PRESENTED AT

18th Annual Advanced Patent Law Institute

March 23-24, 2023
Alexandria, VA

SEP and License Agreements

Presented by
Fabian Gonnell

Fabian Gonnell
Qualcomm
San Diego, CA
fgonnell@qualcomm.com

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

ERICSSON INC., AND TELEFONAKTIEBOLAGET LM ERICSSON, *Plaintiffs*, v. APPLE INC., *Defendant*.	§ § § § § § § § § § § §	CIVIL ACTION NO. 2:21-CV-00376-JRG

ORDER ON PRETRIAL MOTIONS AND MOTIONS *IN LIMINE*

The Court held a Pretrial Conference in the above-captioned matter on Monday, November 21, 2022 and Tuesday, November 22, 2022 regarding pending pretrial motions and motions *in limine* ("MILs") filed by Plaintiffs Ericsson Inc. and Telefonaktiebolaget LM Ericsson ("Plaintiffs" or "Ericsson") and Defendant Apple Inc. ("Defendant" or "Apple"). (Dkt. Nos. 177, 178, 179, 180, 181, 182, 183, 184, 185, 186, 187, 188, 189, 190, 191, 192, 193, 194, 195, 196, 197, 248, 249, 275, 276, 280, 281.) This Order memorializes the Court's rulings on the aforementioned pretrial motions and MILs as announced into the record from the bench, including additional instructions that were given to the Parties. Although this Order summarizes the Court's rulings as announced into the record during the Pretrial Conference, this Order in no way limits or constrains such rulings from the bench. Accordingly, it is hereby **ORDERED** as follows:

PRETRIAL MOTIONS

1. Apple's Motion for Summary Judgment on Apple's Counterclaim I (Dkt. No. 189)

The motion was **DENIED**. (Dkt. No. 289 at 22:21–42:7.) The Court was persuaded that the 2015 Global Patent License Agreement ("GPLA") did not specifically prohibit Ericsson from

filing its declaratory judgment action in this district and that the same was not a breach of the GPLA.

2. Ericsson's Motion for Summary Judgment on Apple's Counterclaim I (Dkt. No. 192)

The motion was **GRANTED**. (Dkt. No. 289 at 22:21–42:7.) The Court was persuaded that the GPLA did not specifically prohibit Ericsson from filing its declaratory judgment action in this district and the same was not a breach of the GPLA.

3. Ericsson's Motion Under Fed. R. Civ. P. 44.1 for Determination of Foreign Law (Dkt. No. 178)

The motion was **GRANTED**. (Dkt. No. 289 at 43:5–62:12.) The ETSI IPR Policy does not require Ericsson to license its non-SEP implementation patents under FRAND protocols. The Court noted that non-SEPs—or implementation patents—are clearly part of the GPLA, will be part of the evidence the jury will hear in this case, and are part of the totality of Ericsson's conduct in negotiation for SEP licenses under FRAND terms. Therefore, the Court held that it is appropriate for the jury to hear about relevant conduct related to non-SEP patents. Apple may not expressly or impliedly tell the jury that Ericsson's failure or refusal to license non-SEPs, alone, is a breach of Ericsson's FRAND obligation. It is merely one of a totality of circumstances relevant to the parties' FRAND obligations.

4. Ericsson's Motion for Summary Judgment on Apple's Counterclaim Count IV (Dkt. No. 194)

The motion was **DENIED**. (Dkt. No. 289 at 62:13–69:19.) The Court found that the contents of this motion were effectively ruled on in the context of the earlier pretrial motions. Any portion of this motion not specifically disposed of as part of the Court's ruling in other pretrial motions was **DENIED**.

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