



Regional Court Munich I

21 O 9333/19

Order of 11 July 2019

Operative Part

1. Under penalty of a fine to be determined, but not exceeding EUR 250,000.00 for each case

of contravention - or in the alternative detention - or detention for up to six months, in case

of repeated contravention for up to a total of two years, with said fine to be enforced against

a member of Respondent's Board of Directors, Respondentis

ordered to refrain

from applying for an anti-suit injunction, which is intended directly or indirectly to prohibit

Applicants to pursue one or more of the following patent infringement proceedings in Germany, namely

1. Regional Court of Munich I, docket no. 21 O 3889/19;
2. Regional Court of Munich I, docket no. 21 O 3891/19;
3. Regional Court of Munich I, docket no. 7 O 3890/19;
4. Regional Court of Düsseldorf, docket no. 4a O 27/19;
5. Regional Court of Düsseldorf, docket no. 4a O 26/19;
6. Regional Court of Düsseldorf, docket no. 4c O 17/19;
7. Regional Court of Mannheim, docket no. 2 O 37/39;



8. Regional Court of Mannheim; docket no. 20 36/19;
9. Regional Court of Mannheim, docket no. 2 O 35/19;
10. Regional Court of Mannheim, docket no. 2 O 34/19;

if this is done - as in the motion for an anti-suit injunction of 12 June 2019 in proceedings number 5:19-cv-02520-LHK, incoming file no. 32, before the United States District Court - Northern District of California (Exhibit R 4), with said undertaking to cease and desist also covering, in particular,

- the order to withdraw the motion for an anti-suit injunction of 12 June 2019 in proceedings number 5:19-cv-02520-LHK, incoming file no. 32, before the United States District Court - Northern District of California immediately upon service of this injunction order,
- the prohibition of further pursuing the anti-suit injunction proceedings, other than for the purpose of withdrawing the motion.

2. Respondent bears of the costs of the litigation.
3. The value in dispute is assessed at EUR 2,500,000.00.
4. To be served together with the order:

Statement of claim of 09 July 2019, together with exhibits

Grounds

I.

Applicants' motion for an injunction is addressing Respondent's attempts to make it more difficult for Applicants to continue several patent infringement suits in the Federal Republic of Germany by means of a so-called anti-suit injunction in the USA.



Applicants are part of a group of companies offering telecommunications services and related hardware and software products worldwide. Applicants are the proprietors of numerous property rights, inter alia in the field of mobile telecommunications.

Applicant to 1) is, in particular, registered proprietor of patents DE 60 240 446 C5, EP 1 671 505 B1, EP 2 087 626 B1, EP 1 273 199 B2, EP 1 929 826 B1, EP 2 087 629 B1 and EP 2 145 404 B1 (Set of Exhibits AR 1). Applicant 2) is, in particular, registered proprietor of patents EP 2 797 239 B1, EP 2 286 629 B2 and EP 2 981 103 B14 (Set of Exhibits R 1a).

Respondent is part of the R, which is organized under the parent company RA and is a globally operating group of companies primarily acting as a supplier to the automotive industry.

On 21 March 2019, Applicants filed a total of ten patent infringement suits against D before the Regional Courts of Munich I, Mannheim and Düsseldorf. These are pending before the Local Court of Munich I under docket numbers 21 O 3889/19 (= patent EP 2 797 239 B1), 21 O 3891/19 (= patent DE 60 240 446 C5) and 7 O 3890/19 (= patent EP 1 671 505 B1), before the Regional Court of Düsseldorf under docket numbers 4c O 17/19 (= patent EP 2 087 629 B1), 4a O 26/19 (= patent EP 2 087 626 B1) and 4a O 27/19 (= patent EP 1 929 826 B1) and before the Regional Court of Mannheim under docket numbers 2 O 34/19 (= patent EP 2 981 103 B1), 2 O 35/19 (= patent EP 2 286 629 B2), 2 O 36/19 (= patent EP 2 145 404 B1) and 2 O 37/19 (= patent EP 1 273 199 B2).

Two companies of the R have joined each of the above proceedings as interveners, namely RG and RK.

(see Set of Exhibits R 5b).

Subsequently, on 10 May 2019, Respondent filed a main action against Applicants in the United States District Court of the Northern District of California for possible infringements of FRAND obligations ("complaint for breach of FRAND commitments and violations of antitrust and unfair competition laws") (cf. Exhibit R 7).

As part of said proceedings, Respondent on 12 June 2019 requested issuing a so-called anti-suit injunction by way of an interim injunction ("motion") (cf. Exhibit R 4, with translation Exhibit R 4a).

The statement of claim of 12 June 2019 stated in particular:

"Plaintiff RI respectfully requests that this Court enjoin Defendants AS and AT, and any related entities (collectively "A") from prosecuting the patent infringement



actions filed in Germany against R's customer, D (the "German Actions"). The German Actions are more specifically identified as follows:

- A v. D, First Munich Regional Court, Patent Division, No 21 O 3889/19.
- AT v. D, First Munich Regional Court, Patent Division, No. 7 O 3890/19.
- AT v. D, First Munich Regional Court, Patent Division, No. 21 O 3891/19.
- AT v. D, Düsseldorf Regional Court, Patent Division, No. 4a 26/19.
- AT v. D, Düsseldorf Regional Court, Patent Division, No. 4a 27/19.
- AT v. D, Düsseldorf Regional Court, Patent Division, No. 4c 17/19.
- AT v. D, Mannheim Regional Court, Patent Division, No. 2 O 37/19.
- A v. D, Mannheim Regional Court, Patent Division, No. 2 O 36/19.
- A v. D, Mannheim Regional Court, Patent Division, No. 2 O 35/19.
- A v. D, Mannheim Regional Court,
Patent Division, No. 2 O 34/19.

In addition, R seeks an order enjoining Defendants from instituting against R or any of its customers (or their subsidiaries or affiliates) any action alleging infringement of their global 2G, 3G and 4G SEPs during the pendency of the FRAND proceeding in this Court, or from acting in concert with (sic!) anyone to institute such an action.

With regard to the translation, reference is made to Exhibit R 4a pp. 2 et seq.

Applicants have been given an opportunity by the US court to submit a statement on said motion for an anti-suit injunction by 24 July 2019. Subsequent to this, the US court may decide at any time on the application at its own discretion (see Exhibits R 11 and R 11a). Following Applicants' submission, the hearing has been preliminarily scheduled for 10 October 2019.

Applicants request, by way of preliminary injunction, that

under penalty of a fine to be determined, but not exceeding EUR 250,000.00 for each case of contravention - or in the alternative detention - or detention for up to six months, in case of repeated contravention for up to a total of two years, with said



fine to be enforced against the respective Chairman of the Board of Directors, Respondent is enjoined

to refrain from applying for an anti-suit injunction or any similar measure, which is intended directly or indirectly to prohibit Applicants, to further pursue one or more of the following patent infringement proceedings in Germany, namely

1. Regional Court of Munich I, docket no. 21 O 3889/19;
2. Regional Court of Munich I, docket no. 21 O 3891/19;
3. Regional Court of Munich I, docket no. 7 O 3890/19;
4. Regional Court of Düsseldorf, docket no. 4a O 27/19;
5. Regional Court of Düsseldorf, docket no. 4a O 26/19;
6. Regional Court of Düsseldorf, docket no. 4c O 17/19;
7. Regional Court of Mannheim, docket no. 2 O 37/39;
8. Regional Court of Mannheim; docket no. 2 O 36/19;
9. Regional Court of Mannheim, docket no. 2 O 35/19;
10. Regional Court of Mannheim, docket no. 2 O 34/19;

with said undertaking to cease and desist also covering, in particular,

- the obligation to withdraw the motion for an anti-suit injunction of 12 June 2019 in proceedings number 5:19-cv-02520-LHK, incoming file no. 32, before the United States District Court - Northern District of California within 24 hours from service of this injunction order,

- and the obligation not to further pursue the anti-suit injunction proceedings, other than for the purpose of withdrawing the motion with immediate effect.

With regard to the facts of the case, reference is also made to the statement of claim of 09 July 2019, together with exhibits.



II.

Applicants' motion proves to be admissible and has merit. Due to the particular urgency of the matter, as an exception, a decision by way of a court order was required without a prior hearing of Respondent (Section 937 (2) ZPO).

1. The motion proves to be admissible. In particular, the Regional Court of Munich | has international and local competence pursuant to Section 937 (1) in conjunction with Section 32 ZPO, as the place of effect of the act lies within the territory of the Federal Republic of Germany. Article 7 no. 2 of the Recast Brussels Regulation does not apply, since Respondent is domiciled in the USA and hence not in any Member State of the European Union.

If the anti-suit injunction sought by Respondent were issued, Applicants would at least be prevented indirectly from asserting their rights under the aforementioned patents within the territory of the Federal Republic of Germany without prejudice. The place of effect thus is Germany.

2. The motion also proves to have merit, as there is a claim and grounds for an injunction.

a) An injunction claim exists, as Applicants have a cease-and-desist claim against Respondent under Section 1004 (analogously) in conjunction with Section 823 (1) of the German Civil Code (BGB).

aa) If the anti-suit injunction sought by Respondent were issued, this would interfere with Applicants' protected legal interests. According to the generally accepted Opinion, patents are protected as other rights within the meaning of Section 823 (1) BGB (cf. e.g. MüKo-BGB, Section 823, para. 282). The Chamber is of the opinion that the motion for an anti-suit injunction does not already constitute an encroachment upon Applicants' protected rights. Rather, such encroachment lies only in issuing the anti-suit injunction as such, which, however, is sufficiently imminent, given the motion (cf. below on the danger of a first infringement).

Issuing the anti-suit injunction would indeed not directly prevent Applicants from further pursuing the aforementioned patent infringement proceedings in Germany. For it would have no effect in Germany, as it would not contain any content enforceable in Germany (cf. e.g. Higher Regional Court of Dusseldorf ZIP 1996, 294).



However, if the present patent infringement proceedings would be continued by Applicants after the anti-suit injunction had been issued, this would have far-reaching consequences for Applicants in the USA; in particular, they would stand to fear significant economic disadvantages. Hence there is at least an indirect prejudice.

bb) Such intervention is also unlawful. In principle, the intervention indicates the unlawfulness (cf. e.g. MüKo-BGB Section 1004, para. 198).

The unlawfulness also follows from the fact that the anti-suit injunction is intended to deprive Respondents of their right of action in Germany. This jeopardizes the rule of law and the proper course of justice, as this is guaranteed only if the parties involved are able to file the motions without any restriction, as necessary given the situation (Higher Regional Court of Düsseldorf, loc. cit., para. 31).

In addition, the unlawfulness is not eliminated by the fact that the motion for an anti-suit injunction is an admissible remedy in the USA and that the anti-suit injunction is an admissible measure under US case law. Only the legal systems of the Federal Republic of Germany and of the European Union, which do not know and indeed reject such a legal construct, are decisive for the assessment of the unlawfulness or lawfulness of an act.

cc) For the same reasons, there is also no obligation of Respondents to tolerate under Section 1004 (2) BGB (analogous).

dd) By filing for motion for the anti-suit injunction, Respondent created the concrete danger of unlawful encroachment upon Applicants' patent rights protected under Section 823 (1) BGB.

Applicants therefore do not need to wait for an initial unlawful prejudice by issuing the anti-suit injunction. Rather, there is a so-called danger of a first infringement, as such initial prejudice is sufficiently imminent. Issuing the anti-suit injunction can be expected at least from 24 July 2019. The decision here is at the discretion of the US court - by filing of the motion, Respondent has gotten the proceedings there underway.

ee) Respondent has furthermore created said danger of a first infringement by filing its motion for an anti-suit injunction; it thus is the tortfeasor and hence has standing to be sued as regards the injunction claim.



ff) The injunction claim here is also directed at active action on the part of Respondent, namely the withdrawal of the motion for the anti-suit injunction.

It is acknowledged that the tortfeasor may also be obliged under Section 1004 (1) sentence 2 BGB to act if the imminent prejudice can only be stopped by such active intervention (cf. e.g. Federal Court of Justice (BGH) NJW 2004, 1035 para. 14 with further references).

This is the situation in the present case. It is guaranteed by simply withdrawing the motion that the US court will no longer decide on the motion for an anti-suit injunction. If the motion were not withdrawn, it would fall exclusively within the jurisdiction of the court to issue a relevant order - even if Respondent does not take the corresponding procedural measures.

b) There is also a ground for injunction, as the matter is urgent and Applicants' interests in obtaining the preliminary injunction outweigh Respondent's interests.

aa) First, Applicants have shown through their conduct that the matter is urgent to them. In particular, within less than one month from becoming aware of the motion for an anti-suit injunction on 12 June 2019, they filed a motion for preliminary injunction - i.e. on 09 July 2019.

bb) Also, in the case at hand, as an exception, a decision by way of a court order pursuant to Section 937 (2) ZPO was required without a prior hearing of Respondent due to the particular urgency of the matter.

The principle of procedural equality of arms indeed requires that in judicial proceedings, it must be ensured that the opposing party is in principle heard before a decision is made and hence must be given the opportunity to exert influence on an impending judicial decision (Federal Constitutional Court (BVerfG), 3631 para. 15 with further references). However, in the special procedural situations of preliminary relief, a prior hearing is dispensable if it would frustrate the purpose of the proceedings, as in the attachment proceedings, in the ordering of pre-trial detention or in apartment searches (cf. BVerfG *loc. cit.*).

In the case at hand, the Chamber would have been able to schedule an oral hearing for 19 July 2019, at the earliest. Filing, execution and service of the judgment on Respondent thus would not have been ensured prior to the expiry of the deadline for Applicants' submission of statements on 24 July 2019 - however, from such date, the



US court would have been able to issue an anti-suit injunction. Applicants therefore ran the risk of losing their rights.

If Respondent had been heard, this would also have led to a corresponding delay. In addition, there would have been cause to fear that Respondent, knowing of the present injunction motion, would notify the US court of the present events in order to file for preliminary measures against the present injunction proceedings (cf. Exhibits R 11 and R 12). Applicants thus would also run the risk that their rights here would be thwarted.

After all, the situation is comparable to the example cases of the Federal Constitutional Court, and justifies issuing the preliminary injunction without prior hearing of Respondent. Their right to be heard is to be remedied in possible opposition proceedings.

cc) This weighing of interests also finds in Applicants' favor. In particular, Respondent, who is not involved in the patent infringement proceedings in the Federal Republic of Germany as either intervener or party, does not have any legitimate interest.

In this regard, it should also be borne in mind that the preliminary injunction (in contrast to the requested anti-suit injunction) is not intended to deprive Respondent of its rights to bring an action. The preliminary injunction is in fact not directed against the main proceedings pending in the USA (Exhibit R 7).

III.

The costs are borne in accordance with Section 91 ZPO.



KATHER · AUGENSTEIN
RECHTSANWÄLTE

Kather Augenstein Rechtsanwälte

Bahnstraße 16

40212 Düsseldorf

P: +49 211 5135360

E-Mail: augenstein@katheraugenstein.com / info@katheraugenstein.com