



Standard Essential Patents (SEP)

At a Glance

Standard Essential Patent (SEP) Litigation – Anything But “Standard”

SEPs are becoming increasingly crucial components of corporate patent portfolios and IP strategies. Munck Wilson Mandala attorneys are well versed in the issues that holders and implementers of SEPs need to know to fully protect their companies.

Trial By Fire Power

MWM’s distinguished nationwide intellectual property practice has unique expertise originating from a combination of high-tech knowledge and experience with exceptional trial skills.

Overview

Standard Essential Patent (SEP) litigation is anything but “standard,” especially when it comes to determining remedies for patents that must be licensed under fair, reasonable, and non-discriminatory (FRAND) terms. SEPs present thriving innovators unique opportunity – and challenges – in allowing the world to benefit from their cutting-edge innovations, constantly pushing the curve and competitive goal post of what technology can do. Core technology patents are a key component in open standardization, allowing SEP owners to disclose and share their technologies knowing that their innovations will be protected.

MWM attorneys provide highly skilled advocacy to ensure our clients receive a fair return on their R&D investment when another company uses their standardized technology that not only keeps them protected but allows them to continue to bring out new ideas, new standards, and new platforms allowing all to benefit. FRAND licensing has an established history of global market success by compensating innovative companies through patent royalties giving them the resources to reinvest in the next generation of technology and unlock the latest digital experiences for the masses to enjoy. Our attorneys work with clients to develop FRAND licensing agreements that maximize revenue while maintaining fair access to their technologies. We are dedicated to helping our clients build IP portfolios that bolster their businesses and empower them to continue growing and innovating new technologies.

MWM attorneys have extensive experience counseling companies that develop and defend against SEP assertions across the full spectrum of tech sectors. Successfully managing an IP portfolio is vital to creating and maintain a business’ niche within a market. Our attorneys work with corporations to manage all aspects of their patent portfolio strategy, including determining whether patents cover standard essential technologies, pursuing global filing strategies, and aligning prosecution strategy with standard submissions strategy.

Our attorneys are renowned for our expertise defending companies – from startups to Fortune 50 corporations – against companies asserting SEPs around the globe in high-stakes, multinational litigation involving patents, FRAND licensing, and competition issues. We collaborate and work with several global networks that keeps us well positioned to support our clients who operate in increasingly international, innovative and competitive environments. We provide knowledgeable counsel concerning ETSI (European Telecommunications Standards Institute) standardization activities for Information and Communication Technologies (ICT) across various sectors including those in key global technologies such as GSM™, TETRA, 3G, 4G, 5G, DECT™.

With more than 40 registered patent attorneys, we have one of the strongest patent prosecution teams in the southern United States with offices coast-to-coast. We are privileged to represent some of the world's largest technology companies, as well as to offer the same exceptional service, creativity, and commitment to entrepreneurs and emerging businesses. Our highly regarded intellectual property law team has wide-ranging technical backgrounds. Because we understand your technology and business, we are better equipped to protect the innovations that support your business objectives and to work directly with your scientists, programmers, and engineers in their areas of expertise. Our attorneys' understanding of your industry allows us to work with you to identify innovations in your products and processes, and to create accurate patent applications to give your inventions the best legal protection possible.

Our Services Include:

Global Patent Filing + Portfolio Management

MWM works with corporations that develop SEPs to pursue coordinated global patent filing strategies designed to build the strongest SEP portfolios possible. Our goal is to develop a patent portfolio that strengthens our client's negotiating position while also establishing a strong defense. We effectively manage the proper disclosure of their IP rights to the relevant SSOs, interpreting each agency's policies and ensuring compliance. Our attorneys continuously monitor our clients' SEP portfolios for further infringement, invalidity, and essentiality issues.

SEP + FRAND Licensing Strategies

Licensing SEPs on FRAND terms is a critical issue for SEP owners, and one that can potentially expose them to serious litigation risk. MWM attorneys are well versed in the fluidity of FRAND licensing allowing us to provide valuable insight into the valuation of SEP portfolios, determination whether they are required to license to and from competitors, what the proper royalty base for licensing SEP technology should be, what the proper bounds of a FRAND license are, and how to arrive at the right FRAND agreement to avoid litigation.

SEP + FRAND Litigation

Our attorneys have extensive experience handling SEP and FRAND disputes in district court and the International Trade Commission (ITC), including handling pre-suit investigation and diligence, developing infringement/non-infringement theories based on various standards, conducting forensic analysis of standards development in support of validity, inventorship, and related theories, as well as developing and combatting invalidity theories. MWM attorneys are skilled beyond patent litigation and regularly counsel clients on non-patent claims relating to antitrust, and other competition-based claims that intersect with many SEP and FRAND matters. We are also able to coordinate our clients' litigation strategies with inter partes review (IPR) strategies.

Arbitration

As standardization and interoperability requirements are impacting more once-disparate industries, arbitration is increasingly being used to settle SEP and FRAND disputes. MWM attorneys expertly represent our clients in arbitration related to SEP and FRAND issues, from selecting highly skilled arbitrators to negotiating a wide range of issues, including choice of law, the scope of the issues to be arbitrated, and the forms of relief to be granted.