴⁶ a) does the owner of a FRAND encumbered SEP abuse its dominant position if he/she requests an injunctive relief, although the alleged infringer has declared its readiness to enter into negotiations? Or is an abuse to be excluded only if the license seeker has submitted to the patent owner an unconditional offer? b) if readiness to enter into negotiations is sufficient, are there any qualitative and/or time related requirements? c) if an unconditional offer is required, are there any qualitative and/or time related conditions that the alleged infringer must meet? May the offer include the condition that the SEP is legally valid? d) if the fulfilment by the licence seeker of the obligations arising from the future licensing agreement is a pre-requisite for preventing an injunction, are there specific conditions that the same seeker must meet (e.g. render an account for past acts of use)? e) does the same conditions for the finding of an abuse apply to actions against patent infringements other than injunctions (e.g. damages)?

⁴³ See Press release of Ministry of Commerce available at <http://english.mofcom.gov.cn/article/newsrelease/significantnews/201510/20151001151049.shtml>

⁴⁴ Unofficial version of the Order in English is available at www.linklaters.com/pdfs/mkt/beijing/19848090.pdf.

⁴⁵ In particular, according to article 13, «in the course of exercising intellectual property rights, undertakings shall not eliminate or restrict competition by setting or implementing standards (including mandatory requirements in national technical specifications). An undertaking with a dominant market position shall not, without any justification, engage in any of the following conducts in the course of setting or implementing standards to eliminate or restrict competition: (1) in the course of participating in setting standards, intentionally refraining from disclosing information on the patent to the standards-setting organisation, or explicitly waiving its patent right but nevertheless claiming for patent rights against undertakings implementing the standard after the patent is involved in the standard; and (2) refusing to grant a licence, tying products or imposing other unreasonable conditions on transactions in violation of the principles of fairness, reasonableness and non-discrimination in order to eliminate or restrict competition, after such patent becomes a standard essential patent. For the purpose of these provisions, standard essential patents refer to patents that are indispensable in implementing standards».

⁴⁶See European Court of Justice, 16 July 2015, case C-170/13, *Huawei Technologies/ZTE*.

In the Huawei judgement, the ECJ has reconciled the above-mentioned positions in an original way and confirmed the approach adopted by the Advocate General Wathelet in its opinion.⁴⁷

The Court has set up a number of specific obligations bearing upon the parties during the negotiation, explicitly stating that the failure by the SEP holder to comply with said obligations provisions would entail a violation of art. 102 TFEU. The mechanism should work as follows.

Before bringing an action against an alleged infringer, the SEP holder must alert the latter of the infringement complained about by designating the infringed SEP and specifying the way in which it has been infringed, «even if the SEP has already been used by the alleged infringer»⁴⁸.

As pointed out by the Advocate General, the reason for this obligation is that the high number of patents covering some hi-tech standards (e.g. in the smartphone environment) could lead a firm to infringe some of such patents without being aware of it.⁴⁹

Once the alleged infringer has expressed «its willingness to conclude a licensing agreement on FRAND terms», the SEP holder must submit «a written offer for a licence on FRAND terms [...] specifying, in particular, the amount of the royalty and the way in which that royalty is to be calculated»⁵⁰.

This is an ambiguous passage of the ruling, as the Court obliges the proprietor of the patent to present an offer in accordance with FRAND terms, but does not identify detailed technical criteria to exactly determine terms and rates.

It is not clear if this approach is a gap left blank on purpose by the ECJ or if it is a policy-making choice oriented to a «case by case approach». The latter option is likely to be the most realistic, as defining in depth what has to be meant with “«FRAND» could excessively limit the SEP holders’ right to run a business and to lead free negotiations with their counterparties.

The alleged infringer must respond diligently to the offer of the SEP holder, without adopting delaying tactics⁵¹. If the alleged infringer does not accept such offer, it must submit to the SEP holder, «promptly and in writing, a specific counter-offer that corresponds to FRAND terms». In absence of this counter-offer, the seeking of an injunction by the SEP holder does not have abusive nature.⁵²

A question instantly arises while reading this passage: how can the alleged infringer present an offer corresponding to non-discriminatory terms if he/she does not have access to the licensing agreements signed by the SEP holder with other parties with reference to the patent at issue? If determining FRAND rates proves to be hard for the SEP holder, as observed above, it could turn out to be impossible for the alleged infringer, since he/she has no access to important information. An answer to this issue has not been given by the ECJ.

⁴⁷See Opinion of the Advocate General Wathelet, 20 November 2014, case C-170/13, *Huawei Technologies/ZTE*.

⁴⁸ See European Court of Justice, (nt.46), para. 60-61.

⁴⁹ See paras 62 and 81.

⁵⁰ Idem, at para. 63.

⁵¹ See European Court of Justice, (nt.46), par. 65.

⁵² Idem, at para. 66.

If the alleged infringer is using the teachings of the SEP before a licensing agreement has been concluded and its counter-offer is rejected, it must provide financial security (i.e.: bank guarantee, deposit). The value of the security should be calculated on the basis of, *inter alia*, the number of the past acts of use of the SEP. The alleged infringer must be able to render an account in respect of said acts of use.⁵³

Where no agreement is reached on the details of the FRAND terms following the counter-offer by the alleged infringer, the parties may, by common agreement, request that the amount of the royalty be determined by an independent third party without delay.⁵⁴

In the sequence of procedural obligations placed on the parties for the negotiation of a licence, however, the timing of the alleged infringer's obligations remains unclear⁵⁵, although the Advocate General explains that «The time frame for the exchange of offers and counteroffers and the duration of the negotiations must be assessed in the light of the commercial window of opportunity available to the SEP holder for securing a return on its patent in the sector in question».⁵⁶

The alleged infringer always maintains the right to challenge the validity of the SEP or the essential nature of the patent for the implementation of the standard, independently from the outcome of the licensing negotiation.⁵⁷

The Huawei judgment apparently provides competition authorities and national courts with detailed guidance to strike a fair balance between IPRs, the right of access to a tribunal and the freedom to conduct business.

However, after the judgment, several issues remain open. Firstly, an open question concerns dominance: is the owner of a SEP always dominant? The ECJ skips the issue because «the questions posed by the referring court relate only to the existence of an abuse».⁵⁸

Previously, in his Opinion to the Court, Advocate General Wathelet incidentally wrote that «the fact that an undertaking owns a SEP does not necessarily mean that it holds a dominant position [...]», and that the presumption of dominance of the SEP holder should always be rebuttable.⁵⁹ However, since the referring court had posed no question concerning the existence of a dominant position, the Advocate General did not go further with his reasoning. Secondly, the Court does not rule on how FRAND are actually to be determined.⁶⁰ The methodology to determine FRAND rates remains subject to a «case by case» approach and,

⁵³ Idem, at para. 67.

⁵⁴ Idem, at para. 68.

⁵⁵ See C. BROWN-SANFORD, B. FORD, *Finding a way after Huawei: licensing of standard-essential patents*, Global Competition Review, 24 June 2016, available at globalcompetitionreview.com.

⁵⁶ See the Opinion of the Advocate General Wathelet, (nt.47) [par. 89]. On this point, Marty, Sibony and Wachsman note that the more the technological evolution is rapid in the sector, the shorter will be the aforesaid commercial window. See F. MARTY, A. SIBONY, A. WACHSMAN, *Brivet essentiel à une norme (BEN) – Licence "FRAND" – Actions en contrefaçon: La Cour de Justice de l'Union européenne précise les conditions de l'action en contrefaçon d'un brevet*, Concurrences 2015, 4, pp. 120 ff..

⁵⁷ See European Court of Justice, (nt. 51), para. 69.

⁵⁸ Idem at para. 43.

⁵⁹ Idem at para. 57-58.

⁶⁰ See SIR ROBIN JACOB -ALEXANDER MILNER “*Lessons from Huawei v. ZTE*” October 2016, available at www.4ipcouncil.com, underlines that stakeholders in mobile SEP licensing currently debates on the appropriate

as an increase in litigation is now expected, having no clear calculation parameters could at first lead to heterogeneous decisions by the «independent third party», which is called to determine the amount of the licensing royalties.⁶¹

Furthermore, in case in which the SEP holder has made an offer and the standard implementer has made a counter offer, but they are still unable to agree on the terms and conditions of the licence, the Court ruled that the parties may rely on an independent third party in order to determine the royalty rate. However, the Court does not offer guidance on what happens if they do not agree to submit their case to such third party.⁶²

Also what should happen where both the patentee's offer and the implementer's counteroffer are both FRAND?⁶³

Thirdly, the Court did not clarify the extent to which the SEP holder can require the standard implementer to take a global licence for its SEPs rather than a licence limited to the jurisdiction in which such patents are litigated or likely to be litigated.⁶⁴ Moreover, the Court did not specify whether, in case of families of patents, the SEP holder can oblige the alleged infringer to take a licence for the whole patent portfolio covering the standard technology, instead of a licence on the mere SEP at stake.

A connected issue not addressed by the Court is that the fragmentation of patent portfolios and the growing use by patent owners of patent assertion entities may lead to royalties stacking; the increase of the total amount of royalties paid for standard technologies might not be compatible with FRAND terms.⁶⁵

Fourthly, it has been noted that, in accordance with the Opinion of the Advocate General, the judgment focused on the weighing of conflicting rights and interests and did not take into account economic theories of effect and efficiencies.⁶⁶

A fifth open question is whether the patentee can require the implementer to enter into a Non-Disclosure Agreement prior to making an offer.⁶⁷

A sixth issue not addressed by the Court is whether or not the FRAND commitment may amount to a contract for the benefit of third parties and therefore an implementer can be entitled to a FRAND license by virtue of such a contract. Indeed, third parties can enforce contracts intended for their benefit.⁶⁸

royalty base and in particular whether it should be the “smallest saleable unit” (“SSU”) or per device, also known as the “Smallest Saleable Patent-Practising Unit” or “SSPPU”).

⁶¹ See this comment in B. LUNDQVIST, *The Interface between Competition Law and Standard Essential Patents – Some Early Comments on the Huawei case*, 2015, available at ssrn.com; Id., *The interface between EU competition law and standard essential patents – from Orange-Book-Standard to the Huawei case*, European Competition Journal 2015, vol. 11, Issue 2-3, pp. 367 ff.; D. GERADIN, *European Union Competition Law, Intellectual Property law and Standardization*, in *The Cambridge Handbook of Technical Standardization Law* (forthcoming 2016), pp. 17 ff., available at ssrn.com.

⁶² See D. GERADIN, (nt. 60), 17 ff.

⁶³ See R. JACOB, (nt. 60), 3 whose opinion is that in this case, the key question is whether the patentee's offer is FRAND, and, if it is, he has fulfilled his commitment and is not guilty of any abuse.

⁶⁴ See D. Geradin, (nt. 60), 17 ff.

⁶⁵ Ibidem C. BROWN-SANFORD, B. FORD, (nt. 55).

⁶⁶ See in this regard B. LUNDQVIST, (nt. 61), 1 ff.; Id., (nt. 61), 367 ff.

⁶⁷ According to R JACOB , (nt.60), p. 12 considering that this is standard practice and that the companies exchange information about their respective businesses, it would be advisable to allow this.

⁶⁸ See R JACOB ,(nt. 60), p. 12 who affirms that, since the commitment is given to the standard development organization (e.g. ETSI) in the form of a contract, the same commitment may be deemed as contractual.

A seventh question is how a court should proceed where the defendant contends that the patent is invalid and/or not used, a sub-question being whether, in case an implementer unsuccessfully challenges validity, essentiality or use, the patentee can/must charge more than he/she charged those who did not make any of such challenges.⁶⁹

Furthermore, the Huawei judgment has raised several questions on its scope of application. For instance, it may be argued that the ruling does not apply to *de facto* standards.⁷⁰

Also, it is not clear whether the ruling only refers to the case of vertically integrated firms attempting to exclude a competitor in the downstream market or also applies, at least by analogy, where the SEP proprietor and the alleged infringer are not competitors.⁷¹ In light of this, it is doubtful whether the ruling applies also to patent trolls and patent assertion entities.⁷²

5. *The post Huawei case law.*

The judgment of ECJ has been followed by several decisions in European jurisdictions and notably in Germany and UK⁷³.

German courts affirmed several principles: firstly, on the applicability of article 102 TFEU, German case law argued that the legal consequences of a patent ambush is a licensing obligation on FRAND terms with respect to the patent, irrespectively of the applicability of article 102 TFEU, but not, automatically, the denial of injunctive relieves under patent law.⁷⁴

⁶⁹ R Jacob's opinion in R JACOB , (nt. 60), p. 13 is that it is possible that the patentee is entitled to apply higher royalties to the above-mentioned implementers, considering also the commitment of the patentee not to discriminate among licensees.

⁷⁰ See B. LUNDQVIST, (nt. 61), 1 ff.; Id., (nt. 61), 367 ff

⁷¹ Ibidem; see also F. HÜBENER, M. JAKOBS, *SEP or no SEP? Open questions after Huawei/ZTE*, *European Competition Law Review* 2016, Vol. 37, 33 ff.

⁷² At the beginning, the judgment refers to «competitors» and then switches to the term «infringers»; however, the judgment always refers to competitors when it draws up the requirements for the exceptional circumstances doctrine. The Commission seems to be of the opinion that the Huawei doctrine applies also where the patent owner does not compete in the downstream market: see the speech of Margrethe Vestager, *Intellectual property and competition*,

19th IBA Competition Conference, Florence 11 September 2015, available at ec.europa.eu/commission, affirming that «In my view, this obligation applies to whoever exercises the patent right in question».

⁷³ See in this regard B. LUNDQVIST, (nt. 61), 1 ff.; Id., (nt. 61), 367 ff.

⁷⁴ Outside Europe, in Japan, the Japan Federal Trade Commission (JFTC), on November 18, 2016, issued a decision ascertaining the violation of the Antimonopoly Act by the company One-Blue. Said company, holder of several SEPs, has declared that it will license them on FRAND terms. In a nutshell, during the negotiations between One-Blue and Imation, the latter company was willing to pay a FRAND fee and requested at the same time to explain how license fees were determined. However, One-Blue gave no explanation and was unable to negotiate the license fee in order to provide non-discriminatory terms. Afterwards, for the purposes of advancing negotiations, One-Blue sent notice to three of the main customers of Imation, warning them that it had the right to seek injunction against them. After having found the violation of the Antimonopoly act, the JFTC, however, stated that it was not necessary to issue a cease-and-desist order because the relevant violation has already ceased.

⁷⁵ See Regional Court Düsseldorf, dated 3 November, 2015, file no. 4a O 144/14, *Sisvel vs. Haier*, in www.darts-ip.com. In the case at hand, the company Sisvel requested an injunction before the Regional Court for the violation of the German part of its European patent no. EP 0852885B1 by the company Haier. Since such patent was essential for the implementation of the GPRS standard developed by the ETSI, Sisvel committed itself to license such patent to third parties on FRAND terms. In light of this, Haier defended itself by asserting

On the applicability of article 101, German courts stated that also the application of art. 101 TFEU does not lead automatically to the denial of the injunction. Indeed, «a violation of art. 101 TFEU can only lead to the nullity of the standardization agreement and may, under certain circumstances, trigger third party civil law claims for injunctive relief and removal with respect to the cartel-law violation, namely the adoption of the standard. [...] Such a violation does not preclude the assertion of SEPs. The third-party damages claim [resulting from the violation of article 101] is not a claim for the grant of a license either».⁷⁵

Secondly, the German Courts have ruled on the meaning of FRAND: the customary level of royalties in the industry is an indication of FRAND terms; however, when considering royalties applied in the industry, the specific technology licensed should be also taken into account and may justify a deviation from customary levels.⁷⁶

The relevance of customary royalties also means that the more concluded license agreements on similar terms the SEP proprietor can present, the stronger is the assumption that the requested royalties are FRAND. In general terms, such previous license agreements are the more indicative, the more is similar the use undertaken by the alleged infringer relative to that of previous licensees. Also, the fact that the previous license agreement has been agreed after the claim of an injunction does not exclude *per se* that the same complies with FRAND terms.⁷⁷

German judges addressed also more specific issues on the meaning of FRAND in case of patent portfolios, patent pooling and worldwide licenses: according to some courts, in determining whether a portfolio license is FRAND, it is necessary to see whether this is in accordance with commercial practices in the relevant sector; in any case, the defendant may demonstrate that the SEP holder is bundling SEP and non-SEP patents in the portfolio license.⁷⁸

The comparison of the licensing conditions with those applied by a patent pool has been taken as an indication, but its probative value is limited: indeed, when a license is obtained via a large pool, participated by several companies, royalties will be normally lower.⁷⁹

that the judicial action of Sisvel constituted an abuse of dominant position. On similar issues, see also Regional Court Düsseldorf, dated 31 March 2016, file no. 4a I 73/14, *Saint Lawrence Communications vs. Vodafone, HTC*, in www.darts-ip.com. In the case at hand, Saint Lawrence Communications requested an injunction against Vodafone to restrain the offering/selling of smartphones. Certain European patents of Saint Lawrence were found to be a SEP for the Adaptive Multi-Rate-Wideband Standard (AMR-WB-Standard). HTC, because of its delivery of smartphones to Vodafone, was third party intervenor participating in the proceedings. The court dismissed the FRAND defense raised by Vodafone and HTC. Furthermore, the dismissal was also due to the fact that that Vodafone did not render account and provided security. The defendant applied for a preliminary stay of the enforcement of the first instance decision, which was rejected also because the Court of Düsseldorf had ascertained the compliance of St. Lawrence's offer with FRAND terms. See Higher Regional Court Düsseldorf, dated 9 May 2016, I-15 U 36/16, in www.darts-ip.com.

⁷⁵ See Regional Court Mannheim, dated 4 March 2016, file no. 7 O 23/14, in www.darts-ip.com. In such case, Philips – as SEP owner – requested an injunction against Acer.

⁷⁶ See Regional Court Düsseldorf, dated 31 March 2016, (nt. 74).

⁷⁷ Ibidem.

⁷⁸ Ibidem. On this issue, see also Regional Court Mannheim, dated 4 March 2016, (nt. 75).

⁷⁹ See Regional Court Düsseldorf, dated 31 March 2016, (nt. 74).

Some courts affirmed that a worldwide license is considered to be «common practice in the respective field of business» and therefore «not obviously infringing FRAND requirements».⁸⁰

An offer by the SEP holder specifying the due royalties and providing that the same royalties may be reviewed by a court – as a general principle – has been judged as compliant with the FRAND obligation.⁸¹

Thirdly, on the scope of application of the Huawei judgment, some Courts claimed that the negotiation requirements set out in such judgment apply regardless of whether the patent holder operates in the product market, or, in other terms, compete with the foreclosed alleged infringer or is a non-practicing entity.⁸²

According to one court, if the supplier of standard-compliant products complied with the obligations set out in the Huawei judgment, its customers can successfully raise the antitrust defense against the same SEP holder.⁸³

The obligations set out in the Huawei judgment have been qualified as «*a behavior test*», that also takes into account the common practice in the commercial sector concerned. According to some courts, a violation of the ECJ principles «suggests a lack of good faith»; considering the wording of the judgment, «the ECJ thus gives the national courts the possibility not to base their decision solely on the fulfillment of the obligations prior to the filing of the action as the only decisive criterion»⁸⁴.

Finally, German case law intervened on the procedural obligations established by the Huawei judgment: on the infringement alert, some German courts held that such alert can be done after filing the action for injunction (even with regards to non-transitional cases, i.e. actions initiated before the Huawei judgment),⁸⁵ that the same alert can be replaced by other sources, such as third parties and media,⁸⁶ and that it can be made to the parent company of the alleged infringer.⁸⁷

On one side, as far as the declaration of willingness of the alleged infringer is concerned, German Courts ruled that the expression of interest by the SEP user should be immediate. For instance, according to some courts, five months are too long for the SEP user to respond

⁸⁰ See Regional Court Mannheim, dated 4 March 2016, (nt. 75). According to the Court, a counter-offer license limited to Germany does not comply with FRAND terms, if the group of the alleged infringer make use of the patents in other countries.

⁸¹ See Regional Court Düsseldorf, dated 31 March 2016, (nt. 74).

⁸² Ibidem.

⁸³ Ibidem.

⁸⁴ See Regional Court Mannheim, dated 4 March 2016, (nt. 75).

⁸⁵ See Higher Regional Court Düsseldorf, dated 9 May 2016, (nt. 74).

⁸⁶ See e.g. Regional Court Mannheim, dated 27 November 2015, file no. 2 O 106/14, 2 O 107/14, 2 O 108/14, *Saint Lawrence Communications vs. Deutsche Telekom*, in www.darts-ip.com. In the case at hand Saint Lawrence Communications requested an injunction against Deutsche Telekom for the infringement of its SEP for the Adaptive Multi-Rate-Wideband Standard (AMR-WB-Standard). HTC smartphones sold by Deutsche Telekom .HTC was third party intervenor participating in the proceedings. The Court issued an injunction in favour of the SEP owner and rejected the defendant's FRAND defence, because Deutsche Telekom did not show its willingness to take a license on FRAND terms and because HTC counter-offer was too general.

⁸⁷ See Regional Court Düsseldorf, dated 3 November, 2015, (nt. 74).

to the infringement alert⁸⁸. According to other courts, «the supplier may not take more than three months since the notification through the customer to indicate willingness».⁸⁹

On the other side, on the offer by the SEP holder, some lower Courts excluded that such offer should comply with FRAND terms⁹⁰ or affirmed that only evident infringements of FRAND obligations must be examined by courts.⁹¹ However, some higher Courts have made clear that the SEP owner's offer needs to be FRAND in order to trigger the SEP user's following obligations and in order to exclude the abusive nature of the injunction.⁹²

In turn, the counter-offer by the SEP user should be specific; and the SEP holder is not obliged to accept offers that call for royalties to be determined by a third party. The option of having a third party determine the amount of the royalty mentioned by the ECJ only become available if the counter-offer is rejected and by common agreement of the parties⁹³.

Also, some courts gave some indications on the obligation of the SEP user to provide security and to render accounts: the security needs to cover all acts of use of the patent in the past. Indeed, according to the same courts, in mentioning «from the point at which its counter-offer is rejected»,⁹⁴ the Huawei ruling refers to the point in time when the security has to be provided to the plaintiff.⁹⁵ Also, some courts affirmed that the alleged infringer can prepare the security and the rendering of accounts while preparing its counter-offer; therefore, it will be in delay, if said security and the rendering are offered several months after the SEP owner declined the counter-offer.

⁸⁸ See e.g. Regional Court Düsseldorf, dated 31 March 2016, (nt.74).

⁸⁹ See Regional Court Mannheim, dated 27 November 2015, (nt. 86).

⁹⁰ See e.g. Regional Court Düsseldorf, dated 3 November 2015, (nt.74). According to the Court, the alleged infringer must nonetheless make a counter-offer and, in any case, promptly reply; in addition, if it is already making use of the patent, it should – irrespectively of the fact that the offer is not FRAND – draw up an account and provide a security. Said judgment has been overturned on appeal by the Higher Regional Court Düsseldorf, dated 13 January 2016, I-15 U 66/15, in www.darts-ip.com. Indeed, according to the Higher Court, only if SEP owner's offer complies with FRAND terms, the alleged infringer has the obligation to respond.

⁹¹ See e.g. Regional Court Mannheim, dated 29 January 2016, 7 O 66/15, in www.darts-ip.com; such case concerned a claim by NTT for alleged infringement by HTC of patents essential for the UMTS standard. NTT had offered HTC a licence at specified royalty rates. 18 months later, and 6 months after the infringement proceedings were commenced, HTC made a counter-offer. The counter-offer was rejected but no security was provided. The Court granted an injunction, holding that HTC had failed to make a prompt counter-offer and to provide security. See also Regional Court Mannheim, dated 4 March 2016, (nt.75).

⁹² See e.g. Higher Regional Court Karlsruhe dated 31 May 2016, 6 U 55/16, *Pioneer vs. Acer* in www.darts-ip.com. In the case at hand, the plaintiff – an electronics company – was the owner of certain patents on DVD software technology and licensed the same patents through a patent pool. With regard to the patents essential to the sale and/or use of DVD products, the same plaintiff made a FRAND commitment addressed to the DVD Forum (which managed the standard). It filed a complaint for alleged patent infringement against the defendant, which raised the FRAND defence. The Mannheim Regional Court issued the injunction and an order for recall/destruction against the defendant. The latter applied for a preliminary stay of the enforcement of the first instance decision; Higher Regional Court Düsseldorf, dated 13 January 2016, I-15 (nt. 90) .

⁹³ See e.g. Regional Court Düsseldorf, dated 31 March 2016, (nt. 74).

⁹⁴ In particular, in Huawei, the ECJ affirmed that «Furthermore, where the alleged infringer is using the teachings of the SEP before a licensing agreement has been concluded, it is for that alleged infringer, from the point at which its counteroffer is rejected, to provide appropriate security» (see par. 67 of the judgment).

⁹⁵ See e.g. Regional Court Düsseldorf, dated 31 March 2016, (nt. 74).

In the English Huawei case,⁹⁶ the final judgment is expected in early 2017. However, for the time being, by examining the preliminary judgment⁹⁷, it may be taken into account some preliminary remarks on FRAND terms.

It should be noted that the preliminary decision – addressing the issue of FRAND terms – has been published before the *Huawei* judgment of the CJEU. Nevertheless, in said decision, Mr. Birss makes reference to the opinion of the Advocate General Wathelet delivered on November 20, 2014. In particular, he recalls the principle affirmed by the Advocate, according to which, if the infringer's conduct is tactical/dilatory, the patentee seeking an injunction is not abusing its dominant position.

In addition, the defendants claimed that the SEP holder should offer a license on single patents and not on the whole portfolio; this may be inferred from ETSI IPR policy and ETSI declarations. Conversely, according to the patent holder, it does not exist an obligation to license SEP individually. Mr. Birss has not decided in this respect in the preliminary decision. Nevertheless, he seems to be more in line with the patentee's position by affirming that: «The patentee may be advancing only a worldwide portfolio licence while the defendant may be offering to take a licence under only the patents actually found to be valid and infringed. Necessarily an individual patent offer would be territorially limited. Both proposals might be

⁹⁶ High Court of Justice, *Unwired Planet v. Huawei, Samsung* (Case No. HP 2014 000005). The dispute has been initiated on March 2014, when Unwired Planet International (hereinafter also referred to as "UPI") brought proceedings for patent infringement, contending that the products sold by Huawei, Google and Samsung, which are compliant with the standards, infringed its SEPs. UPI obtained most of the patent at issue from Ericsson. Many of such patents have been declared essential to various communication standards, including GSM, UMTS and LTE. The defendants Huawei and Samsung, denied the infringement claim and alleged that the UPI patents were void, not infringed and not essential to the relevant standard. In addition to the above, the defendants have also raised, by way of counterclaim, several issues on FRAND terms and violation of competition law. Therefore, the Court split the litigation into a set of distinct trials, respectively named trials "A", "B", "C", "D", "E" and "F", which have been scheduled to take place in 2015 and 2016. According to the Court, the first five trials (trials "A"- "E"), are called "Technical trials", since they concern validity, infringement and essentiality of the patents at issue. The sixth trial (trial "F"), named by the Court "Non-technical trial" instead relates to competition law, FRAND terms, and aims at determining whether injunctions may be granted in the event of SEP infringement. Said last trial, which was scheduled to take place following the conclusion of the technical trials, began on October 24, 2016. As to the outcome of the technical trials, UPI won the first one (trial "A") and the third one (trial "C"), and thus, the relevant patents have been declared valid and infringed. Conversely, at the end of the second trial (trial "B"), the patents at issue have been deemed void due to being obvious and have been revoked. In particular, the patents have been considered void for obviousness, because of a publicly available document proposed by Qualcomm as part of the LTE standardization discussions. Since the nullity of the patents at stake has been found, the Court did not take into consideration the infringement claim. The remaining two technical trials (trials "D" and "E") seem to be still pending. It should be noted that the trial "E" is the only one concerning Non-SEP. As anticipated, defendants have also brought counterclaims for breach of competition law. To sum up, the defendants argued the following: 1. The terms offered by UPI are not FRAND; 2. by seeking an injunction, UPI has acted contrary to Art. 102 TFEU; 3. the MSA agreement (ed. "Master Sales Agreement"), by which Ericsson patents were transferred to UPI, is prohibited by Art. 101 TFUE and thus is void. With reference to the non-technical trial, on April 26, 2016, the High Court rejected Samsung application for transfer part of the case to the Competition Appeal Tribunal (CAT) in accordance with Section 16 Enterprise Act 2002 Regulation 2015. Consequently, the proceeding is still pending before the Chancery Division of the High Court, with appointed Judge Mr. Justice Birss. As anticipated, the "Non-technical trial" is scheduled for 13 weeks starting in October 2016. Therefore, the final judgment is expected in early 2017.

⁹⁷ See, in particular [Unwired Planet International Ltd v Huawei Technologies Co. Ltd & Ors \[2015\] EWHC 1029 \(Pat\) \(24 April 2015\)](#).

FRAND in terms of the ETSI IPR Policy but each side could be refusing the other's offer. The obligation owed by a patentee to ETSI may only be to make a FRAND offer such that once a single FRAND offer has been made, the obligation to ETSI is fulfilled».⁹⁸

In addition, the licenses covered also a standard (2G); however, according to the defendant, the licensor had no essential patents with respect to such standard. At this stage, the appointing judge considered that a proposal including patents of which patentee is not the holder (as for instance, in the present case, proposal covering 2G and as well 3G) seems unlikely to be legitimate. The Court referred to the *Windsurfing* case; in particular, in such case, the ECJ found certain clauses to be anticompetitive, since the same clauses were outside the scope of the patent.⁹⁹

As far as the territorial scope of the license was concerned, in the present case, the patentee proposals had a worldwide scope. However, according to the licensee, the license should not cover the countries, where the patentee has no IP rights; indeed, the licensee sold products also in such countries. On the other hand, the patentee highlighted that this is not relevant, if the licensee the same products, in countries where the technology is protected. The Judge agreed that the products all need a license to be manufactured, but the royalty is calculated by selling price.¹⁰⁰ The judge stated that this point is not suitable for summary determination. On proposals bundling SEPs together with non-SEPs and its compliance with ETSI obligation, according to Judge Birss, this kind of proposal is not compliant with ETSI obligations.¹⁰¹ However, the judge pointed out that in the present case, following the first proposal, the patentee made another proposal concerning SEPs only. In his view, the factual contest has a key role in deciding on this issue. As a result, a decision in this respect will be taken at a latter stage.

Lastly, the Court addressed the question whether licensing proposals not including important information (which are provided to the willing licensee afterwards and upon its request). According to the defendant, this kind of proposal is not FRAND and has to be considered as a mere invitation to commence negotiations. Mr. Birss disagreed with this position, affirming that negotiation have to start somewhere and that proposals should contain vital terms, such as territorial scope, standard scope and royalty rates. As a matter of fact, in his view, «if a patentee makes proposals which cover those terms and the putative licensee makes it clear that it is not interested, I do not see why a patentee should be obliged nevertheless to produce a draft contractual document, capable of being accepted».¹⁰² Decision on this point was considered not suitable for determination by summary trial.

6. The role of the enforcers and the role of the policy makers.

The Huawei case has also opened a huge debate on the role played by the different subjects involved in patent protection and in competition law enforcement.

⁹⁸ See, par. 44 of the aforementioned decision, UK Court, dated April 24, 2015.

⁹⁹ CJEU, February 25, 1986, *Windsurfing International Inc. v Commission of the European Communities*, Case 193/83.

¹⁰⁰ See, par. 52 of the aforementioned decision, UK Court, dated April 24, 2015.

¹⁰¹ See, par. 9 of the aforementioned decision, UK Court, dated April 24, 2015.

¹⁰² See, par. 61 of the aforementioned decision, UK Court, dated April 24, 2015.

First of all the key role of national patent (and Competition law) courts emerges: the ECJ goes beyond the approach adopted by the Commission in its assessment of SEP holders' conduct, thereby enabling decision-making bodies to find a compromise between the protection of intellectual property and the need to ensure the proper functioning of competitive dynamics.¹⁰³

National courts are well equipped to undertake to strike the above-described balance on a "case by case" basis, and by making reference to specific facts. In this regard, it should be noted that judges will be frequently obliged to assess the compliance of licensing conditions with FRAND commitments. Sir Robin Jacob stated that following Huawei case "*The emphasis is on a FRAND defence before a national court, not enforcement by competition authorities*"¹⁰⁴.

Secondly, as soon as the Unified Patent Court ("UPC") enters into force¹⁰⁵ its involvement in the debate surrounding FRAND encumbered SEPs should be considered. In the context of the unitary patent system, there is no express provision on actions for infringements of competition law by patent holders. However before the UPC, acting in its competence ex article 32 of the Agreement on a Unified Patent Court ("UPC Agreement"), an antitrust defense may be raised in patent infringement actions.

Moreover, I also wonder if the standardization issue might be raised in a nullity action and if the exception of non-essentiality of the patent could be regarded as a feature of the validity of SEPs. In 18thDraft of the Rules of Procedure, changes in article 118.1 contain an explicit reference to the «discretion of the Court» with respect to the granting of injunctions by the Court articles 63, 64, 67 and 80 of the UPC Agreement, make implicit reference to such discretion by stating that the Court "may" grant an injunction or other measures.

By deciding on antitrust defenses in a case of FRAND encumbered SEP litigation, the UPC will have the opportunity to strike a balance between barriers to entry and interchangeability and consumer welfare, between competition protection and legitimate exercise of IPRs, on a case by case basis.

Thirdly also European Commission has an important role, as a decision maker, as well as a policy maker. In the first role it has opened the debate on FRAND encumbered patents with the Motorola case. Not having the ECJ specified, so far, in which measure holding a SEP amounts to a dominant position of its owner, the assessment offered by the European Commission in said case remains the latest reference on this point.¹⁰⁶

Acting as a policy maker, the Commission in its Horizontal Cooperation Guidelines has not provided technical guidance with regard to the determination of FRAND terms, limiting itself to define the objective they are supposed to serve.¹⁰⁷.

¹⁰³ See European Court of Justice, (nt. 51), paras 42 and 59, which refers to the need to strike a balance between maintaining free competition ...and the requirement to safeguard proprietor's intellectual property rights and its right to effective judicial protection, guaranteed by Article 17(2) and Article 47 of the Charter").

¹⁰⁴ R JACOB ,(nt. 60), 3.

¹⁰⁵ On the entry into force of the unitary patent system, see article 89 of the UPC Agreement.

¹⁰⁷ See European Commission, *Guidelines on the applicability of Article 101 of the Treaty on the Functioning of the European Union to horizontal co-operation agreements*, (nt. 18), para. 283 ff.

The Commission recently issued a Communication on ICT Standardisation Priorities for the Digital Single Market¹⁰⁸ that also face the question “to clarify core elements of an equitable, effective and enforceable methodology around FRAND principles” that might show the intention of adopting any sort of soft law in the field.¹⁰⁹ It seems not advisable at this stage: challenges in assessing FRAND royalties arise out to a significant extent of determining non-discriminatory royalties. Assuming that the Commission could provide guidance for the calculation of fair royalties, it could clarify to a limited extent the non discrimination criteria, because the application of such criteria relies on a comparative judgment and can only be assessed on the basis of the concrete facts of the case.¹¹⁰

Nor is there a need for any general codification of the Huawei principles within IP Rights Enforcement Directive that might crystallize such principles of judgment in legislation if not counterproductive.

Finally, the role of National Competition Authorities (“NCAs”) remains at stake. In Europe NCAs have not dealt with FRAND encumbered SEPs cases yet and we may wonder whether they will be involved in the future or not, and, if this is the case, if they will be required to intervene in their enforcement and/or advocacy activity, at least for Agencies who also have powers to advocate competition.

What is undoubtable is that in international competition institutions and networks the debate is well advanced¹¹¹ and more active NCAs are well equipped to tackle the issue. Their approach should be expected to be based on a case by case approach; the economic skills of their staff may be of help also in calculating FRAND terms.

However, in my opinion, their role is expected to be minor than the role played by National Courts and the UPC in applying the Huawei doctrine and tests. Indeed, the existence of an abuse of litigation as an abuse of dominance has to be justified in terms of exceptional circumstances. According to an highly authoritative opinion,¹¹² following the Huawei judgment, the role played by the competition law in controlling the enforcement of SEPs is definitively reduced and, furthermore, the right to access to justice is more protected.

I would rather say that the Huawei case has contributed to acknowledge that Patents and Competition does not conflict with each other and to draw the line between the use and the –exceptional- abuse of patent protection, including judicial protection.

¹⁰⁸ COM (2016), 176.

¹⁰⁹ See directive 2004/48/EC, dated 29 April 2004.

¹¹⁰ In Sir Robin Jacob's opinion it is not advisable that the Commission promulgates any guidance or initiates legislation in the specific area covered by the Huawei judgment, for a number of reasons: i) The ruling is not intrinsically complicated, it would be repetitive or superfluous; ii) According to Article 19 TFEU, CJEU is the only institution having the power to reinterpret its rulings; iii) While there are subsidiary questions that the CJEU did not resolve, these kinds of lacunae are best decided by courts on the basis of concrete facts, not by the Commission in the abstract; iv) Any guidance would not be binding; v) There would be a risk of setting national courts on the wrong track. See R JACOB, (nt. 60), 14-15.

¹¹¹ See for instance the hearing of the Competition Committee of the OECD in December 2014.

¹¹² See R JACOB ,(nt. 60), p. 2 "*the judgment confirms that EU competition law indeed has a part to play in controlling the enforcement of SEPs but not as extensively or intrusively as the Commission had proposed. Broadly the position is that competition law merely bolsters existing FRAND commitments (to grant licences on Fair Reasonable and Non Discriminatory terms) and compels owners of SEPs to offer to grant licences on such term*".

Patent law and antitrust law are to be deemed as compatible and complementary tools which ensure the functioning of the market and develop innovation, contributing in a different way, to maximize the consumer welfare. Nevertheless, it may occur that IP rights are abused by their holder to restrict market competition, then reducing consumer welfare.

The issue of abusive IP enforcement and litigation is intertwined with the debate on the relationship between the IP system and competition law, since, under certain conditions, such enforcement and litigation may constitute an abuse of dominant position. In this context, several conflicts of different interests may arise. First of all, fundamental rights, such as the right to access to Court, are involved. The FRAND encumbered SEPs issue is currently a paradigmatic example of the complex relationship between patent law and competition.

Before *Huawei*, an abusive litigation doctrine has been developed, both in US and in EU. According to EU doctrine, seeking an injunction is in principle a legitimate remedy that may result in an abuse of litigation merely in exceptional circumstances, to be detected by ad hoc tests. In the landmark *Motorola* case the European Commission dealt with the definition of the relevant market and the abusive nature of the conduct. In this last regard, it stated that seeking an injunction for FRAND encumbered SEPs against willing licensees may constitute an abuse of a dominant position. Different approaches have been adopted by national courts, which, from a general perspective, denied injunction when FRAND encumbered SEPs were involved. They payed remarkable attention to the good faith of the parties.

The Court – in the *Huawei* case - affirmed the procedural obligations placed on the parties for the negotiation of licenses. The failure to comply with such obligations by the SEPs holder may constitute an abuse of dominant position. However, several issues left open, such as the assessment of SEP-related market power.

Following the *Huawei* case, several national courts, especially in Germany and UK intervened on matters related to FRAND-encumbered SEPs. In particular, German Courts affirmed several principles on the applicability of article 102 TFEU, on the determination of FRAND terms, on the scope of application of the *Huawei* judgment, and on the procedural obligations established by the *Huawei* judgment. A UK court dealt with the features of the SEP holder proposal and the negotiation issue.

The *Huawei* case has also opened a huge debate on the role played by the different subjects involved in the patent protection and in the competition law enforcement. The national courts should have the task to assess compliance of licensing condition with FRAND terms and to strike the balance between IP protection and the need to ensure the functioning of competition dynamics. The Unified Patent Court will strike the abovementioned balance by deciding on the antitrust defence in cases related to FRAND encumbered SEPs. The European Commission, who opened the debate with the *Motorola* case, might act as a policy maker, for instance, by adopting guidelines for Courts on FRAND calculation, although it seems less desirable at the current stage. The role of National Competition Authorities remains at stake, although it is expected to be minor than the one played by National Courts and UPC.

IS DOMINANCE THE MISSING PIECE OF THE HUAWEI PUZZLE?

EMANUELA AREZZO*

Sommario: Introduction. – 1. The obligation to disclose patents and to enter FRAND commitments. – 2. The CJEU ruling. – 3. Compression of SEP rights and exceptional circumstances. – 4. SEPs and the assessment of dominance. – 4.1. The implementation of a standard-compliant product does not imply tout court infringement of all SEPs insisting on the standard. – 5. Conclusion.

Introduction

A standard-essential-patent is not just like any other patent. As the very same name implies, it is a patent insisting on a teaching, often a sliver of technology, that forms a standard¹. Sometimes standards emerge *de facto*, as a result of a natural process within the market whereby consumers gradually gather all around the same product, igniting a vicious circle whereby the more consumers choose the item, the more other consumers will find it advantageous to use the same product (so called direct network effect), and this in turn will lead firms active in adjacent markets to produce standard-compatible products (so called indirect network effect)². Some other times, public authorities of different kinds (at national, European or international level) can dictate the adoption of certain technical specifications by product manufacturers: so called *legal* standards. Eventually, in other occasions, market participants themselves recognize the importance to elicit together a standard to be commonly adopted within the industry³. Although not *legally* binding, conformity to such standards becomes extremely valuable to manufacturers willing to produce standard-compatible devices, as their products would be far less appealing to consumers (think of a

* Ricercatore universitario, Università di Teramo.

¹ For a complete overview of all possible types of standards see M. DOLMANS, *Standards for standards*, 26 Fordham Int. L. J. 163, 2002, at 164.

² As a further consequence, the presence of standard compatible products will make the standard even more appealing to consumers who will keep alining to it. The literature on direct and indirect network effects is vast. Among the most relevant studies see: M.L. KATZ, C. SHAPIRO, *Network Externalities, Competition, and Compatibility*, 75 Am. Econ. Rev. 424 (1985); C. SHAPIRO, H.R. VARIAN, *Information Rules, A Strategic Guide to the Network Economy*, (Harward Business School Press 1999); M. A. LEMLEY, D. MCGOWAN, *Legal Implication of Network Economic Effects*, 86 Calif. L. Rev. 479 (1998); J. FARREL, M.L. KATZ, *The Effects of Antitrust and Intellectual Property Law on Compatibility and Innovation*, 43 Antitrust. Bull. 609 (1998).

³ On the benefits coming from standardization in terms of enhanced interoperability, improved products quality, lower risks for consumers to stay locked-in to a technology which rapidly becomes obsolete, increased downstream competition (i.e. in the market of standard-compatible devices), see P. CHAPPATTE, *Frond commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 322 and ff. Similarly A. JONES, *Standard-essential patents: FRAND commitments, injunctions and the smartphone wars*, in *European Competition Law Journal*, 2014, 1, at 3 (also stressing that standardization may facilitate competition among producers by reducing wasteful spending on technology and lowering costs for consumers). Standardization, however, also carries downsides. Competition between standards, indeed, surely spurs innovation. R. GRASSO, *The ECJ ruling in Huawei and the right to seek injunctions based on FRAND-encumbered SEPs under EU competition law: one step forward*, in 39 *World Competition*, 2016, 213, at 218; R.P. MERGES J.M. KUHN, *An Estoppel Doctrine for Patented Standards*, 97 Calif. L. Rev. 1, 2009, at 7 and ff.

new generation smart-phone only capable of connecting to GSM technology)⁴. In such cases, standardization becomes a complex process which takes place within so called *standard setting organizations* (i.e. SSO)⁵.

In all of the three examples, when a certain technology becomes the – or is chosen to be a --standard, such a determination has generally the effect of excluding the existing competing alternatives from the market. And indeed, while many technologies initially compete for the market, once one of them emerges the others are driven off, as all producers of standard-compliant products will find it more convenient – in case of a *de facto* standard – or will be forced – in case of *legal* standard or standard chosen by a SSO, when no other feasible alternatives do exist – to implement the standard technology⁶. Access to the standard becomes then *essential* to compete both in the markets of standard-embedding products and in the (related) markets for standard-compatible devices or tools, which must be fully interoperable and functional with the standard product or technology. This means that proprietary control – thanks to IPRs – on such technologies becomes the key to rule the market(s). From this comes the specialty of the SEP or standard essential IPRs in general. Unlike any other patents competing in a market where many alternative technological solutions often exist, an IPR whose underlying fragment of technology happen to become part of a standard has just won the lottery game, as the exclusive control on the standard will not only allow his owner to conquer the (first) market for the product elicited as standard (think for example of the market for operating system for the personal computer in the Microsoft case), but it will further vest the IPR holder with a strategic weapon to either conquer the downstream markets of standard-compatible products or to receive a huge flood of licenses from firms willing to operate in such markets, as all manufacturers will need a license from the IPRs insisting on the standardized product or technology⁷.

This second aspect is exacerbated in the sectors, like the telecommunication industry for example, where it is often possible to dissect, on the one side, a(n upstream) market where there standard is not in itself an end product to be sold to consumers – like in the EU Microsoft case, where the very same browser was a standard – but is just a technology (think for example of the 4G technology); and, on the other side, a set of (downstream-)related markets of products embedding the technology (cellular phones, smartphones and tablets for example). In this case, the peculiarity is given by the fact that the perspective is reversed. Differently from the case where the standard itself involves an end product, hence a first

⁴ At this regard see Communication from the Commission, Guidelines on the applicability of Article 101 of the Treaty on the Functioning of the European Union to horizontal co-operation agreements, OJ C 11, 14.1.2011, p. 1–72, at § 266 where it explains that “[...]standards requiring that a particular technology is used exclusively for a standard or preventing the development of other technologies by obliging the members of the standard-setting organisation to exclusively use a particular standard, may lead to the same effect” (i.e. risk of emergence of barriers to entry for competitors and exclusion from the market, to the detriment of innovation).

⁵ For a description of how the standardization process works within an SSO see A. LAYNE-FERRAR, A.J. PADILLA, *Assessing the Link Between Standard Setting and Market Power*, March 2012, <http://ssrn.com/abstract=1567026>, at 5 and ff.

⁶ P. CHAPPATTE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 324, explaining that there are normally many competing solutions to technical problems that are identified during the standard setting process. SSO participants must select the technical contributions which will become part of the standard, with the consequences that once the selection has been operated it will reduce or eliminate the competitive constraints previously exerted by the competing contributions. Similarly J. KATTAN, *FRAND Wars and Section 2*, in *Antitrust* Vol. 27, n. 2, 2013, 30, at 31.

⁷ R. GRASSO, *The ECJ ruling in Huawei and the right to seek injunctions based on FRAND-encumbered SEPs under EU competition law: one step forward*, in *39 World Competition*, 2016, 213, at 221.

relevant product market, and access to the standard is necessary to penetrate *ancillary downstream* product markets (think about the media-player market, as ancillary market of the operating system market), in the latter scenario the markets of product incorporating the standard (“standard-embedding products” and not “standard-compatible devices”) can only improperly be defined “downstream” or “ancillary” markets, as they represent the mainstream source of revenues even for firms active in the upstream technology markets (for example, a smart phone cannot surely be deemed an “ancillary” product with regard to the upstream technology market concerning the 4G communication technology).

Now, technology markets are populated by two types of firms: i) firms (solely) active in such (upstream) markets, whose goal is profit maximization throughout licensing of the technology, and ii) vertically integrated firms also active both in the upstream technology market and in one (downstream-) related market, deriving majority of profits from the sale of the end products in the latter market⁸. In both cases, firms competing in technology markets seem often to prefer to create and join *ad hoc* private organizations (the above mentioned SSOs) to elicit the technology to be implemented as standard within the market, often trying to influence the emergence of a certain technology over a competing one and rightly so. Differently from the case of IPRs which happen to insist on a product which emerges as *de facto standard*, whose commercial success on the market depends on a vast array of unforeseeable circumstances, and it is ultimately dictated by consumers’ preferences, SEPs insisting on technologies which market players elicit as standard become all of a sudden, and not necessarily because the technologies really are the best ones, winning cards, as a huge flood of licenses will come worldwide⁹. Because of the standard, the holder of the patent will suddenly find himself with a strong contractual position on the market vis-à-vis manufacturers of standard-embedding products (so called “implementers”) whom he might threaten to leave out of the market should they not accept his licensing terms and conditions¹⁰. These problematic situations (often referred to as *patent hold-up*)¹¹ exerts a direct

⁸ In the afore mentioned Guidelines on horizontal co-operation agreements, where the Commission explains that while for upstream-only companies the only source of income is licensing revenue and their incentive is to maximise their royalties, vertically integrated companies have mixed incentives. In fact, on the one hand, they can draw licensing revenue from their IPR, but on the other hand, they may have to pay royalties to other companies holding IPR essential to the standard. The Guidelines also point out at a third category of players not active in the upstream technology market: these are pure manufacturers of products or services based on the technologies. For such “downstream-only” companies, who do not hold any relevant IPRs, royalties to get access to intangible assets are just a cost. See *Guidelines on the applicability of Article 101 of the Treaty on the Functioning of the European Union to horizontal co-operation agreements*, supra note 4, § 267.

⁹ A. JONES, *Standard-essential patents: FRAND commitments, injunctions and the smartphone wars*, in *European Competition Law Journal*, 2014, 1, at 6.

¹⁰ These concerns have been addressed by the EU Commission in the Horizontal Guidelines where it stated that “[...] by virtue of its IPR, a participant holding IPR essential for implementing the standard, could, in the specific context of standard-setting, also acquire control over the use of a standard. When the standard constitutes a barrier to entry, the company could thereby control the product or service market to which the standard relates. This in turn could allow companies to behave in anti-competitive ways, for example by ‘holding-up’ users after the adoption of the standard either by refusing to license the necessary IPR or by extracting excess rents by way of excessive royalty fees thereby preventing effective access to the standard”. See Commission Communication, Guidelines on the applicability of Article 101 of the Treaty on the Functioning of the European Union to horizontal co-operation agreements [2011] OJ C 11/1 (‘Horizontal Guidelines’), § 263.

¹¹ P. CHAPPATIE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 326, explaining that “The owner of a relevant essential patent in theory has the ability to (i) block companies from producing any products compliant with the standard and (ii) demand royalties for its patent that are significantly higher than the royalties it could have demanded had the technology not been included in the

negative impact on consumers as well, because they will have to bear higher prices for products which are standard compatible, as manufacturers will pass on consumers the mark-up paid on the royalty¹². Moreover, if hold-up actually occurs, there is a risk not only that confidence in the overall standard setting process will be undermined, but also that manufacturers' ability to compete in the market of standard-compatible devices will be sensibly impaired, again to the detriment of both downstream competitors and consumers in terms of a lessening of innovation should their products abandon (or never enter) the market¹³.

Moreover, given the circumstance that, like in the *Huawei* case, a standard is often covered by thousands of patents all insisting on small fragments of technology composing the overall standard, and that therefore all these patents are “perfect complements”, meaning that implementers need access to all essential IPRs in order to produce a product incorporating the standard, a subsequent *royalty stacking* problem might well arise. And indeed, according to established economic theory, when multiple owners of complementary items, all being essential inputs to a final product, can set prices for such inputs independently, the overall price to be paid from the manufacturing firm for the production of the final product will be so high that it might be no longer appealing, in economic terms, for the latter to make it¹⁴.

Incentives for hold-up may be particularly strong when the SEP holder is a vertically integrated firm also active in the downstream market of standard-compliant products and the implementers are his competitors in such markets¹⁵, as such a scenario presents a win-win situation for the former given that he will benefit either – if not more – from the exclusion of his competitors from the market or from the supra-competitive royalties he will be able to extract. It is not a coincidence, therefore, that the so called *smartphone wars* actually began right when new players, which were not part of any standardization consortium, hence did not possess any SEPs, entered the (related) markets of smartphone and tablets (Apple) and operating systems running on such devices (Google and Microsoft): items which would

standard, or before the standard was adopted and competition eliminated (known as the “hold-up” problem).¹²

¹² P. CHAPPATTE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 334-335.

¹³ A. JONES, *Standard-essential patents: FRAND commitments, injunctions and the smartphone wars*, in *European Competition Law Journal*, 2014, 1, at 26.

¹⁴ The issue has been explored in depth by M.A. LEMLEY, C. SHAPIRO, *Patent hold-up and Royalty Stacking*, in 85 *Texas L. Rev.* 1990, 2007. See also P. CHAPPATTE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 326. A different perception of the problem is espoused by D. GERADIN, M. RATO, *Can Standard-setting Lead to Exploitative Abuse? A Dissonant View on Patent Hold-up, Royalty Stacking and the Meaning of FRAND*, (2007) 3 European Competition Journal 101, at 23-24 and 41-42, arguing by contrast that owners of essential IPRs, when individually setting their prices, will take into account prices set by owners of complementary IPRs, assuming that the prospective implementers will only be able to accommodate a certain price level. Elaborating on these thoughts, J. Sidak similarly argues that the royalty stacking argument fails to take into account wide spread market practices, such as cross-licensing between SEP owners and non-exertion of rights, which would punish companies setting far excessive royalties. See J. SIDAK, *Apportionment, FRAND Royalties, and Comparable Licenses After Ericsson v. D-Link.*, in *University of Illinois Law Review*, 2015.

¹⁵ R. GRASSO, *The ECJ ruling in Huawei and the right to seek injunctions based on FRAND-encumbered SEPs under EU competition law: one step forward*, in 39 *World Competition*, 2016, 213, at 218. D. GERADIN, M. RATO, *Can Standard-setting Lead to Exploitative Abuse? A Dissonant View on Patent Hold-up, Royalty Stacking and the Meaning of FRAND*, (2007) 3 European Competition Journal 101, at 5, 21.

all require access to standard technologies¹⁶.

1. *The obligation to disclose patents and to enter FRAND commitments.*

In order to avoid opportunistic behaviours by SEP holders, both in the phase before the standard has been selected and after¹⁷, many SSOs have adopted detailed IPRs policies which compel their members to i) timely disclose the holding of patent(s) that might insist on a technology considered to be chosen as standard or to be further developed to become a standard; ii) endorse a duty to license such rights, to whomever interested, on *fair, reasonable and non discriminatory* conditions (so called FRAND terms)¹⁸. The duty to disclose should eliminate the risks of so called *patent ambush*, as it happened in the *Rambus* case¹⁹, while the commitment to license should eliminate the risk that the SEP holder incurs in unfair and abusive conduct. In fact, the requirement of fairness and reasonableness clearly aims at preventing exploitative unilateral abuses in the form of excessively high royalty rates and unfair trading conditions²⁰, which the SEP holder might try to impose on third parties, and the element of non discrimination clearly implies a duty not to apply dissimilar conditions to equivalent transactions: i.e. not to discriminate in setting licensing conditions and royalty rates among different implementers²¹. While it is dubious whether such obligations can refrain strategic behaviours of firms overstating the essentiality of their right to the

¹⁶ See at this regard A. JONES, *Standard-essential patents: FRAND commitments, injunctions and the smartphone wars*, in *European Competition Law Journal*, 2014, 1, at 9, explaining that the mobile telephony markets had experienced a quiet life as long as most of its core players (like for example, Samsung, Nokia, Ericsson, Motorola, Alcatel-Lucent and Qualcomm) were both SEP-holders and implementers in the market and used to engage in cross-licensing of their patent portfolios. The position changed, however, following the entry into the market of pure implementers and when some of the original players', due to a decline of their position in the final product market, sold off their patent portfolios to patent assertion entities (PAEs). These factors altered the *equilibria* and led to an explosion of disputes worldwide raising a plethora of contract, patent and antitrust issues, including the question of whether a SEP-holder should be able to enforce its FRAND encumbered patent by seeking a preliminary injunction before a court.

¹⁷ Standard setting process involves several decisions to be jointly taken by SSO members, to select each technical contribution which will come to form the standard technology. Competing technical contributions come from the very same SSO members who, in parallel with the standardisation process, conduct their own research and file patent applications to protect their innovations. Given the increased value patents gain once their underlying technology is selected to be part of a standard, many firms are lead to engage in opportunistic behaviors which have been defined "just-in-time patents", meaning that they use to file patents, often of low quality, right before a standardization meeting takes place in order to participate to the meeting to the sole purpose of negotiating the inclusion of their technology in the standard. See B. KANG, E. BEKKERS, *Just-in-time patents and the development of standards*, Research Policy 44 (2015) 1948.

¹⁸ See the General Guidelines for the Co-operation between CEN, CENELEC and ETSI and the European Commission and the European Free Trade Association, signed on 28 March 2003, [2003] OJ C91, 5, where it is established that SSOs "Ensure that all interested parties have access to standards, by broad provision of information on their availability, and by ensuring that standards, including any intellectual property rights (IPRs) they might contain, can be used by market operators on fair, reasonable and non-discriminatory conditions".

¹⁹ Case COMP/38.636 Rambus, 9 December 2009 (Commitment's Decision), FAQ Press Release on the Rambus commitments decision, MEMO IP/09/544.

²⁰ See at this regard J. KATTAN, *FRAND Wars and Section 2*, in *Antitrust* Vol. 27, n. 2, 2013, 30, at 32, observing that while the FRAND commitment is an obligation to accept a royalty that is reasonable in light of the available *ex ante* technological alternatives, a SEP holder breaching the commitment will seek royalties whose rate reflects absence of *ex post* alternatives.

²¹ See P. CHAPPATTE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, 333.

standard²², especially in the case of low quality patents, the obligation to license at FRAND terms clearly curtails good portion of the excluding powers stemming from patent rights, as SEP holders basically accept the fact that they cannot refuse licensing their rights to third parties²³.

Having said this, on the nuances of such contractual obligation and its corollaries much remains to be said. Academics tend to disagree on how strongly – or weakly – should this contractual obligation be interpreted and in particular on whether, together with her right to exclude in general, the SEP holder should be deemed to have implicitly waived also her right to enforce preliminary measures, such as preliminary injunctions, in the case negotiation regarding the FRAND license should break down²⁴. It must be stressed, indeed, that SSOs have a very limited power when it comes to enforce the obligation to license on FRAND terms²⁵. Should the FRAND commitment not be honoured, often the only thing a SSO can do is changing the standard's specification in a way to avoid the infringement of the essential patent²⁶, but this threat has not a strong dissuasive power against the SEP owner, as he knows

²² On this point see *infra* § 4.1.

²³ See J. KATTAN, *FRAND Wars and Section 2*, in *Antitrust* Vol. 27, n. 2, 2013, 30, at 31, explaining that by accepting the FRAND commitment the firm accept to surrender significant legal rights: namely, i) her right to refuse to license the patented technology, hence to enjoin any willing licensee, and ii) to set supra competitive royalties. Also Kattan observes that the essence of a FRAND commitment is a promise to forgo the ability to control price and exclude competition that otherwise would be created by a patent's incorporation into a standard. J. KATTAN, *FRAND Wars and Section 2*, in *Antitrust* Vol. 27, n. 2, 2013, 30, at 33.

²⁴ Several authors believe that a FRAND commitment automatically implies also a waiver of seeking injunctive relief. See M.A. LEMLEY, *Intellectual Property Rights and Standard-Setting Organisations*, in 90 *California Law Review* 1889, 2002, at 1967; J. FARRELL, J. HAYES, C. SHAPIRO, T. SULLIVAN, *Standard Setting, Patents, and Hold-up*, in 74 *Antitrust Law Journal* 603, 2007, at 638; P. CHAPPATTE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 331, arguing that if the licensee is prepared to give a reciprocal license and pay on FRAND terms, no injunction should in principle be available, since the only issue to be resolved regards the amount of royalties to be paid. J. MILLER, *Standard-Setting, Patents and Access Lock-in: RAND Licensing and the Theory of the Firm*, 40 *Indiana Law Review* 351, 2007, at 358; R.P. MERGES, J.M. KUHN, *An Estoppel Doctrine for Patented Standards*, 97 Calif. L. Rev. 1, 2009, at 28 and ff. For a completely different perspective on the issue see D. GERADIN, M. RATO, *Can Standard-setting Lead to Exploitative Abuse? A Dissonant View on Patent Hold-up, Royalty Stacking and the Meaning of FRAND*, (2007) 3 *European Competition Journal* 101, at 16, arguing that a FRAND commitment cannot be interpreted as an implicit waiver, for the SEP owner, to its right to seek injunctive relief, as this would be contrary to well established principles of law (according to which a waiver of right must always be made explicitly or derived from unequivocal circumstances showing the right owner's consent to waive such right); similarly, but based on a different reasoning, see J. RATLIFF, D. RUBINFELD, *The Use and Threat of Injunctions in the RAND Context*, in 1 *Journal of Comp. L. & Econ.* 2013, at 19, arguing that the threat of the imposition of an injunction is what moves the parties towards an agreement on the determination of the FRAND terms.

²⁵ But see also A. JONES, *Standard-essential patents: FRAND commitments, injunctions and the smartphone wars*, in *European Competition Law Journal*, 2014, 1, at 8-9, blaming SSOs for not having developed robust dispute resolution mechanisms capable of dealing with the controversial issues arising between major technology companies, with the consequences that such issues are therefore brought before Courts or competition agencies, bringing to the forefront the question of whether competition law has or not a role to play. Sceptical towards the implementation of competition law to solve this type of issues is Advocate General Wathelet, see Opinion delivered on 20 November 2014, case C-170/13, Huawei Technologies Co. Ltd v. ZTE Corp., ZTE Deutschland GmbH.

²⁶ It's worth mentioning that such a remedy sometimes is not even easy to pursue. For example, the ETSI IPR's policy guidelines envisage a long procedure whereby if the IPR owner keeps refusing to license the SEP and does not provide any explanation for the refusal (within three months from the reception of a letter from the ETSI's Director General), then the Director General will invite the General Assembly to vote in order to refer the standard to a Committee to modify it "so that the IPR is no longer essential". See Art 8.2 of ETSI's

that manufacturers who have already invested huge sums in the production of standard-embedding products are already locked-in to her technology²⁷.

These are indeed precisely the circumstances at issue in the *Huawei* case where the SEP holder, incapable of reaching an agreement on FRAND terms with the manufacturer of the standard-compatible product ZTE, and having the latter nonetheless commenced production and distribution of his products, asked for a preliminary injunction (together with recall of products and damages). From this, the questions posed before the Court of Justice of the European Union which all evolve around the issue of whether a SEP holder, who has voluntarily agreed to license her essential patent(s) on FRAND terms, may exercise her right, normally legitimate, to ask for a preliminary injunction to defend her patent rights or whether, given the specific circumstances of the cases – i.e. being the holder of a SEP and not just a normal patent and having committed to license on FRAND terms – such conduct might be deemed an abuse of dominant position pursuant to art. 102 of the Treaty, on the assumption that holding a SEP confers a position of dominance to his owner.

Clearly, striking a proper balance of the interests at issue is not an easy task. Granting SEP holders an unconstrained power to use preliminary injunctions towards the alleged infringers, when the former has compelled to license her technology on FRAND terms to whomever desires one, might seem nonsensical as the former would practically be in a position of keeping implementers off the downstream market, a scenario which runs counter the very same purposes of the standardization process²⁸. While this scenario seems unlikely to happen, as generally the breaking of FRAND obligations by the SEP owner takes place when manufacturers have already incurred substantial production costs to accept to be cut off the market, the right to seek a preliminary injunction would tilt the balance way too much in favour of the former, increasing her bargaining power in the negotiation²⁹. As SEP holder know, indeed, that implementers are *locked-in* to the standard, and the only way to recoup the sums invested in production is by selling the standard-embedding products, the former can use the preliminary injunction as a bargaining tool to threaten to leave them out of the market should they not accept the proposed contractual terms: hence, forcing implementers to pay much higher royalties they would accept to pay otherwise, far in excess of the holder's true economic contribution³⁰. This even more so because technological products are subject to fast moving obsolescence, which confines their life span into quite narrow temporal

IPR Policy: ETSI Rules of Procedures, 20 April 2016, Intellectual Property Rights Policy, 38.

²⁷ P. CHAPPATTE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 328.

²⁸ See R. GRASSO, *The ECJ ruling in Huawei and the right to seek injunctions based on FRAND-encumbered SEPs under EU competition law: one step forward*, in *World Competition*, 2016, 213, at 234. The author observes that while in normal and undistorted commercial negotiations an implementer can weigh the pros and cons of engaging in a long and costly legal battle with the SEP holder, in this case the former has little choice but to agree to the SEP-holder's un-FRAND licensing conditions, as he faces the risk of being permanently excluded from the market. In fact, "assuming the SEP is valid, infringed, and enforceable, the licensee in fact cannot market its products without infringing the SEP-holder's patents since by definition there are no substitutes".

²⁹ In the mobile telecom industries, for example, firms incur significant investments in designing the product, setting up the production facilities, purchasing the network equipment, etc. As explained by P. Chappatte, once device manufacturers and network operators have incurred such significant sunk costs, they become effectively locked-in to that standard, as they do not want to risk loosing the investments made. See P. CHAPPATTE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 325.

³⁰ At this regard, see M.A. LEMLEY, C. SHAPIRO, *Patent hold-up and Royalty Stacking*, in *Texas L. Rev.* 1990, 2007 at 1993, further asserting that a supra-competitive royalty price acts "as a tax on new products incorporating the patented technology".

boundaries. This latter factor exerts a strong impact as well on the manufacturer negotiating power, making it even weaker, as they know that the longer it takes to conclude the bargain, the bigger are going to be the losses in sales³¹, as there is less time before a new product will be launched onto the market³².

On the other side, however, as the Advocate General pointed out, together with the German Supreme Court, a blunt compression of such a right (i.e. the right to file for a preliminary injunction) would risk tilting the balance in the opposite direction³³, unduly favouring the contractual position of the infringer³⁴. The latter, indeed, knowing that the SEP holder has her hands tied, could start commercialization right away and push the boundaries to negotiate a very low royalty rate (the phenomenon known as “patent hold-out”³⁵ or “inverse patent hold-up”³⁶). And indeed, a bad faith implementer may simply engage in dilatory tactics just to simply not pay the royalties, adducing that the terms are not FRAND³⁷.

2. *The CJEU ruling.*

Torn between the complexities of the German “Orange book test”, strongly favouring patentees’ interests³⁸, and the more straightforward “willining licensee” test adopted by the

³¹ See Opinion (AG Wathelet) delivered on 20 November 2014, case C-170/13, Huawei Technologies Co. Ltd v. ZTE Corp., ZTE Deutschland GmbH, § 82.

³² This concern has been explicitly addressed by the European Commission in the *Google/Motorola* merger case where it held that “[...] Even if exclusion of competing products from the market through injunctions were to be temporary (i.e. there would be a delay only in access to the relevant products until the counter-party of the SEP-holder agreed to the commercial terms demanded), in a fast-moving market such as the smart mobile device market, serious harm could potentially be caused by it”. See *Google/Motorola Mobility*, case COMP/M.6381, 13 February 2012, § 107.

³³ See Opinion (AG Wathelet) delivered on 20 November 2014, case C-170/13, Huawei Technologies Co. Ltd v. ZTE Corp., ZTE Deutschland GmbH, § 42.

³⁴ See P. CAMESASCA, G. LANGUS, D. NEVEN, P. TREACY, *Injunctions for standard-essential patents: justice is not blind*, in 9 Journal of Competition law & Economics, 2013, issue 2, 285, at 289, arguing that an absolute veto on SEP holders to recur to injunctions in all circumstances would give prospective licensees incentives to free ride on the SEPs. See also J.D. HARKRIDER, *Seeing the Forest Through the SEPs*, 2013, 27(3), Antitrust 22, at 26 (explaining that “[...] If firms are free to refuse to pay for their use of SEPs without any risk of injunctions or damages that might lead to underinvestment in standards development and related innovation”).

³⁵ C. CHIEN, *Holding Up and Holding Out*, in 21 Michigan Telecommunications and Technology Law Review 1, 2015.

³⁶ D. GERADIN, M. RATO, *Can Standard-setting Lead to Exploitative Abuse? A Dissonant View on Patent Hold-up, Royalty Stacking and the Meaning of FRAND*, (2007) 3 European Competition Journal 101, at 17.

³⁷ See at this regard J. RATLIFF, D. RUBINFELD, *The Use and Threat of Injunctions in the RAND Context*, in 1 Journal of Comp. L. & Econ. 2013, p. 9, 17 and ff, *supra* note 24, arguing that the threat of injunctive relief serves to provide an incentive for the implementer to stop infringing the patent and accept a “certifiably RAND license”, depicted as a license whose terms have been deemed FRAND by a court, have been imposed by a court or where the parties agree that the negotiated terms are indeed FRAND.

³⁸ See at this regard, A. JONES, *Standard-essential patents: FRAND commitments, injunctions and the smartphone wars*, *supra* note 1, at 24, arguing that the judgments of the lower courts in Germany have made it very difficult for potential licensees to resist an injunction in practice, even if they are willing to engage in good-faith licence negotiations. And indeed it seems that manufacturers of standard-compatible devices faced with injunction actions in Germany have had the choice of either suffering significant harm, as a result of being excluded from a major fast-moving market, or paying the rate requested by the patentee for both past infringements and future licence payments, while at the same time being compelled to forgo all essentiality and validity claims concerning the SEPs.

EU Commission in the *Motorola* case³⁹, which clearly sided for manufacturers of standard-embedding products, the CJEU seems to have endorsed an approach closer to the latter,⁴⁰ by ruling that the conduct at issue should *not* be regarded as abusive if the SEP holder has duly informed the manufacturer of the alleged infringement before commencing the action and the implementer has immediately demonstrated his willingness *not* to enter the agreement⁴¹ or has engaged in dilatory tactics⁴². On the contrary, seeking a preliminary injunction by the SEP holder might be regarded an abuse when the latter is clearly asserting his right against a willing licensee⁴³.

While it is clear that the Court did not intend to adopt the legal technicalities put forward by the German Courts (for example about the offer to be unconditional and not containing specific clauses, such non challenge clauses), the judgement strikes the attention for being peculiar at best. And in fact rather than setting a clear cut principle to determine if seeking an injunction against the manufacture and commercialization of standard-compliant products by a SEP holder is or is not an abuse of dominance, the Court has dictated a sort of best practices of how negotiations should be conducted, by placing upon each party time-specific obligations the completion of which shifts the burden on the counter part⁴⁴. Therefore, a first informational duty lies on SEP holders: they must alert the (supposedly good faith) infringer, specifying which essential patent has been violated and how it has been infringed upon⁴⁵. A obligation which finds its *rationale* in the circumstance that standard technologies in tele-communication sector are normally protected by a vast array of IPRs, so many that it could actually happen that the manufacturer is not aware of that specific

³⁹ *Motorola - Enforcement Of Gprs Standard Essential Patents*, case AT 39985, Brussels, 29.04.2014 C(2014) 2892 final.

⁴⁰ See at this regard R. GRASSO, *The ECJ ruling in Huawei and the right to seek injunctions based on FRAND-encumbered SEPs under EU competition law: one step forward*, in 39 *World Competition*, 2016, 213, at 214, arguing that the CJEU in *Huawei* has basically confirmed the approach of the EU Commission in the *Motorola* case, refining the *willing licensee* test and specifying the requirements to be complied with for the latter to qualify as one. On a similar note: P. MAUME, *Huawei/ZTE or how the CJEU closed the Orange Book*, in *Queen Mary Journal of Intellectual Property*, Vol. 6 No. 2, 207, 2016, at 223, noting the change of perspective between the German approach, where the Court was mainly concerned with the rights of the proprietors and discussed under what circumstances the implementers could raise a competition law defense, thereby avoiding an injunction order, and the CJEU approach, focusing on whether a SEP holder who has entered a FRAND commitment will abuse his dominant position if he attempts to enforce the patent..

⁴¹ This clearly emerges from a literal interpretation of the judgement's wording. In fact, SEP obligation to present the offer on FRAND terms arises only after implementers, being notified of the alleged infringement, have expressly manifested their willingness to enter a licensing agreement. See Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, §§ 63 and 71.

⁴² This means for the CJEU that he has engaged in purely dilatory tactics. Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 65.

⁴³ As it would happen, explains the Court, in the case where the latter, having asserted to be interested in licensing but not agreeing on the royalty rate proposed by the SEP holder, has promptly submitted to the SEP a specific written counter-offer containing FRAND conditions. See Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, §§ 66, 71.

⁴⁴ P. MAUME, *Huawei/ZTE or how the CJEU closed the Orange Book*, in *Queen Mary Journal of Intellectual Property*, Vol. 6 No. 2, 207, at 221 and ff.

⁴⁵ Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, §§ 60-61.

infringement⁴⁶. Once the SEP holder has informed the alleged infringer, it is upon the latter to declare that he is willing to enter a licensing agreement on FRAND terms. Again, once this second step has been accomplished, it is again the SEP holder's turn to make a move: namely, SEP holders are encumbered with the obligation to make the first offer on FRAND term, specifying the amount of the royalty and the way for it to be calculated⁴⁷: an obligation which again seems reasonable, given the fact that on the one side the SEP has a contractual obligation to do so and, on the other side, she surely is on a better position to set the royalty rate⁴⁸ and make a proposal⁴⁹. Once the offer has been made, it is for the implementer to behave diligently and either to accept the offer or to respond by presenting another counter-offer on FRAND terms⁵⁰. Should the parties not find an agreement on the details of the FRAND terms, the CJEU suggest that they might resort to an independent third party who, by common agreement, would be asked to determine the appropriate amount of the royalty⁵¹.

In conclusion, aside from all these behavioural obligations, it seems from a first reading of the judgement that SEP holder can recur to preliminary injunction (to block the infringement of their patents), without it being an abuse of dominant position, only in case there is clear evidence that the implementer is acting in bad faith and has engaged in dilatory tactics⁵². Other than this limited set of circumstances, which all depend on the counterpart's behaviour, the filing of a preliminary injunction by the SEP holder will amount to an abuse of dominance: this even in the cases where production and commercialization of the infringing products has already taken place. And indeed, even if the Court admits that “in principle, the user of those rights [i.e. the essential IPRs], if he is not the proprietor, is required to obtain a license prior to any use”⁵³, not only she justifies a compression of the right to have recourse to legal proceedings to ensure effective enforcement of the exclusive

⁴⁶ Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 62.

⁴⁷ Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 63.

⁴⁸ See P. MAUME, *Huawei/ZTE or how the CJEU closed the Orange Book*, in *Queen Mary Journal of Intellectual Property*, Vol. 6 No. 2, 207, 2016, at 223, explaining that the position adopted by the Court takes into account the information asymmetry between SEP holders and implementers, and favours the disadvantaged barbanning position of the implementer who could risk, were he the one to offer first, to be caught by his own proposed royalty rate, should he set it too high.

⁴⁹ The Court observed at this regard that lacking a public standard licensing agreement, and where other licensing agreements have been already concluded with other competitors but not released to the public, “[...] the proprietor of the SEP is better placed to check whether its offer complies with the condition of non-discrimination than is the alleged infringer”. Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 64.

⁵⁰ Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 71.

⁵¹ Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 68.

⁵² According to the Court, an implementers engages in dilatory tactics when that, being informed of the infringement, he has not responded diligently “in accordance with recognized commercial practices in the field and in good faith”. Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 63.

⁵³ Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 60.

rights, but she clearly avails *ex post* agreements, when the infringement has already occurred⁵⁴. In the latter circumstances, however, the Court requires the implementer to provide “appropriate security”, according to what is customary to industry practice, and requires him to be able to “render account” of the number of past uses of the technology⁵⁵.

3. *Compression of SEP rights and exceptional circumstances.*

In the reasoning of the Court, the circumstance that SEP holders detain exclusive control on a resource which is *essential* by definition and not duplicable nor interchangeable because market leaders have chosen so, together with the other circumstance that SEP holders have entered an obligation to license their technology on FRAND terms to each interested party, thereby creating the legitimate expectation on them that they could access the technology at a reasonable rate, are to be regarded tantamount to the “exceptional circumstances” that featured the well known *refusal to deal* cases involving IPRs⁵⁶. In those cases, the European Courts and the Commission agreed on the fact that although the mere exercise of an IPR, including the refusal to grant access to such right to third parties, was in principle perfectly legitimate, it may nonetheless turn into an abuse of a dominant position when special exceptional circumstances were present⁵⁷. Namely, access to the intangible resource was *essential* to enter the market, as the IPR subject matter was not substitutable, often thanks to a set of other external market circumstances (mainly network effects), and it

⁵⁴ See at this regard S. BARTHELMESS, M. DOLMANS, R. ZIMBRON, *Enforcing Standards-Essential Patents-The European Court of Justice's Judgement in Huawei v. ZTE*, in *Intellectual Property and Technology Law Journal*, Vol. 27, N. 12, December 2015, at 15, noting that the informational duty placed on SEP holders seem to trump the well known patent law principle, evoked by the same CJEU, pursuant to third parties should always get a license before implementing the technology. Indeed, the Court has stressed that SEP holders cannot bring a preliminary injunction before informing the user of the supposed infringement, this even if “the SEP has already been used by the alleged infringer” (Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 60).

⁵⁵ Indeed the same Court specifically dictates that “where the alleged infringer is using the teachings of the SEP before a licensing agreement has been concluded, it is for that alleged infringer, from the point at which its counter-offer is rejected, to provide appropriate security, in accordance with recognised commercial practices in the field, for example by providing a bank guarantee or by placing the amounts necessary on deposit [...]” (italics added). See Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, § 67. See at this regard S. BARTHELMESS, M. DOLMANS, R. ZIMBRON, *Enforcing Standards-Essential Patents-The European Court of Justice's Judgement in Huawei v. ZTE*, in *Intellectual Property and Technology Law Journal*, Vol. 27, N. 12, December 2015, at 15, further underlying that the EJC does not address in the judgement whether the SEP user may be requested to pay above-FRAND damages for prior use of the technology, at least until he has expressed willingness to enter a licensing agreement.

⁵⁶ This thesis has found also confirmation in the doctrine: see P. CHAPPATTE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 327, and in the European Commission decisions. See in particular *Motorola - Enforcement Of Gprs Standard Essential Patents*, case AT 39985, Brussels, 29.04.2014 C(2014) 2892 final, at § 281 and ff.

⁵⁷ See Case 53/87 *CICCRA v Renault* [1988] ECR 6039, § 16, where the ECJ stressed that a refusal by a car manufacturer to license did not necessarily constitute an abuse (rather the right of the IPR holder to make exclusive use of the right is the substance of the exclusive right), but would do so if it gave rise to “certain abusive conduct . . . such as the arbitrary refusal to deliver spare parts to independent repairers”. Similarly *Volvo v Veng*, Case C-238/87. Cases C-241–242/91 P RTE & ITP v Commission [1995] ECR I-743, § 49. Case T-201/04 Microsoft v Commission [2007] ECR II-3601.

prevented new products from being released (i.e. it prevented innovation), to the detriment of consumers⁵⁸.

In both line of cases, even if the SEP cases could also be framed as exploitative rather than exclusionary abuses⁵⁹ (the category refusal to deals belong to)⁶⁰, analogies can be found in the presence of exceptional circumstances to justify the compression of otherwise legitimate exercise of IPRs and constitutional rights of access to Court⁶¹ (in the case of SEP, the legitimate right to fully enforce and defend her right in Court by presenting civil actions and preliminary measures). This to preserve not only competitors' interests but also consumers' welfare which in the refusal to deal cases suffered from a lessening of innovation, while in the SEP case could be damaged by the price increase eventually passed by SEP users on the portable devices sold on the market (more than on the risk that SEP users incapable of finding an agreement would recall their products from the market)⁶².

Despite all these commonalities, however, there is a significant difference between these two set of cases which casts a dark shadow not just on the judgement rendered by the Court but more generally on the antitrust assessment of technological markets. And in fact, the EU jurisprudence on refusal to deal cases, since its very beginning, has always acknowledged a core principle for all cases involving the interaction of the two disciplines (competition law on the one side and intellectual property right laws on the other side): namely, that the mere holding of an IPR is not tantamount *per se* to a position of dominance in the market. A position that only the presence of *exogenous* exceptional circumstances and

⁵⁸ For an extensive analysis of these cases see E. AREZZO, *Intellectual property rights at the crossroad between monopolization and abuse of dominant position: American and European approaches compared*", in The John Marshall Journal of Computer & Information Law, volume 24, issue 3, 2006, 445.

⁵⁹ And indeed if not framed as an exploitative abuse, either under Art. 102(a) or (c) TFEU, the most appropriate way to describe this conduct would probably be as a *constructive* refusal to license since, as it has been noted, "as long as the injunction is pending, the SEP-holder is effectively denying a licence to its SEPs, thereby preventing the implementer from marketing its standard-compliant products on the downstream market". See R. GRASSO, *The ECJ ruling in Huawei and the right to seek injunctions based on FRAND-encumbered SEPs under EU competition law: one step forward*, in 39 *World Competition*, 2016, 213, at 232. And in fact, already in the *Deutsche Post* decision, the Commission stated that 'the concept of refusal to supply covers not only outright refusal but also situations where dominant firms make supply subject to objectively unreasonable terms'. Commission decision COMP/C-1/36915, Deutsche Post AG, 25 Jul. 2001, at 141. Constructive refusal to license have been disciplined later in the Commission Communication, Guidance on the Commission's enforcement priorities in applying Article 82 of the EC Treaty to abusive exclusionary conduct by dominant undertakings ("Commission Enforcement Priorities") [2009] OJ C 45/7, at para. 79.

⁶⁰ But see at this regard A. Jones explaining that even if the main concerns in cases such as *Huawei* the main concern seem related to the circumstance that SEP holders be capable of extracting far greater rewards for innovation than what they should get, to the detriment of consumers, a further consequence of the hold-up problem might be a lessening in confidence towards the whole standardization process by implementers, hence a distortion of competition and hence a lessening of innovation in downstream markets. Hence, as in the case of exclusionary conduct (such as refusal to deal or margin squeeze) the core concern is that the "the seeking of an injunction may distort competition in downstream markets". See A. JONES, *Standard-essential patents: FRAND commitments, injunctions and the smartphone wars*, supra note 1, at 18.

⁶¹ The CJEU seems to frame the case as a refusal to deal case, as she mentions the category several times and she mentions the risk that implementers' products are not released into downstream markets. See Court of Justice of the European Union, 16 July 2015, case C-170/13, *Huawei Technologies Co. Ltd c. ZTE Corp., ZTE Deutschland GmbH*, unreported, §§ 53-54.

⁶² See what happened in litigation concerning Apple and Motorola where the former company preferred to engage in negotiation rather than loosing sales of its standard-embedding products. *Motorola - Enforcement Of Gprs Standard Essential Patents*, case AT 39985, 29.04.2014 C(2014) 2892 final.

ex post market factors can justify⁶³. Quite on the contrary, in the *Huawei* case the assumption is exactly the opposite one: meaning that the mere holding of a SEP, because of a set of *endogenous* and *ex ante* factors (ie: the standardization process and the obligation to license on FRAND terms), confers dominance upon the holder, a dominance which can be abused if she brings a preliminary injunction for the alleged infringement of her products against a third party who has demonstrated to be interested in negotiating a license in good faith.

Now, despite sympathizing with the position expressed by the CJEU in its judgement, one cannot refrain from asking whether the mere holding of a SEP is really enough to prove dominance. And in fact, while in traditional refusal to deal cases, the market circumstances and factors determining the presence of exceptional circumstances – hence, turning the mere holding of an IPR into a position of dominance – have always been subject to in depth scrutiny by competition agencies, the *ex ante intrinsic* factors attributing dominance *tout court* on SEPs have just been taken for granted by the European Court of Justice. An assumption which is perilous at best.

4. *SEPs and the assessment of dominance.*

While the issue was not raised in the preliminary ruling, hence not dealt by the CJEU, the question of whether the mere holding of a SEP can be enough in itself to confer a position of dominance bears a crucial importance in the assessment of these cases as the finding of dominance should be the first step to construe the theory of abuse⁶⁴.

There are no doubts that the selection of a patented technology within a standard enhances the value of the patent. As already pointed out, the strong *lock-in effects* characterizing *telecom industries* together with the impossibility to design around the standard technology, once it has become standard, will grant SEP holders a stronger bargaining position vis-à-vis implementers, conferring to the former a certain degree of market power⁶⁵, intended in economic terms as the power to raise the royalty rates of the licensing agreement (by threatening not to license in the first place)⁶⁶.

Under this perspective, it would seem that the SEP holder has the power to behave independently of its competitors, customers and consumers, as enshrined in the European notion of dominance, as his control over a fragment of technology insisting on a small component (the standard) of a much more complex product (for example a smartphone), sold in a separate market (i.e. the market for smartphones), grants him power to successfully threaten implementers' products survival on such market⁶⁷. Moreover, the SEP holder's

⁶³ This approach has been indeed adopted by the European Commission also in the *Motorola* decision. See *infra* at § 4.

⁶⁴ Dominance still is the first step to analyse cases of abuse, despite the attempts to eliminate it. On the subject see E. AREZZO, “Is there a role for market definition and dominance in an effects-based approach?” Max Planck Forum on Competition Law: “Art. 82 EC: New Interpretation, New Enforcement Mechanisms?”, S. Enchelmaier, B. Conde Gallego, M.O. Mackenrodt (eds.), 2008.

⁶⁵ J. KATTAN, *FRAND Wars and Section 2*, in *Antitrust* Vol. 27, n. 2, 2013, 30, at 31.

⁶⁶ See A. LAYNE-FERRAR, A.J. PADILLA, *Assessing the Link Between Standard Setting and Market Power*, March 2012, <http://ssrn.com/abstract=1567026>, at 3, explaining that applying standard economic theories of market power to the SSO scenario, we find that “Market power enables a holder to license more broadly than it otherwise would have and perhaps to charge supra-competitive prices for those licenses.”

⁶⁷ In this sense see J. KATTAN, *FRAND Wars and Section 2*, in *Antitrust* Vol. 27, n. 2, 2013, 30, at 31; A. LAYNE-FERRAR, A.J. PADILLA, *Assessing the Link Between Standard Setting and Market Power*, March 2012, <http://ssrn.com/abstract=1567026>, at 2; C.V. CHIEN, M.A. LEMLEY, *Patent Holdup, The ITC, and the Public Interest*, 98 CORNELL L. REV. 1, 8 (2012). But see V. MELI, *Standard, standardizzazione e applicazione dell'art. 102*

threat to enforce its patent(s) can determine a direct significant price increase of the final product⁶⁸, as experience has shown that often SEP holders have demanded royalties calculated as a percentage of the price of the final product sold in the market (for example a smartphone), despite the fact that their rights insisted on a sliver of technology composing a component of the overall final device⁶⁹.

The overall considerations just highlighted have led several authors to agree that the mere holding of a SEP is sufficient *per se* for the firm to be regarded as dominant.⁷⁰ Nonetheless, if such enhanced patent value or market power is tantamount to a finding of dominance pursuant to art. 102 of the TFEU⁷¹ is a question to which conflicting answers have been provided⁷².

Tfue ai conflitti su licenze relative a diritti di proprietà intellettuale, in *Orizzonti del Diritto Commerciale (online Law Review)*, Year II, 2014, 1, at 22, who is very skeptical towards a reconstruction of the finding of dominance exclusively based on the company's power to set the rules to compete on a certain market, without taking into account his *actual* position in such market. As Meli rightly points out, such an approach might lead to a rather peculiar situation where SEP holders' conduct could be found abusive even if they are not active in the related market of standard embedding products.

⁶⁸ R. GRASSO, *The ECJ ruling in Huawei and the right to seek injunctions based on FRAND-encumbered SEPs under EU competition law: one step forward*, in 39 *World Competition*, 2016, 213, at 218.

⁶⁹ In the North-American *Microsoft v. Motorola* case, for example, Motorola asked for a royalty of \$ 3.00-\$4.50 per unit, while the Court later set the FRAND rate at \$0.03471 per unit. See Microsoft Corp. v. Motorola, Inc., No. C10-1823JLR, 2013 U.S. Dist. LEXIS 60233 (W.D. Wash., Apr. 25, 2013) (*Microsoft F/RAND Rate Decision*), at 212 and 303. Similarly, in the Dutch case *Samsung v. Apple*, Samsung made an offer whereby it asked for a royalty rate of 2.4 percent of the entire sale price of the relevant Apple products (i-phones and i-pads) and the District Court held that such an offer did not comply with the commitment to license at FRAND terms. See D.C. Hague, Mar. 14, 2012, Dkt. Nos. 400367/HA ZA 11-2212, 400376/ HA ZA 11-2213, 400385 / HA ZA 11-2215 (Samsung Elecs. Co. Ltd/Apple Inc.). Other examples can be found in L.B. GREENFIELD, H. SCHNEIDER, J.J. MUELLER, *SEP Enforcement Disputes Beyond the Water's Edge: A Survey of Recent Non-U.S. Decisions*, 27 *Antitrust* 3, (2013).

⁷⁰ See A. JONES, *Standard-essential patents: FRAND commitments, injunctions and the smartphone wars*, supra note 1, at 16, arguing that patent owners are likely to acquire market power after the standard is adopted if it subsequently becomes impossible for implementers to invent or design around the patent; J. KATTAN, *FRAND Wars and Section 2*, in *Antitrust* Vol. 27, n. 2, 2013, 30, at 31, arguing that owners of SEPs on for widely implemented standards possess monopoly power for the technologies on which their SEPs read. But see also R. O'DONOGHUE, J PADILLA, *The Law and Economics of Article 102 TFEU*, Hart Publishing, 2nd ed., 2013, at 703, who stress that it is also important to check whether the exercise of market power is constrained by countervailing factors, such as blocking patents owned by the manufacturers. A more cautious approach is endorsed by some other authors: for example, R. GRASSO, *The ECJ ruling in Huawei and the right to seek injunctions based on FRAND-encumbered SEPs under EU competition law: one step forward*, in 39 *World Competition*, 2016, 213, at 211, stressing that others factors need to be taken into account to elaborate a finding of dominance, even in the case of SEPs. A contrary view is expressed by A. LAYNE-FERRAR, A.J. PADILLA, *Assessing the Link Between Standard Setting and Market Power*, March 2012, <http://ssrn.com/abstract=1567026>, arguing that no direct evidence exist which assert an unequivocal correlation between SSOs and market power, and that, while several other factors need to be taken into account, "in examining measureable effects on patent value we find that some SSOs appear to enhance some included patents' importance or value, but most do not".

⁷¹ As well known, the European concept of dominance entails a "[...] position of economic strength enjoyed by an undertaking which enables it to prevent effective competition being maintained on the relevant market by affording it the power to behave to an appreciable extent *independently* of its competitors, its customers and ultimately of the consumers". See Case 27/76, *United Brands v. Commission*, [1978] ECR 207, para. 65; Case 85/67, *Hoffmann-La Roche v. Commission*, [1979] ECR I-461, para. 38.

⁷² Another critical aspect concerns the delineation of the relevant market. At this regard see V. MELI, *Standard, standardizzazione e applicazione dell'art. 102 Tfue ai conflitti su licenze relative a diritti di proprietà intellettuale*, in *Orizzonti del Diritto Commerciale (online Law Review)*, Year II, 2014, 1, at 29 e ss.

In particular, it seems that the EU Commission is not at all convinced by this theorem. The Guidelines on horizontal cooperation clearly explain that even if the establishment of a standard can create or increase the market power of holders of standard-essential IPRs, “[...] *there is no presumption* that holding or exercising IPR essential to a standard equates to the possession or exercise of market power” and rightly points out that “[...] The question of market power can only be assessed on a case by case basis.”⁷³ Similarly, in the *Motorola* decision the Commission vividly stated that “[...] the mere ownership of a SEP does not [...] in itself equate to dominance” and that other factors had to be taken into account, in particular the circumstance that access to such *privately adopted* standard (the GPRS technology) had become indispensable for manufacturers of standard-compliant products and the related circumstance that the industry was locked-in to that standard.⁷⁴ This is a very important aspect, as *privately elected* standards are binding only to the members of the SSO who have chosen the technology but they are not *per se* compulsory for all industry participants, unless such standard also becomes a *de facto standard*. And in fact, other *private standards* selected by concurrent SSOs may well emerge and represent valid alternatives.

In the *Motorola* decision, the Commission carefully analysed the circumstances of the case, demonstrating that the GPRS technology had been widely adopted in the overall industry due to its inclusion in the GSM standards specification and its implementation by network operators in their 2G networks. The wide adoption of GPRS in the EEA led, in turn, device manufacturers to base their services and products on the same air interface technology, so that devices can communicate with the network: this eventually led to a situation where industry players became locked-in to the GPRS technology⁷⁵. Such an analysis is absent in the CJEU judgement.

4.1. The implementation of a standard-compliant product does not imply tout court infringement of all SEPs insisting on the standard.

Another aspect seems relevant when we discuss the implications stemming from the assumption that mere holding of a SEP confers dominance. And in fact, even if it well might happen – and it has happened -- that firms holding SEPs on technologies embedded into a standard successfully hold-up implementers in the downstream markets, it is just not convincing that *each* SEP holder, even one controlling the *tiniest marginal* fragment of technology *declared to be essential*, or even one who is aware of possessing a very weak patent, can *always* and just by himself successfully threaten the survival on the market of every possible standard-embedding products⁷⁶.

This conclusion stems from the widely accepted belief that manufacturing of a standard-embedding product necessarily implies *per se* the infringement of *all* the essential IPRs insisting on the standard. Such theorem is based on two intertwined assumptions. The

⁷³ *Guidelines on the applicability of Article 101 of the Treaty on the Functioning of the European Union to horizontal co-operation agreements*, supra note 4, § 269.

⁷⁴ *Motorola - Enforcement Of Gprs Standard Essential Patents*, case AT 39985, 29.04.2014 C(2014) 2892 final, § 223, 226.

⁷⁵ *Motorola - Enforcement Of Gprs Standard Essential Patents*, case AT 39985, supra, §§ 227-228, 231. In this case, the Commission further ruled out any likely emergence in the short and medium term of an alternative GPRS technology in the EEA. because of the prevalence of GPRS-compliant products and of the large investments that market participants had already made in GSM/GPRS networks in the EEA. *Idem*, at § 232.

⁷⁶ A. JONES, *Standard-essential patents: FRAND commitments, injunctions and the smartphone wars*, supra note 1, at 5.

straightforward infringement assumption stems from the very same concept of “essentiality” (hence: indispensability) adopted by the majority of SSOs. Essentiality of the IPRs is indeed generally described as a situation whereby it is not possible on technical grounds to make equipment which complies with the standard without infringing it⁷⁷: which means that if implementers make something which is standard-compliant without proper access to the underlying IPRs they must be infringing them⁷⁸.

The second part of the theory implies that the infringement automatically covers *all* the standard essential IPRs. This assumption has strong procedural implications. In fact, if the essential IPRs all at once are inevitably infringed, there is no need to prove that any specific SEP’s violation has taken place. It will suffice to show that the SEP has been declared essential to the standard and that the alleged infringer has manufactured a standard-compatible product without a license. This second assumption derives straightforwardly from the application of the famous *Cournot* “complements theory” to essential IPRs⁷⁹, deriving that SEPs (and essential IPRs in general) are *all* to be deemed essential inputs to the release of a final product (which would be the standard) and therefore *all* necessarily to be employed for the manufacture of a standard-compliant product⁸⁰.

Both the assumptions of the above described theorem, however, are not entirely convincing. First of all, SEPs are not always *truly* essential, despite being declared so by their holders. It is common knowledge that firms are prone to over-declare the essentiality of their titles of protection – especially in the case of weak patents – to have them inserted in the cluster of essential IPRs and gain from the licensing⁸¹. Besides, much in the same way it happens with regard to the validity of IPRs, competition authorities do not perform any checks on the actual essentiality of the patents to the standards. By the same token, assuming that the contested SEPs are truly essential to the standard, it might well be the case that such

⁷⁷ According to the most recently revised version of the ETSI IPR Policy, “«ESSENTIAL» as applied to IPR means that it is not possible on technical (but not commercial) grounds, taking into account normal technical practice and the state of the art generally available at the time of standardization, to make, sell, lease, otherwise dispose of, repair, use or operate EQUIPMENT or METHODS which comply with a STANDARD without infringing that IPR”. See ETSI Rules of Procedures, 20 April 2016, Intellectual Property Rights Policy, clause 15.6, 41. For an overview of the most used practices See R. BEKKER, A. UPDEGROVE, *A study of IPR policies and practices of a representative group of Standard Setting Organizations worldwide*, September 2012, available at <http://ssrn.com/abstract=2333445>, at 34.

⁷⁸ The EU Commission in *Motorola - Enforcement Of Gprs Standard Essential Patents*, case AT 39985, Brussels, 29.04.2014 C(2014) 2892 final, argued that in the standard-setting context, by seeking and enforcing an injunction, an SEP-holder is able to exclude ‘even the most innovative standard-compliant products from the market as, by definition, the patented technology cannot be worked around’, and eventually limit consumer choice and partially eliminate downstream competition. *Motorola - Enforcement Of Gprs Standard Essential Patents*, case AT 39985, Brussels, 29.04.2014 C(2014) 2892 final, at § 312.

⁷⁹ P. CHAPPATTE, *Fraud commitments – the case for antitrust intervention*, in *European Competition Journal*, 2009, 319, at 326.

⁸⁰ The complement theory seems to be espoused also by the European Commission. See Communication from the Commission — Guidelines on the application of Article 101 of the Treaty on the Functioning of the European Union to technology transfer agreements, OJ C 89, 28.3.2014, p. 3–50, § 252, where it explains – with regard to pools -- that technologies that are essential “are by necessity also complements”.

⁸¹ See B. KANG, E. BEKKERS, *Just-in-time patents and the development of standards*, Research Policy 44 (2015) 1948. This phenomenon is exacerbated by the circumstance that several SSOs allow for so called blanket disclosures, meaning declarations whereby a party indicates its ownership of one or more patents reading on the standard, while not revealing the details of such patents. See *Patents and Standards, a modern framework for IPR-based standardization*, Final Report, Study prepared for the European Commission, Directorate General for Enterprise and Industry, 2014, (hereinafter *Patent and Standards*), at 117.

titles of protection are not enforceable, hence not infringed. The SEPs indeed might be found invalid or simply might have expired. Eventually, in the most remote scenario, patents might not be essential to implement within a product, despite the fact that they are correctly identified as SEP and they are valid⁸². Indeed, even a patent -- or more precisely of one of its claims⁸³ -- which is declared *essential* to a standard might prove not to be so in practice if it regards an *optional* feature of the standard technology⁸⁴. This is because the normative clauses of the standard often refer both to mandatory portions, meaning those elements which must necessarily be implemented for the final product to be deemed standard-compliant, as well as to optional portions of the technology which may never be practically implemented⁸⁵. As consequence, even if many SSOs' policies demand claims on optional technologies within the standard to be treated as essential⁸⁶, clearly when certain manufacturers decide not to implement certain optional features of the standard in their products, SEPs that are only essential to such specific features will not be infringed⁸⁷.

5. Conclusion.

The CJEU sentence in the *Huawei* case tries to provide an answer to one of the most thorny issue of this century, namely whether the holder of a standard essential patent commits an abuse of dominant position when he enforces his right – apparently legitimate – to a preliminary injunction against an implementer wishing to make and sell a standard-embedding product without a license. As the CJEU rightly states, the answer cannot be provided without taking into consideration the conduct of the opponent: meaning, whether the implementer wishes or not to enter the negotiation and to pay for the appropriate rate of royalties. To this end, in responding to the preliminary ruling posed by the German Court, the CJEU sets some sort of best practices, a set of detailed rules of conduct to which both parties involved shall abide, in order for the circumstances of the case not to be held abusive.

⁸² *Patents and Standards, a modern framework for IPR-based standardization*, Final Report, Study prepared for the European Commission, Directorate General for Enterprise and Industry, 2014, at, 116.

⁸³ See at this regard R. BEKKER, A. UPDEGROVE, *A study of IPR policies and practices of a representative group of Standard Setting Organizations worldwide*, September 2012, available at <http://ssrn.com/abstract=2333445>, at 11, stressing that it is more appropriate to refer to “essential claims” rather than “essential patents”, as a patent might well contain a broad set of claims many of which might not be essential. Therefore, the authors observe that a properly crafted IPR policy should not impose licensing obligations to claims other than those that are in fact essential.

⁸⁴ A. LAYNE-FERRAR, A.J. PADILLA, *Assessing the Link Between Standard Setting and Market Power*, March 2012, <http://ssrn.com/abstract=1567026>, at 12. This point has also been later emphasized, with regard to the determination of the appropriate royalty rate pursuant to a FRAND commitment by G. GHIDINI and G. TRABUCCO in *Pro-competitive Guidelines for Assessing FRAND Royalties with Regard to SEPs*, in this Law Review.

⁸⁵ R. BEKKER, A. UPDEGROVE, *A study of IPR policies and practices of a representative group of Standard Setting Organizations worldwide*, September 2012, available at <http://ssrn.com/abstract=2333445>, at 41.

⁸⁶ R. BEKKER, A. UPDEGROVE, *A study of IPR policies and practices of a representative group of Standard Setting Organizations worldwide*, September 2012, available at <http://ssrn.com/abstract=2333445>, at 41. The study analyzes the practice of the ten most important SSOs and finds that the majority of them tends to classify patents on optional features of the standard as essential patents. The author highlights that this should be in theory to the advantage of the implementers who should be able to obtain a FRAND license also on such optional features. However, this circumstance shows that the mere production of a standard-compliant product does not amount *per se* to an infringement of an essential patent.

⁸⁷ *Patents and Standards, a modern framework for IPR-based standardization*, Final Report, Study prepared for the European Commission, Directorate General for Enterprise and Industry, 2014, at 115-116.

Despite being quite reasonable and convincing in its holding, the sentence does not delve into a crucial aspect which remains in the shadows. The Court, indeed, takes for granted the assumption that mere holding of SEPs is tantamount to holding a dominant position in the market, avoiding also the second related question of how to delineate the relevant market in such a case. One might easily respond that dominance was not an aspect raised in the preliminary ruling, henceforth the Court was not compelled to deal with the issue. While this is circumstance is true, one cannot avoid adding however that still the Court might have – or should have – stressed that all the reasoning put forward is valid as long as the firm is indeed found dominant.

In an attempt to apply the exceptional circumstances test also to SEPs, the Court stretched the overall reasoning well beyond the boundaries set in the well known refusal to deal cases (from *Magill* to *Microsoft*), inferring dominance from *ex ante* and *endogenous* factual situations (namely: the declaration that the patent is essential by its holder and the FRAND commitment), without any need to inquire whether such *privately* elected standard was also a *de facto* standard or whether there are other market circumstances which prove it to be actually indispensable to compete in the market. This latter element is crucial when speaking about privately elected standards as, despite being remote, chances could exist that alternative technologies are present or will soon enter the market. Such an analysis, indeed, has been conducted by the European Commission in the aforementioned *Motorola* case. Moreover, the need to engage into such an in-depth factual is strengthened by the circumstance that the overall system does not envisage any check on the true essentiality of the patent to the standard, not to mention the validity of the supposedly essential patent.