



KATHER · AUGENSTEIN
RECHTSANWÄLTE

HIGHER REGIONAL COURT MUNICH

6 U 5042/19

Judgement of 12.12.2019

[...]

Reasons

[...]

II

The respondent's appeal against the challenged judgment of the Regional Court Munich I of 30 August 2019 is admissible, in particular it was filed in due form and time (section 517 of the Code of Civil Procedure) and with due substantiation (section 520(2) of the Code of Civil Procedure). However, it is not successful on the merits. The judgement only had to be adapted to the amended application. The Regional Court's finding that an interference with the applicants' rights to their patents at issue, which was connected with the threatened issuing of an anti-suit injunction and for which the respondent was jointly responsible in tort, by prohibiting the continuation of the patent infringement proceedings pending in Germany against D. AG, is unlawful and, irrespective of the objections raised by the respondent against this, justifies the preventive injunctive relief pursued by the application for a preliminary injunction, is in any case free of legal errors in the result. In detail:

A)

The application for an injunction is admissible.

1.

The local and subject-matter jurisdiction of the Regional Court is no longer to be examined in the appellate instance (section 513 (2) Code of Civil Procedure). The international jurisdiction of the German courts results from the respondent's seat in Germany.



2.

The application for a preliminary injunction satisfies the requirement of specificity. Contrary to the view of the respondent, this also applies to the version of the request that was amended in the hearing before the Court.

The addition of "... an Anti-Suit Injunction or other equivalent measures such as a Temporary Restraining Order ..." takes into account the reservations expressed by the Court at the hearing regarding the specificity of the original version of the request insofar as it referred to "other equivalent measures" (§ 253 para. 2 no. 2 Code of Civil Procedure); the applicants explained in their submission of 6 November 2019 that the "Temporary Restraining Order" applied for by CAS in the US proceedings served to secure the anti-suit request and was thus to be regarded as an equivalent measure within the meaning of the amended application for an injunction.

The amendment of the application is also not precluded by a lack of urgency, as the "Temporary Restraining Order" was already covered by the term "other equivalent measures" in the request for an injunction dated 09.07.2019.

To the extent that the applicants further amended the request at the hearing by omitting the last two indents and instead including the words "... to enforce that Continental Automotive Systems Inc. does not file a motion as it did with the motion for relief ... before the Northern District of California United States Court" in the request, they have permissibly taken into account the fact that CAS anti-suit motion of 12 June 2019 is no longer the subject of proceedings in the USA.

3.

The request for a preliminary injunction also does not lack a legitimate interest in legal protection. The legitimate interest in legal protection as a general prerequisite for proceedings usually results from the non-fulfilment of the claim asserted by the applicant. It is lacking if the applicant can achieve its legal protection objective by simpler and cheaper means. The argument of the respondent that there is no legitimate interest in legal protection because the applicants are to be referred to defending themselves against the anti-suit motion in the context of the proceedings in the USA cannot be followed (see below under B.3).

B)



The respondent's appeal is also unsuccessful on the merits.

1.

The Regional Court took German law as a basis, which was not objected to by the appeal, so that no further comments are necessary in this respect.

2.

A judicial power comparable to Anglo-Saxon law to deny a party the power to institute proceedings does not exist under German procedural law (see Schulze, in *Wieczorek/Schütze*, Code of Civil Procedure, 4th ed., Vor § 50 Rn. 43, 44, § 51 Rn. 10). However, a substantive claim to refrain from initiating proceedings may arise from a prior contractual agreement (see also BGH, judgment of 17.10.2019 - III ZR 42/19); likewise, from the aspect of tort (Schulze loc. cit.; Schack, International Civil Procedure Law, marginal no. 859 et seq.), which the Regional Court assumed.

a)

The appeal also does not challenge the Regional Court's correct assessment that the issuance of the anti-suit injunction requested by CAS in the proceedings before the Northern District of California United States Court constituted a threatened encroachment on an absolute right of the applicants within the meaning of § 823 para. 1 in conjunction with § 1004 para. sentence Civil Code (whereby the respondent's view that there is no damage to the applicants in this respect is not valid because the asserted preventive injunctive relief does not presuppose such damage), namely in their property-like rights to the patents at issue in the proceedings. In this respect, the Regional Court correctly found that the interference with property within the meaning of § 1004 para. 1 sentence 1 of the German Civil Code could also occur in a way other than by depriving or withholding it, in the case in dispute namely by the fact that the applicants would be denied the right to use the patents in the case of an anti-suit injunction - just as in the case of a temporary restraining order, to assert their exclusive right to the patents-in-suit in the pending patent infringement litigation by continuing them in the direction of D. AG, in order to be able to enforce the desired claims in court in this way without having to wait for the outcome of the main proceedings in the USA.



The fact that CAS withdrew the motion for an anti-suit injunction after service of the order issued against it in the proceedings 21 O 9333/19 does not contradict the Regional Court's correct affirmation of a risk of initial infringement. As the renewed application of 8 October 2019 (Exhibit AR 44, AR 44a), which according to the applicants' submission, which remains undisputed in this respect, only conditionally does not relate to the patent infringement proceedings against D. AG that are at issue in Germany, shows, CAS has not refrained from its intention to continue to file corresponding applications.

b)

The Regional Court assumed that the threatened interference with the applicant's patent rights qualified as unlawful under the relevant German law (LGU, page 21 f. under c)). In doing so, it rightly relied on the fact that, according to the case law of the Federal Court of Justice (Urt. v. 13.3.1979 - VI ZR 177/77, concerning the liability of the person making the report) as well as the BVerfG (decision of 25.2.1987 - 1 BvR 1086/85 concerning the application for the submission of an affidavit), according to which the taking of legal action alone cannot indicate unlawfulness if the action subsequently turns out not to be objectively justified, unlawfulness does not already follow from the affirmation of a (threatened) violation. Following this, the Regional Court positively determined the unlawfulness of CAS's anti-suit request. In addition, it correctly pointed out that this case law, which refers to proceedings that are lawful according to the German legal understanding, cannot be inferred that every conduct/procedure that is permissible according to the law of a third state thus falls within the scope of this case law. Since the appeal does not raise any substantiated objections to this either, there is no need to elaborate further.

3.

The appeal cannot be followed in that it deduces from the inadmissibility of the anti-suit request that, according to these principles, the prohibition ordered by the Regional Court ("Anti-Anti-Suit Injunction") should not have been issued either.

To the extent that the Regional Court took the view that the respondent's objection that an anti-suit injunction, which the court had found to be unlawful, could not be countered by means of a prohibition on litigation ("anti-suit injunction") which at least indirectly affected the court proceedings in the USA, was not valid because such a prohibition would not be ordered with the granting of the preliminary injunction applied for by the



applicant, the Court, however, was not able to agree with this on the grounds given by the court of first instance.

a)

The approach of the Regional Court that the issuance of the preliminary injunction requested by the applicants is not accompanied by a prohibition of litigation against CAS with regard to the US court proceedings because the requested preliminary injunction does not affect the main proceedings there and, moreover, both the respondent and CAS are free to pursue the applicants with further lawsuits worldwide (LGU p. 20/21) cannot be accepted. It is true that the preliminary injunction does not have any - direct or immediate - influence on the main proceedings conducted by CAS against the applicants in the USA, which are aimed at licensing the Nokia patents on reasonable terms corresponding to FRAND. However, this does not change the fact that CAS, with the issuance of the preliminary injunction sought by the applicants, would be denied the right to file or pursue an application admissible under US law in the context of pending court proceedings. The differentiation made by the Regional Court - impermissible influence on the conduct of the main proceedings on licensing on the one hand, permissible prohibition of an application within the framework of the main proceedings on the other hand - cannot be followed. According to case law, the need for legal protection is not only lacking for actions directed against the conduct of the proceedings as such (BGH GRUR 2013, 647 para. 12 f. - Rechtsmissbräuchlicher Zuschlagsbeschluss; BGH GRUR 2005, 882 para. 23 - Unjustified IP warning I; BGH GRUR 2006, 219 para. 14 - Detection device II), but also for actions directed against other measures in the context of pending court proceedings (such as party submissions) (cf. the case law of the German Federal Court of Justice (BGH GRUR), 882 para. 23 - Unjustified IP warning I; BGH GRUR 2006, 219 para. 14 - Detection device II), but also for actions directed against other measures in the context of pending court proceedings (such as party submissions), see BGH GRUR 2018, 757 para. 16 - 18).

The application for an anti-suit injunction or a temporary restraining order are applications in the context of the licensing action filed in the USA in May 2019. They are intended to secure the temporal priority of the licensing proceedings in order to be able to pursue them "undisturbed" by the ten patent infringement proceedings pending in Germany. The fact that the "accompanying applications" are not independent proceedings, but require pending main proceedings, does not justify the assessment that the aforementioned case law only applies to the main proceedings, but not to



accompanying procedural applications in the form of an application for an anti-suit injunction or a temporary restraining order.

Nor can this be countered by the fact that German courts have in the past refused to serve an anti-suit injunction and deemed its enforcement inadmissible (see OLG Düsseldorf, decision of 10.01.1996 - 3 VA 11/95, Juris LS and para. 31, exhibit FDB 9). A possible incompatibility of the order of a foreign court with German law is to be assessed independently of the question whether a German court is precluded from influencing the power to file and pursue applications of a party to foreign court proceedings.

b)

The factual tortious interference with the applicants' patent rights associated with the issuance of an anti-suit injunction (which is threatened here and thus constitutes a preventive claim for injunctive relief within the meaning of Section 1004 of the German Civil Code) is unlawful in the specific case (see above under 2.b). The issuance of the preliminary injunction is also not precluded by a procedural privilege. The same applies to the Temporary Restraining Order in the sense of the application for an injunction.

aa)

The applicants see their application for a preliminary injunction (merely) as a defensive measure against an attack by the respondent in the form of an anti-suit injunction application, aimed at prohibiting the applicants from having patent infringements in Germany (further) examined by the ordinary courts in the context of ordinary proceedings. The preliminary injunction directed against the respondent was an exercise of a right of self-defence in favour of the applicants (§ 227 German Civil Code) in order to enforce their constitutionally secured legal position arising from their right to property and their claim to the safeguarding of justice against a judicial measure of CAS pursuing only destructive goals in the context of a main action filed in the USA, which was subsequent in time to the patent infringement actions pending in Germany. In this situation, the applicants must be free to continue their patent infringement actions in Germany without being disturbed and without having to wait for the outcome of the US main proceedings.

According to section 227, subsection 1 of the Civil Code, an act required by self-defence is not unlawful. Paragraph 2 defines self-defence as that defence which is necessary to ward off a present unlawful attack by oneself or another. If these factual requirements are met, the act of self-defence is lawful and does not give rise to any liability for damages. As already discussed in the meeting, this concerns actions that are taken



because it is not possible to take legal action due to the current unlawful attack. The extent to which this approach could therefore be used to justify the ordering of a prohibition of litigation that is inadmissible according to the above principles of case law therefore appears questionable.

bb)

However, this can be left aside. The procedural privilege developed by case-law, according to which the litigant cannot be prohibited from a certain procedural conduct, including the initiation of judicial/official proceedings, by way of an action/interlocutory injunction, is based on the assumption that the protection of the litigant is regularly guaranteed by the judicial proceedings in accordance with their legal form. Where this is not guaranteed, the unrestricted protection of legal interests must remain (BGH loc. cit., para. 21 with further references - Unjustified Warning of IP Rights I). This case law on the so-called procedural privilege concerns - as far as the Court can see - only cases involving procedural statements or acts in connection with domestic proceedings, i.e. the admissibility of a statement or other procedural act was reserved for examination in domestic judicial or official proceedings.

If this case law were to be applied to the present case, in which the admissibility and the merits of the application for an anti-suit injunction are examined exclusively under the relevant US law by the competent court in California, it would have to be required that the interests of the applicants in the continuation of the patent infringement proceedings are sufficiently protected. This cannot be assumed on the basis of the credible factual submissions.

According to these principles, the following applies:

(1)

When weighing the conflicting interests, the applicants' property-like right to their patents, which is protected by fundamental rights (in the form of the judicial enforceability of the exclusive right resulting from ownership against anyone, in particular against the potential patent infringer), is in dispute and takes precedence over the respondent's fundamental right to general freedom of action (Article 2 (1) of the Basic Law) and requires the issuance of the interim injunction applied for by the applicants, as the court of first instance correctly concluded. In this respect, the applicants correctly point out that the grant of an interim injunction is the only effective defence against an



anti-suit injunction, by means of which the applicants can be prevented from exercising their legal position as patent proprietors in the patent infringement proceedings pending in Germany until the conclusion of the US proceedings conducted between other parties, the subject matter of which is not identical to the infringement proceedings here. Even if, according to the respondent's submission, the main proceedings in the USA (licensing) are being conducted on the basis of a use of the applicants' patents, it is not shown or otherwise evident why the objection of licensing on FRAND terms cannot be asserted in the infringement proceedings in Germany already pending before the main proceedings in the USA, in which two C. group companies are involved as intervening parties.

(2)

The respondent cannot successfully argue against this that the applicants - who, by participating in the US market, have consciously subjected themselves to the legal system there and must therefore allow themselves to be held to it - have sufficient possibilities of legal defence, including an appeal, in the context of an anti-suit injunction application in the USA. The fact that the applicants are granted a hearing on the application for an anti-suit injunction and that they could appeal against its issuance does not prove that the rights of the applicants are sufficiently protected according to the above principles in the context of the proceedings concerning the application for an anti-suit injunction (likewise concerning the application for a temporary restraining order, which aims at an interim measure without prior hearing of the opponent). This results neither from the submission of the respondent - insofar as the respondent's pleading of 25 November 2019, which was not admitted, contains new factual submissions, these were no longer to be taken into account (§ 296a Code of Civil Procedure) - nor from the application submitted as exhibit AR 4. According to the understanding of the Court, the "protection" of the main proceedings is in the foreground of the examination. The effects of a prohibition of the continuation of the patent infringement proceedings pending in Germany, on the other hand, are obviously only the subject of the examination insofar as the concomitant contact with another foreign legal system can be regarded as "tolerable".

(3)

Furthermore, a lack of need for protection on the part of the applicants cannot be derived from the fact that, according to the case law of the Düsseldorf Higher Regional Court, an anti-suit injunction could not be declared enforceable in Germany. The applicants rightly



point out that in the event of a violation of an anti-suit injunction in the USA, they would have to expect a penalty to be imposed on them.

(4)

In this situation, the respondent's interest in filing an application for an anti-suit injunction that is permissible under US law must take a back seat. Nor can the respondent successfully argue that the applicants' application for a preliminary injunction would be contradictory in that, on the one hand, they would claim a right to defend against a potential prohibition on continuing their patent infringement proceedings in Germany and, on the other hand, they would overpower the respondent with a prohibition on conducting proceedings in the USA. For the above reasons, an exceptional case exists that justifies the issuance of an interim injunction as a mandatory defensive reaction to a possible anti-suit injunction (in the form of an "anti-anti-suit injunction").

4.

Contrary to the view of the respondent, the issuing of the interim injunction applied for by the applicant does not violate international law. Reference is made to the correct statements in the judgment of the Regional Court (LGU p. 27 et seq.). In particular, it should be noted that the preliminary injunction in implementation of the territorial principle merely serves to defend against threatened patent rights in Germany; any reflexive extraterritorial effects are legitimised by this, they do not constitute interference with the sovereign rights of the USA (see Maunz/Dürig, GG, 87th ed. 2019, Art. 25 marginal no. 50; Geimer, Internationales Zivilprozessrecht, 8th ed., Jurisdiction, marginal no. 399c). Moreover, according to Article 25 of the Basic Law, international law, as a "component of federal law", ranks below federal law. Since, for the above reasons under 3., the issuing of an interim injunction as carried out by the Regional Court is constitutionally legitimate, a contrary assessment by international law is also not justified in this respect (cf. BVerfG NJW 2016, 1295, margin no. 67 et seq.).

5.

Finally, the decision of the Regional Court does not violate European law. In this respect, as correctly assessed by the Regional Court, there is already a lack of cross-border intra-European facts. The applicants are taking action against the respondent for alleged



infringement of their patent rights in Germany in the form of unlawful interference with their exclusive right by threatening to obtain a stay of proceedings.

The judgment of the Federal Court of Justice of 17 October 2019 - III ZR 42/19 (Schadenersatz, Gerichtsstandsvereinbarung betreffend die Verpflichtung zum Schadenersatz bei vertragswriger Erhebung einer Hauptsache in den USA) referred to by the respondent does not support the respondent's assessment to the contrary. When the BGH refers to the case law of the ECJ, according to which court-ordered prohibitions of litigation are not compatible with the (former) Brussels Convention and the (current) Brussels Regulation, as they contradict the principle of mutual trust and the statutorily regulated jurisdiction provisions, according to which each of the courts in the European Union is granted the same expertise and an examination of the jurisdiction of a court by the court of another contracting or member state is not permitted, this does not apply precisely in relation to third countries, such as the USA (BGH loc. cit.loc. cit, para. 30 loc. cit.). Insofar as in the literature, following the case law of the ECJ, the opinion is expressed that with the rejection of the anti-suit injunction in the European area, the anti-anti-suit injunction should be settled at the same time (Mankowski, EWiR 555, 756 loc. cit.; ders., in Rauscher, European Civil Procedure and Conflict of Laws, 4th ed., preliminary remarks on Art. 4 para. 55), this assessment does not concern the present case constellation either.

6.

The respondent also has the right to bring an action.

a)

In principle, the person who has committed the act violating or impairing the legal interest as perpetrator or indirect perpetrator (cf. Palandt/Sprau loc. cit., § 823 marginal no. 76) is liable for a tortious act according to § 823 para. 1 Civil Code; likewise, the person who commits the act in question together with others (§ 830 para. 1 sentence 1 Civil Code).

b)

The applicants have presented sufficient circumstances for the involvement of the respondent, which the respondent has not - as required - substantiated.

aa)



The Regional Court stated that the respondent, the parent company of the Continental Group, was jointly and severally liable for the established tortious act giving rise to the preventive injunctive relief under § 1004 para. 1 in conjunction with § 823 para. 1 of the German Civil Code (Civil Code). In justification, the first instance judgement stated that CAS, with the knowledge and intention of the respondent, had not only filed the US main action, but also the application for an anti-suit injunction. This follows, above all, from the factual arguments established by the Regional Court and the conduct of the proceedings of the two group companies of the respondent that joined the patent infringement proceedings before the Regional Court of Düsseldorf, Case No. 4c O 17/19.

bb)

The Court agrees with this assessment.

The central issue in dispute, at which conditions the applicants are obliged to license their patents, is a question that not only affects the business area of individual group companies on the side of the respondent, as is also evident from the respondent's argumentation on the group-related examination of the FRAND requirement. In accordance with the importance of this issue, it is also apparent that the respondent filed the complaint with the EU Commission in January 2019 (Exhibit AR 6). According to the findings of the Regional Court, the main action in the USA was filed by CAS with the knowledge and intention of the respondent. That the respondent had positive knowledge of CAS' (first) filing of the anti-suit injunction application was admitted by the respondent (written statement of 13.08.2019, para. 10). The applicants' assertion that the respondent was involved in overarching decisions of the group and in overall strategic considerations, notwithstanding their submission that CAS acted on its own responsibility, was not contested by the applicants in any specific manner, but merely pointed out that the conclusion that all procedural acts and pleadings of CAS in the anti-suit proceedings were coordinated with the respondent cannot be drawn in a permissible manner. The respondent also did not deny that it had continuously provided CAS with information in the anti-suit proceedings (see the respondent's submission of 9 August 2019, para. 90, first indent).

Against this background, the Court considers it far-fetched that the decision to file the main action in the US was made by CAS in coordination with the respondent, but that the application for an anti-suit injunction was filed "on its own" with the aim of being able to conduct the main action "undisturbed" by the patent infringement proceedings



already pending in Germany. Since the underlying events and decision-making processes are naturally beyond the knowledge of the applicants, they satisfy their burden of proof if they provide sufficient evidence of joint coordination, as was the case, with the consequence that the respondent has a secondary burden of proof to assert that such coordination did not take place (see Federal Court of Justice BeckRS 2019, 12963 para. 47). The respondent did not comply with this, as it limited itself at first instance to criticising the applicant's submission in this regard as insufficient. Nothing to the contrary results from the decision BGH GRUR 2016, 1031 - Wärmetauscher referred to by the respondent. In this decision (para. 58), the Federal Court of Justice did not consider the fact that the second respondent was the parent company of the first respondent and that the parts supplied to the third respondent had a specific marking to be sufficient to establish liability, because the marking could also indicate the first respondent and this consequently did not justify attribution of the patent infringement, even taking into account the affiliation under company law. The facts of the present case are not comparable to this.

[...]