

EIP

Success for EIP litigation team and client Optis against Apple

Last Friday, 16 October 2020, judgment was handed down by Mr Justice Birss in the High Court, London, in the first of four technical trials listed in EIP client Optis' UK patent litigation and long-standing licensing dispute against Apple. ^[1] Two non-technical trials focusing on licencing issues are also in the court's diary.

The four technical trials all concern patents from Optis' portfolio of standard essential patents. In this first test of the strength of that portfolio 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 (a process important in ensuring network coverage as mobile phone users move between locations).

The patent had previously been successfully asserted against Huawei and Samsung but had been subjected to new arguments from Apple who relied upon prior art that had not featured in that earlier litigation.

The trial was highly unusual in that it commenced on 5 October with closing argument finishing on the 13 October, yet the Judge produced his fully reasoned judgment, running to 214 paragraphs in less than three days. This was because the 818 patent expired on 20 October and a pre-trial hearing, the court had indicated that, were the patent to be found valid and essential, the Court would consider granting an injunction against Apple for the short, remaining life of the patent. In the event this did not prove necessary as shortly before judgment was handed down Apple undertook that, subject to certain the Court making additional findings at a subsequent trial scheduled for July 2021, and the Court determining that one or more Optis patents was valid and essential, Apple would enter into a FRAND licence as determined by the Court.

Gary Moss, EIP's Head of Litigation said: "Technical success at the first opportunity combined with the undertaking provided by Apple is a significant step forward in Optis' battle to secure proper compensation for Apple's use of its portfolio consistent with its ETSI undertakings. EIP is pleased to have been able to represent Optis in this matter and to help it achieve this early success in these proceedings and a step forward in the long running dispute."

Counsel acting for Optis were Adrian Speck Q.C., Mark Chacksfield Q.C. and Thomas Jones all of the Chambers of Mr James Mellor Q.C. 8 New Square, Lincolns Inn.

The EIP team on the technical case was Robert Lundie Smith, Joanne Welch, Jack Dickerson, David Brinck, Jerome Spaargaren, Sunny Bansal and Stephanie Harris.

The EIP team dealing with non-technical / injunction issues was Gary Moss, Kathleen Fox Murphy, and Catherine Howell.

Arty Rajendra of Osborne Clarke acted as co-Counsel on the case.

[1] Optis Cellular Technology LLC, Optis Wireless Technology LLC and Unwired Planet International Ltd v Apple Retail UK Ltd., Apple Distribution International Ltd and Apple Inc. (HP-2019-000006).