

EIP

Further success for EIP's litigation team and client Optis against Apple

Today, 25 June 2021, judgment was handed down by Mr Justice Meade in the High Court, London, in the second of four technical trials listed in EIP client Optis' UK patent litigation and long-standing licensing dispute with Apple.

The four technical trials all concern patents from Optis' portfolio of standard essential patents (SEP). In the first test of the strength of that portfolio, back in October 2020, Optis were successful in establishing that its patent (EP (UK) 1,230,818) was valid and essential to the process of handing over a mobile telephone from a 4G or a 3G network to a 2G network.

Now in this second technical trial Optis established the validity, infringement and essentiality of patent EP (UK)2,229,744 B1 in respect of a mechanism for Radio Link Control (RLC) polling for continuous transmission within the Long Term Evolution (LTE) network. This patent had previously been upheld by Mr Justice Birss as part of the Unwired Planet v Huawei action, but Apple sought to challenge it again. That challenge was rejected.

Of wider significance to the SEP community as a whole is the Court's decision on Apple's so called "non disclosure / estoppel" defence. This called into question the process by which declarations of essentiality had been made to ETSI (European Telecommunications Standards Institute) by SEP holders. Apple argued that the relevant declaration had been made by Ericsson (the original patentee) out of time and that as a result the '744 patent could not be enforced against them. Since the evidence showed that somewhere in the region of 90% of declarations to ETSI followed the same process, the issue had potentially far reaching significance for the industry as a whole. In the event Mr Justice

Meade rejected Apple's arguments and held that the timing of Ericsson's declaration was in keeping with the ETSI IPR policy and the expectations of the members of ETSI as a whole.

EIP's Head of Litigation Gary Moss said: "This latest success is another step towards Optis being suitably recompensed for the use of the technology encapsulated in its patent portfolio, consistent with the ETSI IPR Policy. EIP is delighted to have assisted Optis in achieving such a positive outcome in this long running dispute. It is particularly gratifying that Apple's estoppel defence, which could have had serious implications extending beyond the current dispute, has been roundly rejected by the Court."

The EIP team on the case was:

On the technical issues: Robert Lundie Smith, Heather McCann, Jerome Spaargaren, Sunny Bansal, Tom Brazier, Catherine Howell, Emily Atherton, Jana Ebelt and Rebecca Dolman.

On the estoppel issues: Gary Moss, Kathleen Fox Murphy, Jack Dickerson, Angela Jack, Owen Waugh and Liam Rhodes.

Osbourne Clarke LLP were co-Counsel.

The barristers acting for Optis were:

On the technical issues: Tom Moody-Stuart QC, Tom Jones and Jennifer Dixon.

On the estoppel issues: Mark Chacksfield QC and Henry Edwards.