

IP Litigator, Ahoy! ITC Welcomes SEP Holders Navigating for The Best Venue, (May 1, 2025)

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Reza Dokhanchy, Michael T. Renaud, Amy LoBue

Reza Dokhanchy is a Member at Mintz. He is a patent and trade secret litigator who represents plaintiffs and defendants in the high-tech and life sciences fields.

Michael Renaud is Chair of Mintz's Intellectual Property Division. A pioneer in IP strategy, Michael has unique experience and expertise in formulating and executing multi-national enforcement and monetization strategies.

AmyLoBue is an Associate at Mintz in the Intellectual Property Practice. She focuses her practice on patent and trade secret litigation and monetization.

Given the recent unanimous decision by a UK appellate court that Ericsson's injunction efforts based on standard-essential patents (SEPs) were, essentially by their very nature, "hold-up" and "coercion" that violated Ericsson's FRAND obligations, and ordering Ericsson to grant a license, owners of SEPs may be looking for the best venue for asserting their rights. The answer is clear, albeit possibly surprising: the U.S. International Trade Commission, where injunction is the only remedy.

Courts around the world have taken varying and often conflicting views of how to treat enforcement of patents that implicate technological standards, called "SEPs," *i.e.* patents that are infringed by any product that complies with the standard. Given the widespread adoption of standards and the fact that some standards may be covered by thousands of SEPs, some courts have been hesitant to permit injunctions, which would prohibit the sale or use of these ubiquitous technologies. Many people therefore have the impression that one cannot successfully assert SEPs at the International Trade Commission, where injunction is the only remedy. But a closer look at ITC case law reveals that impression is incorrect. The most recent statement from an ITC ALJ was an order on December 20, 2024 recommending an exclusion order based on Nokia's SEPs and holding that the ITC "does not expressly prohibit exclusionary relief merely because standard-essential patents are asserted," and rejecting all arguments that Nokia's negotiation and litigation conduct violated its standards-related contractual obligations that would preclude injunction.^[1]

The impression that SEPs cannot be successfully asserted at the ITC likely stems from two sources. First, because standard-setting organizations (SSOs) nearly universally require members to contractually agree to negotiate a license for any SEPs they might have now or in the future (on terms that are "fair, reasonable, and non-discriminatory," or "FRAND") to any entity that wants a license, some believe that a logical consequence is that there can be no injunction since a license is contractually obligated to be granted, and generally for relatively low cost. However, over the past decade, ITC administrative law judges have repeatedly rejected this argument from respondents (the term for defendants at the ITC).

Instead, the law is that, as a defense, a respondent may raise a complainant's violations of its FRAND obligations, *i.e.*, a complainant's failure to adequately participate in a license negotiation process, failure to properly disclose patents, delaying license offers until after the standard is fully adopted (*i.e.*, "hold-up"), and other behaviors a respondent alleges is not "fair," not "reasonable," or not "non-discriminatory." These arguments may be raised (1) as an affirmative defense within the rubric of equitable defenses, such as implied waiver, implied license, promissory estoppel, and/or patent misuse, (2) possibly as an affirmative breach-of-contract defense,^[2] and (3) within the broader public interest inquiry that is part of every ITC proceeding.^[3] If successful,

it appears that the defense will serve as a bar to any remedy at the ITC. But, critically, there is no per-se bar against injunctions based on SEPs at the ITC.^[4] Moreover, as explained in the overview of SEP cases at the ITC below, and confirmed in recent rulings, the ITC has been justifiably skeptical of FRAND-based defenses.

Second, the 2013 *Samsung v. Apple* ITC investigation (the term for a case at the ITC) wherein the US Trade Representative vetoed the Commission's exclusion order likely lingers in the minds of attorneys. But that reasoning has never since been followed, either by the US Trade Representative in the form of a veto or by the ALJ or ITC in the form of recommending against an injunction due to concerns over abuse of SEPs or violations of FRAND obligations. Moreover, the DOJ and USPTO written policy on which the veto was based has since been rescinded.

Thus, given the right circumstances, the ITC is arguably the best venue to litigate SEPs.

ITC'S HISTORIC TREATMENT OF STANDARD-ESSENTIAL PATENTS

The impression many have regarding the lack of viability of SEP claims at the ITC may stem from the well-publicized *Samsung v. Apple* ITC investigation in which Samsung won an exclusion order against Apple, but the US Trade Representative vetoed it. However, time has shown that that case is an isolated one and its reasoning was limited to that case.

On June 28, 2011, Samsung filed suit in the ITC against Apple, accusing Apple's tablet and media player products of infringing two patents that [it] argued were essential to the Universal Mobile Telecommunications.^[5] Apple argued unsuccessfully that 1) Samsung was per se precluded from obtaining an exclusion order with respect to its infringed SEPs, 2) Samsung misused its patent when it allegedly violated its FRAND obligation, and that 3) Apple had an implied license because of Samsung's FRAND obligations.^[6] After the trial, June 4-15, 2012, the ALJ recommended that the Commission find that Samsung had not shown that Apple infringed any patent, including its SEPs. But on review, the Commission reversed and vacated the ALJ's findings with respect to one patent, which was also one of Samsung's SEPs, and issued an exclusion order.^[7]

During the subsequent presidential review period, on August 3, 2013, the US Trade Representative, Ambassador Michael Froman, vetoed the ITC's exclusion order. However, his rationale was based heavily on a since-repealed policy published a few months prior, in January 2013, by the US Department of Justice (DOJ) and the US Patent and Trademark Office (USPTO) that cautioned tribunals not to issue injunctions based on SEP infringement unless the infringer is unable to or refuses to pay for a license, or actually or constructively refuses to engage in license negotiations.^[8]

In 2019, the DOJ and USPTO withdrew the 2013 statement and clarified that all remedies available in an ordinary patent case "are equally available in patent litigation involving standards-essential patents."^[9] In 2022, the DOJ and USPTO withdrew the 2019 policy without reinstating the 2013 policy and without promulgating any clear standard to replace the 2019 version. Instead, the 2022 Policy Statement says only that the "DOJ will review conduct by SEP holders or standards implementers on a case-by-case basis to determine if either party is engaging in practices that result in the anticompetitive use of market power or other abusive processes that harm competition."^[10]

Critically, the authors of this article have found no instances since the 2013 Froman veto in which an ALJ or the Commission have accepted arguments from a respondent that injunctions are not available for an SEP, instead rejecting all such arguments, which are usually based on an alleged failure to comply with FRAND obligations.

The table below analyzes the SEP / FRAND discussion in ITC cases:

ITC Case	Date of Public Final Determination and Stage of Case	ALJ/ITC Reasoning with Respect to SEP-based Claim	Exclusion Order Granted?
<i>Motorola v. Microsoft</i> , Inv. No. 337-TA-752	May 10, 2012 – Initial Determination on Violation	The ALJ denied respondent Microsoft's arguments that	Yes, violation based on SEP infringement.

		FRAND obligations preclude complainants from seeking injunctive relief and noted there is no case nor statutory precedent that narrows the ITC's powers from granting exclusion orders to complainants. ID at 290. Respondent Microsoft failed to meet its burden to prove any FRAND defense or equitable defense related to SEP duties.	<i>On review, the Commission found no violation for reasons unrelated to SEP public policy or FRAND obligations (reversed on infringement).</i>
	and Recommended Remedy (reversed not in pertinent part)		
		Equitable defenses, including those based on an alleged FRAND violation, require a "stringent standard": the respondent must show by clear and convincing evidence that the complainant acted improperly before the defense will bar liability. ID at 147-48, 152. Respondent Apple failed its burden because complainant Motorola showed multiple other manufacturers took licenses to the SEP on FRAND terms and showed that it complied with SSO standards.	Yes, violation based on SEP infringement. <i>On review, the Commission found no violation for reasons unrelated to SEP public policy or FRAND obligations (reversed on validity).</i>
<i>Motorola v. Apple</i> , Inv. No. 337-TA-745	May 16, 2012 – Initial Determination on Violation and Recommended Remedy (reversed not in pertinent part)		
		ALJ showed concern for disallowing complainants per se from seeking exclusion orders for SEPs because this could entice licensees from claiming an offer is not FRAND in bad faith. Com. Op. at 44. The Commission found that Apple failed to show a FRAND violation by clear and convincing evidence because Apple cited no binding legal authority, there was evidence that Apple attempted to add language into the standard-setting organization policies to disallow injunctive relief per se but those attempts were denied, and Apple could not identify any specific obligations owed from complainant Samsung. Com. Op. at 45-48.	Yes, violation based on SEP infringement. <i>US Trade Representative Froman vetoed the exclusion order from taking effect allegedly out of public policy.</i>
<i>Samsung v. Apple</i> , Inv. No. 337-TA-794 <i>This is the Samsung v. Apple case that was vetoed by Amb. Froman.</i>	July 5, 2013 – Commission Opinion (reversing in part and finding violation)		
<i>LSI v. Realtek</i> , Inv. No. 337-TA-837	August 13, 2013 – Initial Determination on Violation and Recommended Remedy	Infringement was only found with respect to one asserted patent, which was not a SEP.	Yes, but violation not based on SEP infringement

	(no violation found on review based on patent expiration)	The ALJ noted that neither the Commission nor any ALJ has ever adopted the theory that a FRAND obligation per se precludes finding a violation and issuing an exclusion order. ID at 333, 360.	
<i>Amkor v. Carsem</i> , Inv. No. 337-TA-501	April 28, 2014 – Commission Opinion Reviewing Initial Determination on Violation of Remand Proceeding (affirming violation)	Respondent Carsem failed to show that any asserted patent was essential and thus the complainant Amkor did not have any FRAND obligations.	Yes, but violation not based on SEP infringement
<i>InterDigital v. Microsoft</i> , Inv. No. 337-TA-868	June 26, 2014 – Initial Determination on Violation and Recommended Remedy (affirmed in pertinent part on review)	No infringement was found of a valid patent and therefore FRAND obligations were irrelevant to the ALJ's analysis. ID at 108. Even if infringement was found, the FRAND obligations would be satisfied because it is well-known that a FRAND rate "is a range of possible values, depending on [hundreds of other] economic factors." ID at 113, 118.	No, due to lack of infringement of a valid patent
<i>InterDigital v. Microsoft</i> , Inv. No. 337-TA-613	May 8, 2015 – Initial Determination on Violation and Recommended Remedy on Remand (reversed not in pertinent part)	Respondents failed to show any evidence of hold-up and thus failed to meet their burden. Further, the ALJ found evidence of reverse hold-up because respondents refused to enter into a license or to compensate the complainant InterDigital. ID at 30-31, 51. The mere fact that licenses arising out of litigation may yield higher rates is not sufficient to show "discrimination" (i.e., to show a FRAND violation). ID at 33.	Yes, violation based on SEP infringement. <i>On review, the Commission found no violation for reasons unrelated to SEP public policy or FRAND obligations (reversed on infringement, based on issue preclusion).</i>
<i>Cisco v. Arista</i> , Inv. No. 337-TA-944	March 2, 2016 – Initial Determination on Violation and Recommended Remedy (affirmed in pertinent part on review)	The respondent Arista failed to show the complainant Cisco had agreed to FRAND obligations for the patents at issue. ID at 269.	Yes, but violation not based on SEP infringement
<i>Neology v. Kapsch</i> , Inv. No. 337-TA-979	July 24, 2017 – Initial Determination on Violation and Recommended Remedy (affirmed in pertinent part on review)	No infringement was found of a valid patent and therefore FRAND obligations were irrelevant to the ALJ's analysis. But the ALJ still noted that even if infringement of a valid patent were found, respondent had not proved	No

		that complainant had a FRAND obligation in the first place. ID at 263.	
<i>Fujifilm v. Sony</i> , Inv. No. 337-TA-1012	September 29, 2017 – Initial Determination on Violation and Recommended Remedy (not reviewed)	It was the respondent Sony's burden to show that the patents were essential to practice the standard. It did not do so. Because the asserted patents were not proven essential, the complainant Fujifilm did not breach any FRAND obligation by bringing the ITC suit seeking injunctive relief. ID at 364.	Yes, but violation not based on SEP infringement
<i>Netlist v. SK hynix</i> , Inv. No. 337-TA-1023	December 4, 2017 – Initial Determination on Violation and Recommended Remedy (affirmed in pertinent part on review)	No infringement was found. Until infringement of an SEP is found, any FRAND analysis is "purely hypothetical." ID at 183.	No
<i>Netlist v. SK hynix</i> , Inv. No. 337-TA-1089 (related to the 1023 investigation above) (complainant Netlist represented by Mintz)	November 4, 2019 – Initial Determination on Violation and Recommended Remedy (reversed not in pertinent part on review)	Infringement found and all SEP-related defenses denied. Respondent SK hynix did not meet its burden to prove that the complainant Netlist violated its FRAND terms. Additionally, the mere fact that an exclusion order will create a higher product cost is not dispositive of public interest such that a violation may be appropriate because the higher price could be easily mitigated by delaying the imposition of the exclusion order. ID at 180-81.	Yes, violation based on SEP infringement. Exclusion order to be delayed by 6-12 months to mitigate any public interest effect. On review, the Commission found no violation for reasons unrelated to SEP public policy or FRAND obligations (reversed on domestic industry). Parties settled while appealing reversal.
<i>INVT SPE v. Apple</i> , Inv. No. 337-TA-1138	March 9, 2020 – Initial Determination on Violation and Recommended Remedy (affirmed in pertinent part on review)	No infringement was found and even if infringement was found, no patent was standard-essential such that there were no FRAND obligations. ID at 179.	No
<i>Philips v. Thales</i> , Inv. No. 337-TA-1240	April 28, 2022 – Initial Determination on Violation and Recommended Remedy (affirmed in pertinent part on review)	No infringement was found, and separately, all SEP patents at issue were found unenforceable under implied waiver because complainant waited six years after the standard was enacted before it disclosed its SEPs and admitted that it was "waiting for a significant market to develop." ID at 267, 270-71, 317-19.	No Later, in its 4/15/2022 Recommendation for Remedy, the ALJ found that enforcing the SEPs would not go against public interest such that an exclusion order should issue in the case that the Commission reversed on infringement, which did not occur.

		But the ALJ also noted that the agreement with the SSO “does not require SEP holders to grant a license to other parties... [r]ather, a SEP holder must only stand ‘prepared to grant irrevocable license’ on FRAND terms and cannot actually enter a license unless both parties actually negotiate in good faith.” ID at 284-85. In this way, there is only an obligation to negotiate, not to grant licenses. ID at 284-87.	
<i>Ericsson v. Motorola Mobility</i> , Inv. No. 337-TA-1375	January 8, 2025 – Initial Determination on Violation and Recommended Remedy (pending review) <i>This determination only covers infringement finding. The ALJ’s ruling on public interest and FRAND issues are pending and expected in the Recommended Remedy, which was extended to April 4, 2025.</i>	Four SEPs found infringed. The ALJ did not analyze or discuss FRAND-related issues, including public interest findings. The ALJ will issue another initial determination on whether the public interest precludes a remedy, such as whether an exclusion order should issue.	Infringement found for SEP. Remedy not yet determined. Public interest ruling forthcoming (April 4).
<i>Nokia v. Amazon</i> , Inv. No. 337-TA-1379 <i>(related to the 1380 investigation above)</i>	February 10, 2025 – Initial Determination on Violation and Recommended Remedy (pending review)	Separately finding that infringement and all SEP-related defenses denied. Respondent Amazon did not meet its burden to prove that the complainant Nokia violated FRAND terms, held up Amazon, or breached its duty to disclose its SEPs.	Yes, violation based on SEP infringement. Pending Commission Review
<i>Nokia v. Amazon</i> , Inv. No. 337-TA-1380 <i>This is the Nokia v. Amazon case discussed in detail below.</i>	January 8, 2025 – Initial Determination on Violation and Recommended Remedy (pending review)	Infringement found and all SEP-related defenses denied. Respondent Amazon did not meet its burden to prove that the complainant Nokia violated FRAND terms, held up Amazon, or breached its duty to disclose its SEPs.	Yes, violation based on SEP infringement. Pending Commission Review

Notably, since 2012, the ITC has not once precluded issuing an exclusion order over concerns of issuing injunctions for SEPs or because of a FRAND violation defense.

Only once has the ITC found that a complainant violated its commitments to its SSO (*Certain UMTS and LTE Cellular Communication Modules and Products Containing the Same*, Inv. No. 337-TA-1240). There, the commitment was based on SEP disclosure requirements, which vary by SSOs, rather than FRAND obligations. The ALJ addressed the disclosure requirements under equitable affirmative defenses and found that because

the complainant, there Philips, did not timely disclose its essential patents, its SEPs at issue were unenforceable under implied waiver.^[11] But even in that case, the ALJ clarified that if the Commission did reverse its implied waiver finding and found infringement of the SEPs, the Commission should issue an exclusion order because the mere fact that the patents were SEPs did not in itself create a FRAND violation.^[12]

Also only once, in the same case, has the ITC found evidence of a complainant holding-up a willing licensee, *i.e.*, breaching its FRAND obligation by waiting until the standard was adopted before it was willing to license its SEPs to unfairly increase its bargaining power.^[13] Thus even though Ambassador Froman feared widespread hold-up based on the power of an injunction for an SEP, the data so far shows that hold-up is rare.

RECENT DEVELOPMENTS: ITC GRANTS SEP-BASED EXCLUSION ORDERS IN *NOKIA v. AMAZON*

One of the most recent ITC opinions regarding SEPs confirms the availability of injunctions. On January 8, 2025, in *Certain Video Capable Electronic Devices, Including Computers, Streaming Devices, Televisions, and Components and Modules Thereof*, Inv. No. 337-TA-1380, the ITC found that Amazon infringed Nokia's SEPs and recommended that the Board issue an injunction against Amazon products.

Complaints Nokia Technologies Oy and Nokia Corporation (Nokia) asserted five standard-essential patents for video compression technology against respondents [Amazon.com, Inc.](https://www.amazon.com) and Amazon.com Services LLC (Amazon). Despite lengthy license negotiations, Amazon did not take a license because it argued that Nokia's offers were not FRAND, *i.e.*, were not fair, were not reasonable, and/or were not non-discriminatory. Nokia then sued Amazon for patent infringement at the ITC.

In defense, Amazon raised the same arguments and several other SEP-related arguments, all of which were rejected by the ALJ. First, Amazon argued that Nokia's offers were discriminatory because actual licenses to other entities were more favorable than Nokia's license offers to Amazon. The ALJ disagreed, primarily because the preliminary offers are permitted to be non-FRAND—"apparently nothing about Nokia's current offer precludes Amazon from negotiating provisions similar to" licensed entities. The ALJ also reasoned that a respondent must show that the licensed entities were similarly situated in order to directly compare effective licensing rates and argue discrimination, which Amazon failed to do. One may question the viability of a discrimination defense given these hurdles, which seemingly both need to be overcome before a FRAND violation is found.^[14]

Second, Nokia argued that the license offers were not reasonable. The ALJ found that Amazon failed its burden of proof on the issue. The ALJ reasoned that many "sophisticated companies [] have repeatedly agreed to take a license to Nokia's [SEP] patents at an established rate," and that its offered rates had stayed constant despite variances in market acceptance of the standard. This undermined Amazon's hold-up arguments—that Nokia waited for greater market adoption before offering licenses for its SEPs. While the ITC has found that if a complainant has engaged in SEP hold-up, they may not obtain an injunction,^[15] the ALJ found the evidence lacking here. The ALJ also disagreed with Amazon that this market acceptance was simply an "illusion" created by Nokia's licensing of smaller companies who could not afford to challenge Nokia. It was just as likely, the ALJ said, that those companies agreed to license quickly due to smaller exposure, and there was no evidence from Amazon, who bore the burden, that larger companies failed to take a license because Nokia's offers were not FRAND.^[16] Amazon's last reasonableness argument hinged on patent pool^[17] rates being less than Nokia's offers to Amazon. Notably, the ALJ relied on ITC precedent to show that pool rates are generally not good data points for a bilateral negotiation (*i.e.*, a negotiation between one patent holder and one implementer, as the case here) because, among other reasons, pools are bulk licenses that do not differentiate between the strength of SEPs subject to a pool license.^[18]

Third, the ALJ dismissed Amazon's arguments that Nokia failed to negotiate in good faith because its offers were not FRAND. Like the ALJ's reasoning against Amazon's first set of arguments, the ALJ reiterated that only the last offer needs to be FRAND. Nokia is free to offer preliminary offers that are not FRAND so long as

the final agreed-upon license complies with FRAND terms. Because Nokia continued to attempt to license the asserted SEPs, the ALJ found that Nokia negotiated in good faith.^[19] Similar to FRAND defenses, as long as the complainant can demonstrate it is or was willing to engage in negotiations, it appears difficult for respondents to win these types of arguments at the ITC.

Lastly, the ALJ found that Amazon failed to show that Nokia breached any duty to disclose its patents as required by SSOs and thus denied Amazon's equitable estoppel and implied waiver arguments. The ALJ reasoned that a licensee that has made best efforts to file disclosure forms and has "indicat[ed] a willingness to license pertinent patents on RAND terms" has satisfied its obligations.

After denying all of Amazon's defenses, the ALJ concluded that Amazon should be enjoined from importing and selling the accused standard-essential products. Also, in a second, related case between the two parties, another ALJ analyzed Amazon's FRAND-related defenses, which were substantially the same as the arguments Amazon raised in the 1380 Investigation, and rejected all these defenses as well, for similar reasons.^[20]

TAKEAWAYS

Here are the most important takeaways for complainants based on the authors' review of ITC determinations since 2012:

Whether a FRAND violation has or has not occurred:

- Initial offers do not need to comply with FRAND obligations so long as the ultimate license does.^[21] However, a complainant should be clear in negotiation communications that it always remains interested in working toward a license.^[22]
- ALJs have held that at least according to some standards bylaws (g., ETSI's) complainants are not required to actually grant a FRAND license. Instead, they must only be willing to continue to negotiate for a FRAND license.^[23]
- Complainants should be aware of the effective rates for any other licenses for its SEPs at issue and prepare explanations for discounts or lack thereof based on licensee characteristics, like size, bargaining power, etc. Although the burden is on respondents to prove that the complainant violated FRAND principles, a prepared complainant should negotiate with the relevant data points in mind.^[24]
- Complainants should ensure that all disclosure duties are timely followed. Although courts and organizations do not clearly define "timely," a complainant should *not* wait for a market to form and/or for standards to be fully adopted before disclosing patents as "essential" to SSOs. Best practice would be at least, depending on the particular wording in the SSO's bylaws, to file statements of willingness to license SEPs on FRAND terms, use best efforts to include the list of patents and/or subject matter that may be standard-essential, and note where an interested licensee can reach out to inquire about negotiating a FRAND license.^[25]
- It is generally accepted that bilateral negotiations and resulting licenses will result in higher license rates than patent pool rates so the mere existence of lower pool rates than those demanded in a bilateral negotiation is not determinative of a FRAND violation.^[26]
- A respondent could be at risk of being found of engaging in "reverse hold-up." Evidence of reverse hold-up was found when a respondent was on notice that it needed to take a license to an essential patent but repeatedly claimed that the complainant failed to make a FRAND offer without having any evidence of what a FRAND offer may be. Thus, the ITC has been amenable to arguments that a respondent refused to take a license, compensate complainants, or "negotiate in a meaningful way" with a complainant.^[27]

Impact of FRAND-based affirmative defenses:

- A respondent must do more than allege that the complainant is precluded from getting injunctive relief (e., exclusion order) just because the patents at issue are SEPs.^[28]
- It is an open question whether or not a FRAND violation alone is a defense to infringement or whether additional facts are required to demonstrate an equitable defense applies, such as unclean hands, implied waiver, or equitable estoppel, or that the violation of FRAND/SEP obligation is contrary to statutory public interest factors (e., public health and welfare, competitive conditions in the US economy, production of competitive articles in the US, and US consumers) to such a degree that an injunction should not issue.^[29] Note that equitable defenses must be proven by clear and convincing evidence.^[30]

CONCLUSION

The ITC has repeatedly signaled it is willing to issue exclusion orders based on standard-essential patents. However, given the complications that arise in an SEP case that do not exist in an ordinary patent case, in order to succeed at the ITC, experienced counsel is a must.

Mintz has a nationally recognized ITC-focused practice group with extensive experience and success litigating across various industries at the ITC. Further, Mintz is highly familiar with SEP assertions and defenses, and represents several patent pools in monetization efforts, including enforcement. In fact, prior to the very recent *Nokia v. Amazon* cases, Mintz was the last firm to obtain an exclusion order ruling from an ALJ based on SEP infringement, and did so under the more difficult paradigm that existed when the 2013 DOJ and USPTO policy was still in effect.

For related reading, please see Mintz's article suggesting that the ITC address FRAND defenses early in the proceeding, within the 100-day "Pilot Program": <https://www.mintz.com/insights-center/viewpoints/2231/2022-05-09-itc-should-put-its-foot-down-patent-hold-out-and-hold> .

For further information, feel free to reach out to the authors via phone or email.

Footnotes

- ¹ *Certain Video Capable Electronic Devices, Including Computers, Streaming Devices, Televisions, and Components and Modules Thereof*, Inv. No. 337-TA-1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 180 (citing *Certain UMTS and LTE Cellular Communication Modules and Products Containing the Same*, Inv. No. 337-TA-1240, Recommendation on Remedy (May 9, 2022) at 19-20 (compiling investigation determinations)).
- ² The authors of this article are unaware of any ALJ or Commission determination or opinion substantively analyzing a FRAND-violation as a breach of contract defense. Instead, an ALJ implied that this breach of defense could be available in 2021. See Inv. No. 337-TA-1240, Order No. 11 (Sept. 29, 2021) at 4-5.
- ³ Inv. No. 337-TA-1380, Order No. 29 (Mar. 13, 2024) at 6; Inv. No. 337-TA-1240, Notice to Review Final Initial Determination (July 6, 2022) at 3; Inv. No. 337-TA-1240, Order No. 11 (Sept. 29, 2021) at 4-5.
- ⁴ Inv. No. 337-TA-1240, Recommendation on Remedy (May 9, 2022) at 19-20.
- ⁵ *Certain Electronic Devices, Including Wireless Communication Devices, Portable Music and Data Processing Devices, and Tablet Computers*, Inv. No. 337-TA-794, Commission Opinion on Section 337 Violation (July 5, 2013) at 1.
- ⁶ Inv. No. 337-TA-794, Commission Opinion on Section 337 Violation (July 5, 2013) at 46-50.
- ⁷ Inv. No. 337-TA-794, Commission Opinion on Section 337 Violation (July 5, 2013) at 1-3.
- ⁸ 794 Investigation Veto Letter from Ambassador Froman to ITC Chairman Williamson (Aug. 3, 2013), https://ustr.gov/sites/default/files/08032013%20Letter_1.PDF at 1-2; DOJ and USPTO Policy Statement (January 8, 2013), <https://www.justice.gov/atr/pagel/file/1118381/dl?inline=> at 4, 6, 7-8.

- 9 DOJ, NIST, and USPTO Policy Statement (Dec. 19, 2019), <https://www.justice.gov/atr/page/file/1228016/dl> at 3-4.
- 10 DOJ and USPTO Policy Statement (June 8, 2022), <https://www.uspto.gov/sites/default/files/documents/SEP2019-Withdrawal.pdf> at 1, n.1.
- 11 *Certain UMTS and LTE Cellular Communication Modules and Products Containing the Same*, Inv. No. 337-TA-1240, Initial Determination on Section 337 Violation (Apr. 28, 2022) at 267, 270-71, 317-19.
- 12 Inv. No. 337-TA-1240, Recommendation on Remedy (May 9, 2022) at 19-20 (compiling investigation determinations).
- 13 Inv. No. 337-TA-1240, Initial Determination on Section 337 Violation (Apr. 28, 2022) at 267-68, 272 (analyzing hold-up case law as part of the ALJ's implied waiver reasoning).
- 14 Inv. No. 337-TA-1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 142-43.
- 15 Inv. No. 337-TA-1240, Initial Determination on Section 337 Violation (Apr. 28, 2022) at 267-68, 272 (citing *Qualcomm Inc. v. Broadcom Corp.*, 548 F.3d 1004, 1021-22 (Fed. Cir. 2008) and *Core Wireless Licensing S.A.R.L. v. Apple Inc.*, 899 F.3d 1356, 1367-68 (Fed. Cir. 2018)) (finding that the complainant improperly waited for the market to develop and for the standard to be adopted before disclosing its essential patents such that its SEPs were unenforceable under implied waiver). The authors of this article are unable to find another example of the ITC finding that a complainant held-up a willing licensee.
- 16 Inv. No. 337-TA-1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 144-45.
- 17 Patent pools offer a standards implementer a license to multiple SEPs from multiple complainants under one rate, avoiding the need to individually negotiate per-patent or per-patentee licenses.
- 18 Inv. No. 337-TA-1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 145-46.
- 19 Inv. No. 337-TA-1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 146, 149-50.
- 20 *Certain Video Capable Electronic Devices, Including Computers, Streaming Devices, Televisions, and Components and Modules Thereof*, Inv. No. 337-TA-1379, Initial Determination on Section 337 Violation (Feb. 10, 2025) at 102-117.
- 21 Inv. No. 337-TA-1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 146.
- 22 Inv. No. 337-TA-1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 149-153.
- 23 Inv. No. 337-TA-1240, Initial Determination on Section 337 Violation (Apr. 28, 2022) at 284-285.
- 24 Inv. No. 337-TA-1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 142-43.
- 25 Inv. No. 337-TA-1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 150-153.
- 26 Inv. No. 337-TA-1379, Initial Determination on Section 337 Violation (Feb. 10, 2025) at 104-05; Inv. No. 1380, Initial Determination on Section 337 Violation (Jan. 8, 2025) at 145-46.
- 27 *Certain 3G Mobile Handsets and Components Thereof*, Inv. No. 337-TA-613, Initial Determination on Section 337 Violation on Remand (May 8, 2015) at 51-53.
- 28 Inv. No. 337-TA-794, Commission Opinion on Section 337 Violation (July 5, 2013) at 44, 48, 62; *Certain Audiovisual Components and Products Containing the Same*, Inv. No. 337-TA-1240, Initial Determination on Section 337 Violation (Aug. 13, 2013) at 333, 360.
- 29 Inv. No. 337-TA-1240, Recommendation on Remedy (May 9, 2022) at 19-20, 30 (ALJ finding that the complainant did not offer a license on FRAND terms with respect to some of the respondents because it did not provide evidence that it did but still including those respondents in the recommendation for an exclusion order should the Commission find infringement and no implied waiver). Although past ITC cases mention the possibility for alleged FRAND violations to be analyzed as a breach of contract, all determinations found and listed in the table above analyze FRAND and SEP related defenses as either under public interest analysis (i.e., showing that the violation is contrary to statutory public interest factors) or under equitable defenses (e.g., unclean hands, implied waiver, equitable estoppel). Respondents must prove additional elements on top of

showing a breach of a FRAND (or other SEP) obligation under both public interest analysis and equitable estoppel defenses.

- 30 *Certain Wireless Communication Devices, Portable Music and Data Processing Devices, Computers and Components Thereof*, Inv. No. 337-TA-745, Initial Determination on Section 337 Violation (May 16, 2012) at 147-48, 152.