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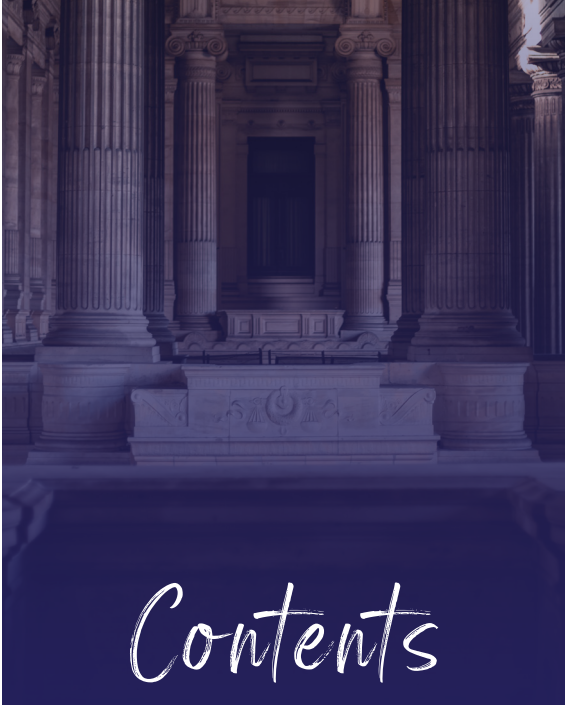
To IP and Beyond

SEP

SEP Jurisprudence in India



Contents

I. Pre-Suit SEP Negotiations: Do's & Don'ts

A. Intex v. Ericsson (DB)[1]

The first decision of the Division Bench of the Delhi High Court that gave crucial insight into factors that could lead to a finding of an "unwilling licensor" or an "unwilling licensee".

• The Delhi High Court found that FRAND cannot be construed as a 'one way street' where obligations are cast on the SEP holder alone. It envisages a candid and transparent negotiation between patentee and implementer.

• The conduct of the parties during negotiations is one of the key factors to determine willingness. This exercise is usually fact sensitive.

• Who would be a Willing Licensor?

An SEP owner who alerts the accused implementer of its SEPs, their mode of infringement, makes a FRAND offer, and in certain situations, provides necessary information (subject to NDA) for a licensee to be able to evaluate [the 'non-discriminatory' part of FRAND] an offer. If the licensor makes a supra-FRAND offer i.e. exorbitant royalty rates, then it will not be considered a willing licensor.

• Who would be a Willing Licensee? After getting a written offer from the SEP Holder, a willing licensee should not delay the negotiations in any manner and accordingly is required to make a counter-offer on FRAND terms. An implementor has no right of silence or inaction on the ground that they do have access to SEP holder's agreements. This is because even in the absence of SEP

holder's agreements, an implementer can take recourse to their own license agreements with other SEP licensors to be able to formulate an appropriate counteroffer. The counteroffer should be supported with an appropriate security in order evidence complete bona-fides. If no ad-hoc royalty is paid during the interregnum, then such party benefits to the disadvantage of other willing licensees and gets an unfair competitive edge in the market.

• Pertinently, Intex was found to be an unwilling licensee by the Single Judge due to its conduct of prolonging pre-suit negotiations and thereafter initiating proceedings against Ericsson before the Competition Commission of India and Intellectual Property Appelate Board during licensing negotiations, which prima facie showed its unwillingness to execute a FRAND licence

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B. Ericsson v. Lava[2]

Lava sued Ericsson in 2013 in the Noida District Court. Ericsson then sued Lava before the Delhi High Court for infringement of its 2G and 3G SEPs. The Noida court case was transferred to the Delhi High Court and heard together. The final decision post trial on infringement, validity and FRAND aspects the Delhi High Court held Lava an "unwilling" licensee based on the following factors:

• Deliberate delay in executing the NDA: Lava deliberately delayed signing of the NDA for 2 years, 'where the only change in the language of the two page agreement was changing the venue from Sweden to Singapore'. The NDA was signed only after Ericsson initiated suit against Micromax.

• No question were ever asked about the essentiality of Ericsson's patents during pre-suit negotiations: Lava repeatedly took time to only revert on technical queries and in effect never questioned the essentiality of the suit patents during the negotiation. Lava was engaged in discussions with Ericsson for 3 years, which, in itself, shows that they believed Ericsson's patents were essential.

• Lava unnecessarily insisted on Ericsson's third-party license agreements: Lava was "dishonest" in insisting that Ericsson provides its third-party license agreements. Such a request blatantly disregarded the confidentiality attached to these third-party agreements. According to the Court, after the signing of the NDA between the parties, Ericsson was not obliged to provide confidential information pertaining to third parties, as the purpose of executing NDA was to share confidential information pertaining to signatories to the said NDA. Court further noted that even ETSI does not impose a duty on the IPR owners to disclose commercial licencing terms to prospective licensees.

• Lava strategically filed the Noida suit just before a scheduled physical meeting: When Lava could not delay any further the physical meeting with Ericsson to negotiate the license terms, it filed the Noida suit. Court was of the view that when Ericsson's high-level representatives had already arrived in India to negotiate the licensing terms on a mutually agreed date, Lava's complete volte-face and filing of the Noida suit constituted lack of willingness.

• No rebuttal at trial to Ericsson's claims of essentiality and infringement: Lava failed to demonstrate its assertion, with cogent evidence, that the Standards could be implemented through alternative methods which are different from the suit patents. Lava had not led any evidence or expert analysis to prove that the conclusions drawn in Ericsson's test reports were incorrect and misleading.

• No Counteroffer by Lava: At no point did Lava ever present a counteroffer. Even though Ericsson had shared copies of interim orders passed by the Delhi High Court in Ericsson v. Micromax case, which contained rates that were offered to similarly placed entities as Lava, Lava failed to give a definitive response to the said offer, nor did Lava give any counteroffer to Ericsson. In fact, even during the course of final arguments in the case, when Court enquired from Lava whether rates offered to Micromax are acceptable to Lava, Lava remained unresponsive.

• Court found Ericsson's rates to be within the FRAND range: Placing reliance on comparable third party license agreements filed by Ericsson, the Court concluded that the rates offered by Ericsson are within the FRAND range

• Court ordered upper end of the FRAND rate for Ericsson's entire portfolio due to Lava's unwilling conduct: Since Lava did not engage in negotiations with Ericsson in good faith, Court ordered the upper end of the FRAND range for Ericsson's entire portfolio and not just the asserted suit patents. Further the Court ordered Lava to render damages from the date they were first notified by Ericsson of patent infringement.

Please note this judgment has been Appealed.

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II. Anti-Anti Suit Injunction and its merit in the context of a multi-jurisdictional SEP Conflict

Interdigital V. Xiaomi[3]

The Delhi High Court had granted an anti-anti suit injunction in favour of Interdigital, thereby injuncting Xiaomi from enforcing the Anti-Suit Injunction order granted in its favour by the Wuhan Court.

Brief Facts: Interdigital had filed two suits against Xiaomi, alleging infringement of its SEP in 3G,4G, 5G and HEVC technologies. IDG also sought an Anti-Anti Suit Injunction (AASI) against Xiaomi, since Xiaomi had obtained an Anti-Suit Injunction (ASI) from the Wuhan Court, preventing IDG from proceeding with the suit in the Hon'ble Delhi High Court. Although the Hon'ble Delhi High Court vide order dated 09.10.2020 granted an ad-interim injunction preventing Xiaomi from enforcing the ASI, it subsequently made the order absolute on 03.05.2021 The Hon'ble Court had made following important observations in its judgement:

• There was no conflict between the adjudication of the FRAND rate determination proceedings before Wuhan Court and the infringement proceedings before the Delhi High Court, as the latter were limited only to the Indian Suit patents.

• An anti-suit injunction should be granted only in rare cases, and not for the mere asking. An anti-suit injunction could only be granted by a Court possessing

"sufficient interest" in the lis forming subject matter of the proceedings, which it intends to injunct.

• Interference with the right to pursue one's legal remedies, before the preferred forum, which was competent to adjudicate thereon, amounts to "oppression", especially where there is no other forum which the litigant could approach.

• In patent infringement matters, it was the right of the patent holder to choose the patents and where it desired to enforce it. The right to seek legal redressal against infringement is a fundamental right.

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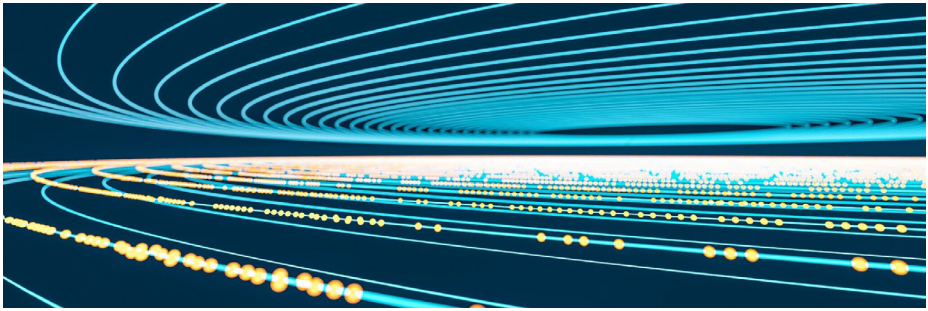
III. Pro Tem Deposits: An Emerging Trend in SEP Cases



Brief background: Ordinarily, any interim relief in patent matters is granted only upon the satisfaction of the trifecta of: (i) prima facie case of infringement and validity of the suit patents, (ii) balance of convenience, and (iii) irreparable harm. However, when SEP litigations started getting instituted before the Delhi High Court, initially ex-parte ad interim injunctions were often granted for the asking by alleged SEP holders, as they insisted that the same was necessary since they possessed SEPs. These interim injunctions would then invariably get modified only by consent of an interim arrangement, whereby the accused implementer would be constrained to render interim deposits at the rates more often than not dictated by the SEP holder. However, it was only upon consistent representations made by various accused implementers, that the Indian Courts were made aware of the fact that SEP claims are unilateral in nature and need to be verified by the national court in accordance with national laws. This eventually resulted in denial of ex-parte ad interim injunctions and emergence of the insistence of pro tem deposits by SEP holders, even prior to a determination of the merits of their claims. Usually the request for pro tem deposits were being made on the following grounds:- (i) that the financial position of the Defendant is precarious, (ii) that the SEP holders have many third party licensees and thus the credibility of the suit patents being SEPs should be presumed in their favour and (iii) that the accused implementer did not act in a FRAND-ly manner during pre-suit negotiations. This raised serious legal questions on whether such exceptions are justified to be made in the case of SEP matters and if pro tem deposits should be given without taking the Defendant's defences into consideration, and that too prior to an prima facie assessment of the Plaintiff's claims.

The following two key decisions of the Delhi High Court have clarified the law on pro tem deposits in SEP cases:

A. Nokia v. Oppo (DB)[4]

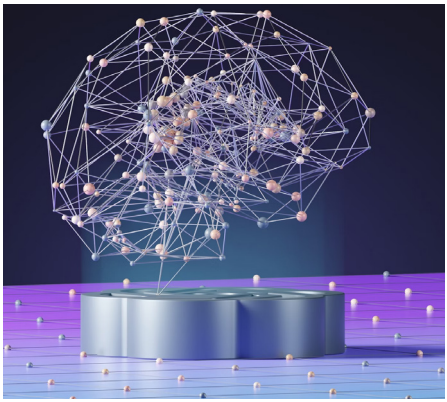
Brief Facts & Takeaways

• Facts: Nokia sued OPPO alleging infringement of its 3G, 4G and 5G SEPs. Relying on a previous licensed agreement, Nokia sought pro tem deposits on the basis of 'admissions' inferred from OPPO's willingness to renew the previous licensing arrangement. The Ld. Single Judge dismissed Nokia's request primarily on the ground that no such 'admission' could be presumed in the facts of the case, since Nokia accepted that despite the previous licensing arrangement, OPPO was entitled to challenge the validity and essentiality of the suit patents. Nokia appealed to the Ld. Division Bench, which overturned the Single Judge's decision and directed OPPO to deposit monies (in line with its previous agreement) with the High Court during the pendency of Nokia's interim injunction application.

• The Ld. Division Bench noted that since an application for interim injunction is usually heard at length in India wherein Court has to examine various technical aspect on merits and the same would take time, it was therefore necessary for the Court to pass a pro-tem order.

• The Division Bench held inter alia that the Court has power to pass pro tem orders to balance equities without detailed merit exploration and noted that implementers have an asymmetric advantage in SEP disputes.

• Placing reliance on international jurisprudence (Huawei v ZTE), the Division Bench held that providing a security is a part of a willing



implementer's obligations during the negotiation stage itself.

• However, the Division Bench clarified that "normally speaking, a pro tem deposit should be directed only after a prima facie finding of essentiality and validity of the suit patents has been recorded". However, the Ld. Division Bench's justified its direction to OPPO to make a pro tem deposits based on the following facts in this case:

- There was a previous licensing arrangement that OPPO was willing to renew,

- OPPO had given counter offers,

- OPPO also offered to make interim payments during pre-suit negotiations,

- OPPO had sought FRAND determination of Nokia's portfolio in China,

- There were findings of infringement of Nokia's patents by OPPO in foreign courts.

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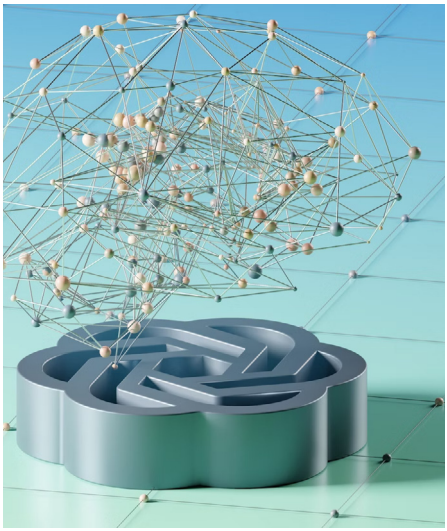
B. OPPO v. Interdigital (DB).[5]

Brief Facts & Takeaways

• Interdigital sued OPPO for infringement of its Cellular (3G-5G) and HEVC SEPs and sought inter alia interim injunction as also pro tem deposits. The parties had agreed vide consent order to dispose of the interim injunction and pro tem applications in view of the international bank guarantees already provided by OPPO in favour of INTERDIGITAL. As these BGs could not be verified before the Court by the issuing Bank, as they needed to be notified through proper channels, OPPO offered to provide an Indian Bank Guarantee instead. However, Interdigital objected to the Indian BG and instead insisted upon pro tem deposits. The Ld. Single Judge directed OPPO to make pro tem deposits with the Court by holding that OPPO has breached the consent terms. OPPO preferred an appeal which was allowed by the Division Bench accepting OPPO's Indian Bank Guarantee instead of the pro tem deposits ordered by the Single Judge. The Ld. Division Bench held as follows:

• **Pro Tem deposits cannot be ordered sans a consideration of defences:** The Division Bench, clarified the Nokia v OPPO decision and held that it is not authority for the proposition that orders for pro tem deposits, can be ordered without taking into consideration the defences of the accused implementer and taking a prima facie view i.e. that the Court must form a prima facie view of infringement after consideration of the defences raised by the implementer

• **Pro Tem deposits are not punitive:** The Division Bench further held that pro tem orders are essentially ad-interim relief and are not meant to be "punitive" in nature.



• **BG is acceptable as Pro Tem security:** The Division Bench held that there was no breach by OPPO and that the Bank Guarantee offered by OPPO was acceptable. This acceptance of BG has greatly benefited accused implementers, who would not be saddled with onerous deposits during the pendency of the suit, thereby negatively impacting their cash flows.

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IV. Interim Injunctions: Requirements of Law.

Intex v Ericsson (DB)[6]

Brief facts: Ericsson sued Intex seeking, inter alia, interim injunction from infringing 8 (eight) of its SEPs for 2G and 3G telecommunication standards. The Ld. Single Judge found prima facie in favour of Ericsson on validity, essentiality, infringement, and willingness to license on FRAND terms. After examining 26 (twenty-six) of Ericsson's third-party agreements, the Ld. Judge granted an interim injunction, fixed and interim royalty rate and directed that Intex could avoid the injunction subject to paying 50% of the interim amount to Ericsson and securing the remainder 50% through a Bank Guarantee. In cross-appeals, the Ld. Division Bench held in favour of Ericsson while making the following important observations:

• Test of Infringement in SEP matter: Court upheld the indirect test of infringement i.e. "(i) Mapping patentee's patent ('A') to the standard ('B') to show that the patent is a Standard Essential Patent. (ii) Showing that the implementer's device ('C') also maps to the standard ('B')".

• When is there a cause for interim relief in SEP suits made out? Court held that "at the stage of seeking interim relief, the Court must consider the relief sought in the case from a prima facie perspective. This means that the Court must assess whether prima facie, the patent is infringed. The Court must also assess prima facie, whether the implementer is an unwilling licensee and/or whether the royalty sought by the plaintiff is on

FRAND terms i.e. whether globally or locally similar implementers are paying royalty in accordance with the terms suggested by the patentee."

• Injunction can be granted if infringement of even one patent is prima-facie established: Court held that to restrain an infringing device, an SEP holder does not have to sue based on each of the thousands of patents that it claims to own in the product. It can do so by showing that even one patent is infringed, like a "silver bullet".

• Global Portfolio License is capable of being FRAND: As the value is in the technology which forms a part of the standard and the suit patents is just representative of that technology, the Court held that an SEP holder is not required to offer individual patent licences or country specific licences and that global portfolio licences are capable of being FRAND.

• Intex was prima-facie held to be an intentional unwilling licensee: Court observed that Intex pro-longed negotiations for 5 years s, during which it did not raise any objection regarding essentiality of Ericsson's patents. Nor did Intex share any of its own claim charts with Ericsson either indicating use of alternate technology or disputing essentiality of Ericsson patents or countering Ericsson's claim charts. Further, Intex also initiated proceedings against Ericsson before the CCI and IPAB in the midst of licensing negotiations, which also prima facie showed its unwillingness to execute a FRAND licence

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V. Discovery: Relevant Evidence

Courts, world over, have adopted the comparable license approach to determine FRAND license rates. As such, SEP owner's third-party agreements have become crucial to negotiating FRAND licenses and the adjudication of FRAND disputes. However, SEP holders then began to assert that even the agreements of the accused implementer are relevant to decide the issue of FRAND. While in the Interdigital v Xiaomi[7] judgement it was observed that there was no relevance of the accused implementer's agreements on the issue of FRAND, this came to be conclusively decided in the following decision.

InterDigital v OPPO[8]

Brief Facts: Interdigital had sued OPPO for infringement of its Cellular (3G-5G) and HEVC SEPs before the Delhi High Court. Interdigital sought discovery of OPPO's agreements with third parties for the said technologies, as also OPPO's agreement with Qualcomm. According to Interdigital, OPPO's third party agreements were relevant to the issue of FRAND to demonstrate their unwillingness and OPPO's agreement with Qualcomm was additionally relevant to verify the exhaustion defence raised by OPPO. OPPO also sought Interdigital'

s agreement with Qualcomm for the issue of FRAND and exhaustion. The Ld. Single Judge directed both parties to produce their respective agreements with Qualcomm, while disallowing Interdigital' s request for OPPO's agreement with third parties, noting that the same are not relevant for FRAND.

Key Takeaways:

• The Defendant's agreements are not relevant for the issue of FRAND: Court held that for the issue of FRAND an assessment of comparable licenses of the Plaintiffs is required and there is no relevance of the Defendant's third-party licenses for this purpose.

• Plaintiff needs to provide positive evidence on issued of Essentiality and Infringement before progressing to the issue of FRAND: Court held that since the onus of establishing essentiality and infringement is on the Plaintiff, they are required to supply positive evidence for the same before an assessment of FRAND issues arise. Court also observed that in the Interdigital vs Lenovo case, UK Court had dismissed a similar request made for disclosure of Lenovo's agreements. Accordingly, Court held that OPPO's agreement with Orange SA and Ericsson are not relevant for determination of FRAND rates.

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VI. Confidentiality Clubs: Balancing Equities while Securing Confidentiality

Interdigital V Xiaomi.[9]

Facts: Interdigital sued Xiaomi alleging infringement of its SEPs in 3G/4G/5G and HEVC technologies. In the suit, Interdigital sought setting up of a two-tier confidentiality club: Outer Tier with access to all documents designated as confidential (except those designated as 'Legal Eyes Only'), and Interdigital' s Inner Tier designated as "Legal Eyes Only" with access, in addition, to comparable licenses. Only advocates and external experts appointed by the parties could be members of Inner Tier. Interdigital argued that representatives or parties themselves could not be members of Inner Tier, which was opposed by Xiaomi.

The Court held in favour of Xiaomi as follows:

• Determining whether the rates offered by the Plaintiff are FRAND, is an integral part of SEP litigation which involves a holistic appreciation of the license agreements, between the plaintiff and other licensees. Therefore, the defendant as well as its employees and associates cannot be kept entirely out of such a procedure. Such a practice would be against principles of natural justice and fair play.

• It is settled law (as per Bar Council of India Rules, 1975 interpreted in various Supreme Court decisions) that lawyers

are the client's agents and therefore have to act as per their client's instructions. SEP infringement litigation cannot be treated as a category sui generis, to which the settled legal principles would not apply.

• It would be unreasonable to thrust on Xiaomi a FRAND rate which was adjudicated in the absence of Xiaomi and its officials or personnel.

• The constitution of club as sought by Interdigital would create an unequal balance since Interdigital would have access to the contents of all of the license agreements whereas Xiaomi would not have the same privilege. This cannot be allowed since Interdigital is required, by law, to allow exploitation of SEPs by Xiaomi, by granting a license to Xiaomi at FRAND rates. Therefore, third-party license agreements of Interdigital will be most crucial, rather than the agreements of Xiaomi.

• Pursuant to the above decision the High Court Of Delhi Rules Governing Patent Suits, 2022 came into effect on 24.02.2022 whereby as per Rule 11[10], "nominated representatives of the parties" were allowed to be included within confidentiality clubs.

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VII. Final Adjudication regarding FRAND & Quantum of Damages

Ericsson v. Lava[11]

On 28th March 2024, Delhi High Court pronounced its final judgment in the SEP litigation between Ericsson and Lava for claimed infringement of Ericsson's 2G and 3G SEPs. Delhi High Court ultimately decided the matter in favour of Ericsson by granting it damages to the tune of INR 244 Crores (USD 29.9 Million) along with interest @ 5% per annum till the full realisation of the amount, in addition to, legal costs. Hereinbelow is the summary of the important observations made by the Court on issues of FRAND and quantum of damages:

• Lava was found to be guilty of holding out: Court held that a review of the pre-suit correspondence evidenced that that Lava never had any intention to enter into a FRAND licensing agreement with Ericsson as it employed delaying tactics, nor did it provide a counteroffer. Court observed that Lava never questioned the essentiality of the suit patents during the period of negotiations and repeatedly took time to revert with technical queries, but failed to raise any. That even the signing of the NDA was delayed for 2 years. Court observed that even during the course of hearing the final arguments, Lava failed to confirm that it was willing to pay the same rates as what was being paid by Micromax (a similarly places entity), in terms of the orders previously passed by the Court. The Court therefore ultimately characterized Lava's conduct

as that of an "unwilling licensee" and held that it was guilty of employing "hold-out strategy".

• **Lava failed to establish hold-up and royalty stacking:** Court observed that Lava had failed to lead any evidence to prove royalty stacking and hold-up against Ericsson. Further, the Court held that there can be no question of royalty stacking, since Lava is not paying any royalty to any third party in respect of any SEPs being implemented in its devices and also since Lava failed to even give a counteroffer.

• **Ericsson's Offer was FRAND:** Ericsson placed 54 (fifty four) licenses on record, which upon review, Court held were comparable in nature as these agreements were made with entities similarly placed to Lava, and were competing with Lava in the Indian mobile handset market. Court further held that the rates offered to Lava were consistent with those accepted by other similarly situated entities, and thus the rates offered by Ericsson would fall within the FRAND range. The Court also held that a FRAND rate cannot discriminate between licensees on the "basis of scale of operations or date of entry in the market".

• **Comparable license approach was preferred over Top Down approach:** Court observed that for assessing damages, comparable license approach would be the preferred method since this approach relies on FRAND rates negotiated between parties in similar circumstances, making it a reliable benchmark for determining royalties for a prospective licensee. With respect to top-down approach advocated by Lava, the Court observed that Lava had not provided requisite evidence/calculations to justify adopting a top-down approach.

• **Quantum of Damages:** Since the patents had expired and no permanent injunction could have been granted, the Court computed the damages to be awarded in favour of Ericsson and the following considerations weighed in the Court's mind while computing damages:

i. **Damages should be awarded on FRAND rate:** Delhi High Court held that Ericsson is entitled to receive damages calculated based on the loss of royalty/ license fees it would have received had Lava executed a FRAND license agreement at the commencement of its business operations.

ii. **Damages should be granted for all devices not just the tested ones:** The Delhi High Court held that since Lava's impugned devices comply with ETSI standards as also the optional standards, and the position remains the same for all other Lava devices, damages ought to be paid for all devices and not only the tested devices.

iii. **Basis for computation of damages would be the device and not the chipset:** Lava had argued that royalty should be calculated on the value of the chipset and not on the basis of the entire device. However, the Court held that in light of "prevailing international jurisprudence" it was evident that the basis of calculation of royalty should be the end-product and not the chipset. Court further observed that in none of Ericsson's comparable agreements, the third parties were rendering royalties calculated on the value of chipset and instead were paying royalties based on the net selling price of the end-device.

iv. **Damages should be granted for the entire portfolio and not just the suit patents:** Lava had argued that royalty should be payable only for the eight Suit

Patents and not the portfolio of SEPs, however, the Delhi High Court observed that in the Noida suit, Lava themselves had sought a license from Ericsson for "all its SEPs and not just the suit patents". Further pursuant to reviewing the evidence, the Court held that Lava's case for licensing individual patents from a portfolio is not workable as this could cause substantial administrative burdens, increased transaction costs, "legal complexities", uncertainties in technology implementation and inefficiencies for both the licensors and implementers. While, on the other hand licensing the entire portfolio under FRAND principles, ensures equitable and fair treatment of implementers. Thus, the Court held that "granting damages only for the asserted patents, rather than for the entire portfolio, would not only deviate from industry practises and FRAND principles but also potentially disrupt the balance and fairness in the licensing ecosystem." Court also held that since compliance with standard implies implementation of all SEPs, therefore it is necessary to take a license for all SEPs and accordingly the damages would also have to be assessed on the basis of the entire portfolio.

v. **Limitation period for damages:** Delhi High Court held that damages in a patent infringement suit can be claimed from the date of publication of the patent application as the rights of the patentee are activated from the said date. The Court therefore held that the period of limitation (i,e, 3 years) as prescribed under the Limitation Act,1963 will not be applicable, on account of Patent Act being special law and thus, prevailing over general law. Court however, relied upon Section 111(1) of the Patents Act, 1970 to limit damages to the cut-off date of 1st November 2011, which was when Lava was first notified of Ericsson's claims.

vi. **Calculation of damages and determination of FRAND rate:** The Delhi High Court observed that Ericsson's November 2015 offer to Lava for 2G and 3G technology, which was similar to what was offered to other similarly situated entities would be relevant for determining the FRAND rate. As the rate specified in the November 2015 offer was a range, the Court adopted the "upper end of the range" since Lava had not negotiated in good faith. However, because 1 out of 8 suit patents was revoked, the necessary deductions were made and two separate royalty rates for 2G and 3G devices were arrived at. But, since Lava had not filed separate data for 2G and 3G devices, the Court applied an average of the two rates and arrived at the final royalty rate of 1.05% of the net selling price of Lava devices. The period for which royalties are payable, is 1st November 2011 (when Ericsson first wrote to Lava) till 8th May 2020 (when the last asserted suit patent expired) which amounts to INR 244,07,63,990 (USD 26.9 Million approx).

vii. **Litigation costs awarded in favour of Ericsson:** The Delhi High Court held that Ericsson is entitled to recover actual costs of litigation since Lava did not negotiate in good faith and failed to settle the dispute, despite numerous opportunities during the course of proceedings, nor did it give any counter offer.

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VII. About Us

Saikrishna & Associates is one of the largest IP practices in India offering comprehensive legal services in patents, copyright, trademarks, data privacy, competition law, TMT and more. With 285+ members, including 170+ advocates and 55+ patent attorneys / engineers, our strong bench strength has allowed us scale swiftly as per client's needs.

The firm's patent practice is served by a dedicated team of 75+ professionals, including 8 Partners. This team handles patent litigation, prosecution, and advisory work, catering to clients across diverse sectors like telecommunications, electronics, life sciences, AI, etc.

The team is known for its strategic and business relevant advice, particularly when it comes to setting realistic expectations in the unpredictability associated with the Indian judicial landscape.

Spearheading SEP-FRAND Jurisprudence in India

The Firm has been at the forefront of SEP litigation and advisory work in India. Having represented SEP licensees in ~24 out of ~39 SEP disputes in India, the Firm is uniquely placed to defend against a variety of SEP owner strategies. As many of these disputes are multi-jurisdictional, we work closely with several well-known firms across the globe in contributing to their global defence strategy.

Trials in IP matters are rare in India. Trials in SEP matters are rarer. We have the distinction of handling one of the three full SEP trials in India.

Saikrishna & Associates been involved in several landmark Indian decisions that shaped the SEP-FRAND landscape in India. These include rulings on:

1. The issue of pro-tem deposits by implementers in SEP disputes (Nokia v Oppo, FAO(OS)(Comm) 321/2022). This judgment was also awarded as an Impact Case of the Year by Benchmark Litigation APAC 2024 Rankings.

2. Access to comparable licenses by in-house representatives as part of Confidentiality Clubs in SEP suits (Interdigital v Xiaomi, CS(Comm) 295/2020 dt 16 Dec 2020).

3. The first-ever Anti-Anti-Suit Injunction in patent matters (Interdigital v Xiaomi, CS(Comm) 295/2020 dt. 09 Oct 2020).

4. The sufficiency of bank guarantees as security for pro tem royalty payments (Oppo v Interdigital, FAO(OS)(Comm) 47/2024).

5. Access to licenses of SEP licensees for determination of FRAND rates by SEP owners (Interdigital v Oppo, CS(Comm) 692/2021)

Further Reading

The lawyers at Saikrishna & Associates are avid writers who have authored several articles on various aspects of Indian law, including patent and SEP-related topics. Some of these publications are:

1. 'Assessing the Impact of Delhi High Court's 2022 Patent Suits Rules' -

provides an in-depth analysis of the Patent Suits Rules and their impact on patent litigation in India.

2. 'Working requirement under Indian Patent law: A toothless tiger?' - explores the issues and challenges surrounding the working requirement unique to Indian patent law.

3. 'Pro Tem deposits- An Emerging Trend in the Indian Standard Essential Patents Diaspora' - This article discusses the emerging trend of pro-tem deposits in SEP disputes in India, and the Delhi High Court's rulings on this issue.

4. 'The Doctrine of Equivalents in Patent Law – An overview of the Law in India' – discusses the applicability of the doctrine in India.

5. 'Foreign application disclosures under Section 8: Passing the parcel?' – discusses the impact of the amendments proposed in Aug 2023 to change the timeline for filing information about corresponding foreign applications at prosecution.

6. 'Delhi High Court renders its first SEP decision for Telecommunication Standards in the Ericsson v Lava case'

7. 'In Pursuit of Fairness: Delhi High Court's Do's and Don'ts for SEP Negotiations'

8. 'Delhi High Court Clarifies Scope of Discovery in SEP Suits'

9. 'Pro-Tem(ptation) of it all: Delhi High Court, clarifies on the issue of ad-interim relief in SEP matters'

Awards and Accolades

The firm has received numerous awards and accolades over the years. It is Ranked as a leading IP firm by prominent legal directories

• Winner – India Law Firm of the Year – Benchmark Litigation Asia Pacific 2024

• IAM Patents 1000 – Recommended Firm (2020, 2022, 2023)

• Managing IP APAC Awards – 2020 – Firm of the Year – Copyright

• Chambers & Partners – Asia Pacific 2015 - 2020 - Leading Firm - IP & TM - 2016-2020

• WTR 1000 – Gold Ranked Firm - Enforcement & Litigation (2016, 2017, 2018, 2019, 2020)

• Managing IP Global Awards 2014 – India – Patent Contentious

• Top Tier Firm – IP, White Collar Crime, and Government & Regulatory disputes - Benchmark Litigation Asia Pacific 2024

References

[1]Intex Technologies (India) Limited v. Telefonatiebolaget L.M. Ericsson (Publ) 2023 SCC OnLine Del 1845

[2]Telefonaktiebolaget LM Ericsson v. Lava International Ltd 2024:DHC:2698

[3]Interdigital Technology Corporation & Ors. V. Xiaomi Corporation & Ors 2021: DHC:1493

[4]Nokia Technologies Oy v. Guangdong Oppo Mobile Telecommunications Corp. Ltd. & Ors 2023 SCC OnLine Del 3841

[5]Guangdong OPPO Mobile Telecommunications Corp Ltd v. Interdigital Technologies Corporation & Ors 2024 DHC 4547 DB

[6]Intex Technologies (India) Limited v Telefonatiebolaget L.M. Ericsson (Publ) 2023 SCC OnLine Del 1845

[7]2020:DHC:3598

[8]InterDigital Technology Corp & Ors v Guangdong OPPO Mobile Telecommunications Corp Ltd & Ors 2024: DHC: 4610

[9]Interdigital Technology Corporation & Ors. V. Xiaomi Corporation & Ors 2020:DHC:3598

[10]Rule 11(i) “At any stage in a proceeding, the Court may constitute a confidentiality club or adopt such measures as appropriate, consisting of lawyers (external & in-house), experts as also nominated representatives of the parties, for the preservation and exchange of confidential information filed before the Court including documents, as per the Delhi High Court (Original Side) Rules, 2018.

Such nominated representatives of the parties, appointed to the Club, may inter alia, be persons who are not in charge of, or active in, the day-to-day business operations and management of the respective parties so as to maintain the integrity of the information so disclosed.”

[11]Telefonaktiebolaget LM Ericsson v. Lava International Ltd 2024:DHC:2698

[12]S111. Restriction on power of court to grant damages or account of profits for infringement: (1) In a suit for infringement of patent, damages or an account of profits shall not be granted against the defendant who proves that at the date of the infringement he was not aware and had no reasonable grounds for believing that the patent existed. Explanation. -A person shall not be deemed to have been aware or to have had reasonable grounds for believing that a patent exists by reason only of the application to an article of the word “patent”, “patented” or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanies the word or words in question

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