



Higher Regional Court Düsseldorf

I-2 U 27/21

Decision of 07 February 2022

Operative Part

I. Following the appeal, the decision of the 4c Civil Chamber of the Regional Court Düsseldorf dated 15 July 2021, is amended as follows:

1. the preliminary injunction issued by the 4c Civil Chamber of the Düsseldorf Regional Court on 14 December 2020 (docket no.: 4c O 73/20) is annulled.
2. the motion seeking its issuance is dismissed as inadmissible.

(...)

Grounds

I.

The injunction-plaintiff takes action against the injunction-defendants, which are companies of the Xiaomi Group with headquarters in China, by applying for a preliminary injunction with the aim of prohibiting them requesting for injunctions, in particular in China, in which they request to prohibit the plaintiff from asserting their patent rights in the main proceedings pending before the Düsseldorf Regional Court ("anti-suit injunction") or from enforcing any court decisions obtained in these proceedings ("anti-enforcement-injunction"), unless it is ensured that the plaintiff will be given the opportunity to be heard before the foreign court makes a ruling.



In the patent infringement proceedings pending before the Düsseldorf Regional Court (docket no.: 4c O 49/20 and 57/20), the plaintiff is asserting claims against the defendants on account of infringement of the German part of patents EP 2 ... 318 (hereinafter: EP '318) and EP 2 ... 245 (hereinafter: EP '245), which the plaintiff claims are essential for the H.265/MPEG-H High Efficiency Video Coding (HEVC) standard.

There are no main proceedings pending by the defendants against the plaintiff to determine a FRAND license for the use of EP '318 or EP '245 in a jurisdiction that is familiar with the legal institutions of anti-suit injunction or anti-enforcement injunction, such as China. Neither have the defendants applied for an anti-suit injunction or an anti-enforcement injunction against the plaintiff in China or any other country.

In their written statement dated 11 December 2020, the plaintiff filed a request for a preliminary injunction, which the Regional Court issued on 14 December 2020 by way of order.

Upon objection of the defendant, the Regional Court upheld the preliminary injunction by judgment of 15 July 2021 in a modified form compared to the injunction ordered on 14 December 2020. The operative part of the preliminary injunction in the version of that judgment reads as follows:



„The defendants, ..., are prohibited from initiating and/or maintaining legal proceedings in the People's Republic of China in which a motion is made to prohibit the plaintiff from

a) asserting their patent rights in the Federal Republic of Germany against the defendants, in the main proceedings pending before the Board under the court docket no. 4c O 49/20 / 4c O 57/20,

b) from enforcing any court decisions which are obtained by the plaintiff in the injunction proceedings under I.1.a) above, against the defendants, if it is not ensured that the plaintiff will be given the opportunity to be heard in such proceedings before a decision is made.“

The defendants in the injunction challenge this with their appeal.

A further account of the facts of the case is dispensed pursuant to sections 540 para. 2, 313a para. 1 sentence 1, 542 para. 2 sentence 1 of the Code of Civil Procedure.

II.

The admissible appeal of the defendant is successful. The preliminary injunction is to be annulled because the request for its issuance is inadmissible.

1.

The plaintiff lacks the legitimate interest in the issuance of the requested preliminary injunction.



The Senate agrees in essence with the opinion of the Munich courts, which consider an injunction aimed at prohibiting the motion for an anti-suit injunction (“anti-anti-suit injunction”) to be possible [see a)]. However, this applies on condition that both the general admissibility of such an injunction and the determination of its boundaries are questions of legitimate interest in legal protection and that an anti-anti-suit injunction can only be regarded at all and to the extent that it is objectively necessary to ensure effective legal protection of the patent proprietor before the German courts [see b)]. Such a legitimate interest must be denied in this case, in which no motion for the issuance of an anti-suit injunction has been filed and in which there are no substantial indications of an intention to that effect on the part of the defendant and in which there are not even any pending proceedings on the merits of the case by the defendant against the plaintiff for the injunction, for the protection of which an anti-suit injunction could be useful [see c)].

a)

The Higher Regional Court of Munich (judgment dated 12.12.2019, docket no.: 6 U 5042/19, GRUR 2020, 379) as well as the Regional Court of Munich I (judgment dated 02 October 2019, docket no.: 21 O 9333/19, BeckRS 2019, 25536; judgment dated 25 February 2021, docket no.: 7 O 14276/20, GRUR-RS 2021, 3995; judgment dated 24 June 2021, docket no. 7 O 36/21, GRUR-RS 2021, 17662) have considered the conduct of anti-suit injunction proceedings as an unlawful interference with the property-like rights of the owner of a standard-essential patent (hereinafter: SEP) who is subject to the foreign litigation prohibition and have ruled in the latter's favor, based on Secs. 1004 (1), 823 (1) of the German Civil Code, prohibiting the defendant from applying for an anti-suit injunction in another jurisdiction (in the



cases decided therein, the USA and China, respectively) or, if such proceedings have already been instituted, from pursuing them further.

The Regional Court Munich I in particular discusses the conditions under which such an anti-anti-suit injunction can be issued if the defendant has not yet applied for the issuance of an anti-suit injunction and situates the relevant question in the context of the 'risk of first occurrence' necessary for a preventive injunctive relief (GRUR-RS 2021, 3995 marginal no. 89 et seq., wherein the 'risk of first occurrence' is discussed in the context of the 'reason for the injunction' as the point in time relevant for the commencement of the 'period of urgency'; GRUR-RS 2021, 17662 marginal no. 33 et seq.) In the case decided by the Munich Higher Regional Court, a request for an anti-suit injunction filed in the USA (albeit later conditionally withdrawn) already existed, which is why the issue is only briefly addressed there, although also in the context of the risk of 'risk of first occurrence' (GRUR 2020, 379 marginal no. 56).

The Regional Court of Munich I states that previous rulings on the justification of a risk of first occurrence in the context of the risk of a request for and the issuance of a worldwide ban on legal action has to be developed further. According to the previous case law of the German Federal Court of Justice, the assumption of a risk of first occurrence requires serious and tangible indications that the defendant will behave unlawfully in the near future. This cannot be fully accepted in the case of threatened anti-suit injunctions, in particular if they are granted without reference to a judicial measure of the patent proprietor. Finally, FRAND cases are characterized by very particular circumstances which justify a different assessment of the risk of first occurrence, specifically its slight shifting forward in time



in favor of the patent proprietor. Therefore, a user of an SEP could be required not only to prove their willingness to license after obtaining the infringement notice, but also to declare in a binding manner that they will not file an anti-suit injunction against the patentee. If the patent user has not confirmed in text form within the short time limit set by the patent proprietor that they will not file a request for an anti-suit injunction, there is a risk of first occurrence. The constellation in question represents a group of cases which, in the future, will regularly justify the assumption of a first risk of first occurrence and thus the issuance of an anticipatory anti-anti-suit injunction (GRUR-RS 2021, 3995 marginal no. 90 et seq.; GRUR-RS 2021, 17662 marginal no. 34 et seq., see also the other groups of cases of risk of first occurrence developed by Regional Court Munich I).

It is not entirely clear whether, according to the case law of LG Munich I, the foreign proceedings on the merits of the FRAND license must be pending or whether it is possible to waive this requirement. Admittedly, the groups of cases assumed by Regional Court Munich I relating to a risk of first occurrence - in particular that of a lack of a "waiver" declaration by the patent user - do not necessarily require proceedings on the merits of the case; nonetheless, the pending action on the merits in the (potentially) issuing state of an anti-suit injunction plays a decisive role in the determination of a premature risk of first occurrence. Since all groups of cases are based on the actions of the patent user, the latter has it in their own hands not to allow a risk of first occurrence to arise in the first place or to eliminate it. This can also be reasonably expected from the patent user, since the requests for an anti-suit injunction that have become known so far were justified by the fact that a pending action on the merits of the case in the issuing state is to be protected. Such actions on the merits - aimed at the establishment of a



FRAND license agreement or an abstract determination of FRAND license conditions - are based on the argument that the patent user is willing to take a licence. If this is true, the patent user will also refrain from filing an anti-suit injunction, which they must confirm to the patent proprietor. If they refuse to do so, the assumption of a risk of first occurrence of the license is justified (GRUR-RS 2021, 3995 marginal no. 94; GRUR-RS 2021, 17662 marginal no. 37).

Whether, in view of these considerations, a shifting of the risk of first occurrence can also be assumed if, at the time of the request for an anti-suit injunction, there is not yet a pending action on the merits for a FRAND license (that is to be protected), has not yet been up for discussion, because in each of the aforementioned decisions, proceedings on the merits were in fact pending. If the foreign procedural law allows the request for an anti-suit injunction to be filed at the same time as the action on the merits, it would, however, be consistent with previous case law to allow an anti-anti-suit injunction without an action on the merits already being filed abroad.

b)

The Senate agrees with the general assumption that the initiation of proceedings directed towards the issuance of an anti-suit injunction constitutes an encroachment upon the absolute and even constitutionally protected rights of the patent proprietor and that legal protection must be granted against such action. However, both the admissibility in principle of a preliminary injunction directed against a foreign ban on litigation (anti-anti-suit injunction) and the determination of the the scope of such a countermeasure are not questions of substantive law, but rather the question of the legitimate interest in legal protection. In this respect, the Higher Regional Court of Munich (GRUR 2020, 379, marginal no. 59;



contrary to Regional Court of Munich I, BeckRS 2019, 25536, marginal no. 71 et seq.) has already accurately emphasized that an anti-anti-suit injunction constitutes a prohibition of litigation that is per se unfamiliar to German law, for the granting of which there is in principle already no legitimate interest in legal protection. However, such an injunction is to be granted (as an exception) if the ban on litigation imposed by an anti-suit injunction to the disadvantage of the patent proprietor is contrary to the principles of the rule of law and is therefore unacceptable. Constitutional reasons allow and require an anti-anti-suit injunction only to the extent that such a measure is objectively necessary to ensure effective legal protection for the patent proprietor. In the case of purely anticipatory requests, this is generally not the case.

In detail:

aa)

The issuance of an anti-anti-suit injunction is - within the limits to be discussed under bb)

- justified and appropriate on constitutional grounds.

(1)

From a constitutional point of view, everyone is generally free to seek judicial protection for their interests (Article 2 para. 1 of the Basic Law in conjunction with the principle of the rule of law), and an request by the opponent to prohibit such an action (prohibition of legal proceedings) therefore lacks the legitimate interest in legal protection.



(a)

This generally applies without exceptions to domestic German cases.

It is widely recognized that the unimpeded conduct of state-regulated proceedings should not be hindered any more than it is absolutely necessary in the interest of the parties involved, but also in the public interest (BGH, GRUR 2013, 305, 306 - Honorarkürzung). The judicial assertion of claims is privileged, i.e. legal defense even against unjustified claims must take place in the pending proceedings themselves, which at the same time represent sufficient protection for the challenged party (Ingerl/Rohnke, Markengesetz, 3rd ed., Vorb. zu §§ 14-19d marginal no. 418). The judicial examination of a claim, even an alleged one, cannot be prevented (BGH, GRUR 2005, 882, 884 - Unberechtigte Schutzrechtsverwarnung) and court-ordered prohibitions of litigation are therefore generally incompatible with German law (see also Schroeder, EuZW 2004, 468, 470; Becker, EWiR 2009, 265, 266). Due legal procedure can only be guaranteed if the parties involved can present to the court without any restriction all the facts which they consider necessary for the assessment and can file the motions which are necessary according to the state of the proceedings (Higher Regional Court Düsseldorf, decision of 10.01.1996, docket no.: 3 VA 11/95, BeckRS 1996, 940).

Against this background, the rulings of the Federal Court of Justice deny that there is a legitimate interest in legal protection where actions are aimed at the omission or elimination of statements that serve the purpose of assert rights in legal proceedings (BGH, GRUR 1998, 587, 589 - Bilanzanalyse Pro 7; GRUR 2010, 253, 254 - Fischdosendeckel; GRUR 2013, 305, 306 - Honorarkürzung; GRUR 2013, 647, 648 Rechtsmissbräuchlicher Zuschlagsbeschluss). This is based on the rationale



that the course of proceedings governed by the rule of law should not be influenced and its outcome should not be prejudiced by restricting a party's freedom to express their views in these proceedings through claims for injunctive relief or removal (BGH, GRUR 2010, 253, 254 - Fischdosendeckel; GRUR 2013, 305, 306 - Honorarkürzung; GRUR 2013, 647, 648 Rechtsmissbräuchlicher Zuschlagsbeschluss). The relevance of a claim or a defence is to be determined solely within the main proceedings, which are subject to their own rules (BGH, GRUR 2010, 253, 254 - Fischdosendeckel; GRUR 2013, 305, 306 - Honorarkürzung; GRUR 2013, 647, 648 - Rechtsmissbräuchlicher Zuschlagsbeschluss). The only consequence that can be associated with an unjustified legal action is, in principle, that of a dismissal of the action and the obligation to pay the costs of the proceedings.

(b)

Prohibitions on litigation are also not permissible within the European Union. They are incompatible with the principle of mutual trust underlying the Brussels Agreement (ECJ, EuZW 2004, 468, 469 - Turner/Grovit et al.; NJW 2009, 1655, 1656 - Allianz SpA ./ West Tankers Inc.; dec. dated 13 May 2015, docket no.: C-536/13, para. 13 at juris; MüKoZPO- Gottwald, 6th ed., Art. 29 Brussels Ia Regulation para. 28; Rauscher-Mankowski, Europäisches Zivilprozess- und Kollisionsrecht, 5th ed., preliminary note to Art. 4 para. 50; Becker, EWiR 2009, 265, 266).

c)

With regard to litigation, which is to be prohibited in non-European countries, it may be understood as an expression of our principle of the rule of law to generally not limit access to state courts for anyone (both in Germany and abroad). Whether this should exclude legal proceedings that are not carried out under the rule of



law, and whether in such cases - as an exception - a noteworthy interest in legal action should be denied, can remain unanswered. A specific measure (such as the request for an anti-suit injunction) does not at any rate deserve the label of not being in accordance with the rule of law merely because it is unfamiliar to German and/or European law.

(2)

Regarding SEP litigation, however, the issue is not the prohibition of the patent infringer from bringing an action before their home courts for a decision on FRAND licensing. Subject of the protective order of the German court is not the foreign licensing action of the infringing defendant, but only the accompanying ban on litigation for the SEP holder, the anti-suit injunction. Such a ban cannot be accepted, if only because, from the point of view of the rule of law, not only the infringing defendant must have free access to the courts chosen by them, but the SEP holder is of course entitled to the same right, and can accordingly assert institutional protection for its litigation in Germany (cf. Art. 47 EU Charter of Fundamental Rights). This applies all the more beyond considerations of the rule of law, as issued patents enjoy the unrestricted property protection of the Basic Law (BVerfG, Beschl. dated. 15 January 1974, docket no.: 1 BvL 5/70, BeckRS 1974, 104366 Rz. 21; Sachs, Grundgesetz, 9th ed, Art. 14, marginal no. 24) and the EU Charter (cf. Art. 17 (2) EU Charter of Fundamental Rights; also von der Groeben/Schwarze/Hatje-Wollenschläger, Europäisches Unionsrecht, 7th ed., Art. 17 GRC, marginal no. 39), and it is virtually a core element of the property protection that the property right holder can effectively enforce their patent prohibitive rights against third parties. For it is precisely in these rights that the actual value of the monopoly right associated with the grant of the patent is embodied. In this



respect, a judicial dimension is inherent in the protection of property rights to be granted by the state, which requires that a system of granting rights be provided that guarantees the owner (or other entitled party) effective patent enforcement by virtue of its personnel and material resources, its rules and regulations, and their request by the courts. The principle of the rule of law and the constitutional protection of property rights also require a defense against external interference in the patent infringement proceedings.

bb)

The fact that in principle an interest in legal protection for the patent proprietor's request to prohibit the patent user from instituting proceedings directed to the granting of an anti-suit injunction is to be recognized does not mean, however, that a need for legal protection can be affirmed without limitation. For reasons regarding the rule of law and the protection of property, in order to be justified, the issuance of an anti-anti-suit injunction must in fact be necessary for the granting of effective legal protection in favor of the patent proprietor.

(1)

In this regard, it must be taken into account that the protective order, should it become necessary due to the issuance of an anti-suit injunction, can be obtained by the patent proprietor by way of preliminary injunction - and thus at very short notice, if necessary even by way of order. In order to answer the question whether a protective order subsequent to the anti-suit injunction sufficiently protects the interests of the SEP proprietor or whether it is constitutionally required to already intervene in the run-up to an anti-suit injunction in order to avoid unreasonable



disadvantages for the SEP proprietor, two possible sequences of events must be taken into account:

(a)

It can happen that the injunction court accepts the court order contrary to its own anti-suit injunction for the protection of the patent infringement proceedings and complies with it by refraining from sanctions against the SEP proprietor who continues the infringement proceedings because of it. In this case, there is no need for an anticipatory prohibition of protection based on assumptions, because a protective order sufficiently securing the SEP proprietor in their legal prosecution can also be issued in good time after an anti-suit injunction has been issued.

(b)

If the injunction court cannot be prevented from sanctioning infringements of its prohibition to conduct proceedings by a protective order - which it considers to be foreign - the SEP holder will not gain anything from the fact that they have already been granted a protective order in anticipation of a merely feared anti-suit injunction. This is because the injunction court will disregard it in the same way as it would disregard such a protective order which is issued only after an anti-suit injunction and upon which the injunction court (at the request of the infringer) issues an anti-anti-suit injunction order and, based on this, sanctions the continuation of the infringement proceedings - despite the anti-anti-suit injunction issued in the meantime. Insofar as the ban on litigation is only waived upon request, an anticipatory protective order does, however, provide protection for the patent proprietor to the extent that filing a request in violation of the ban enables the possibility of punishment with the means of order under Section 890



of the German Code of Civil Procedure. Irrespective of whether every defendant in infringement proceedings can actually be prevented from filing a request for an anti-suit injunction, the suitability of the penalty cannot be denied, at least not in principle, to influence the infringing defendant, which means that the anticipatory protective order - under the special circumstances discussed - must be regarded as suitable in principle to ensure the unimpeded conduct of the patent infringement proceedings.

Although this being the case, it is important not to stop at these considerations, which solely reflect the interests of the patent proprietor. Rather, it must be kept in mind that in view of the large number of litigations arising from SEP, the request for and the issuance of an anti-suit injunction is the rare exception. This finding prohibits the issuance of a protective order without the existence of substantive evidence solely because of the purely abstract possibility for the infringing defendant to avail itself of it. For it is also an expression of the principle of the rule of law that the rights of another (here: the defendant) may only be interfered with if there is a reason justifying the state's intervention. And this occasion requires a situation which, in the overall consideration of all circumstances, permits the sufficiently certain conclusion that the request for an injunction interfering with the patent infringement proceedings is reasonably to be expected in the near future. Otherwise, the legal position of indeterminate patent users would be interfered with indiscriminately, which obviously contradicts the principle of proportionality. Under this principle, a fair balance is required between the legitimate concern of the SEP owner to be able to continue the patent infringement process undisturbed and the contrary interest of the defendant not to be



burdened with a protective order without sufficient cause on the basis of mere assumptions.

Waiting for tangible indications of the risk of an anti-suit injunction is all the more tolerable for the SEP owner, as any user of an SEP who obtains a ban on litigation against the SEP owner, which cuts off the latter's possibility of legal protection against this at the place of the infringement action, is to be regarded as apparently unwilling to license, with the consequence that they are to be ordered to cease and desist without further ado. A defendant who takes the aforementioned route therefore assumes a considerable litigation risk, which they will reasonably weigh carefully in advance. It may well be that SEP holders conducting business in China have to reckon with sanctions there which, for reasons of economic rationality, make it impossible for them to continue the German infringement proceedings, so that the lack of willingness to take risks associated with the enforcement of the foreign litigation prohibition by the infringing defendant cannot work in their favor. The legal protection provided to the SEP holder may be considered inadequate in view of this. However, said inadequacies are unrelated to the question of whether it is possible to intervene in anticipation of or in retrospect against a foreign litigation ban, but are simply a consequence of the realities arising from Chinese judicial practice.

(2)

In light of this, there is no objective necessity for a purely precautionary anti-anti-suit injunction if no anti-suit injunction has been sought or there are no indications that the patent user intends to do so - e.g. a serious threat - and if there are not proceedings on the merits pending between the parties in a jurisdiction that



provides for the legal institution of an anti-suit injunction. In such a case, the patent proprietor can and must be expected to await further conduct of the patent user, taking into account the considerations described under (1).

Contrary to the opinion of the Regional Court Munich I, it is also not a requirement for the user of an SEP that, after receipt of the infringement notice, they not only declare their willingness to license, but also confirm to the SEP owner that they will not request an anti-suit injunction. The answer to the question whether and under what precise conditions the lack of response to any inquiries can be taken into account when assessing the objective necessity of an anti-anti-suit injunction because the SEP user has certain duties (or obligations) to declare, does not require a substantial decision in the present case. In any case, it cannot be required of the SEP user and possible license seeker to declare without cause in response to a merely imputed inquiry whether they are willing to waive requests for an anti-suit injunction during the duration of the infringement proceedings. If a potential license seeker were to be required to answer such inquiries at all, it would at the very least have to be possible to establish concrete and reliable indications of their intention to make use of the anti-suit injunction remedy as soon as possible. The legal possibility of such motions in some jurisdictions does not in itself imply that the license seeker will make use of them.

c)

In this case, there is no objective necessity for the issuance of an anti-anti-suit injunction and thus no need for legal protection.

The request of the plaintiff was asserted purely as a precautionary measure, irrespective of concrete indications for the issuance of an anti-suit injunction or even



a corresponding request by the defendant, and is thus not necessary to ensure effective legal protection.

aa)

Not only was a ban on litigation neither issued nor applied for. There are furthermore no indications that the defendants intend to apply for an anti-suit injunction against the plaintiff. After all, there are not even proceedings on the merits for the protection of which such a remedy may be useful and helpful. Without such, it cannot be determined why - as assumed by the Regional Court - China of all places should be the jurisdiction in which the defendants could resort to the means of anti-suit injunction.

This assessment is not altered by the fact that in a single case (decision of the Intermediate People's Court of Hunan Province, City of Wuhan of 23 September 2020 in *Xiaomi v. InterDigital*, Exhibit ES 4) have successfully applied for an anti-suit injunction in China. In this regard, neither the explanations of the defendant regarding the previous, allegedly unfair conduct of InterDigital nor the arguments of the plaintiff regarding the central control of such decisions within a group of companies are relevant. The key issue is that the request in question was based on completely different circumstances. For example, an action on the merits by the applicants there (different companies of the Xiaomi group from the defendants) was already pending in China for the determination of a global FRAND rate at the time of the request by the defendants there (InterDigital) in India for a preliminary injunction and an unlimited injunction against Xiaomi for patent infringement (see Exhibit ES 4). Indications that the defendants in the injunction in the present case - without prior pendency of such an action on the merits - intend



to apply for the issuance of an anti-suit injunction against the plaintiff are not substantiated by this.

Insofar as the Regional Court based its decision on the fact that the corporate group of the defendant had already resorted to the legal construct of the anti-suit injunction several times in order to extensively protect their interests in China and thus bring other foreign legal proceedings to a standstill (see p. 18 of the judgment under appeal), this is not plausible. The decision of the British High Court of Justice of 26 October 2020 (submitted in English as Exhibit ES 7) is reproduced by the Regional Court to the effect that this decision prohibited Xiaomi from applying for an anti-suit injunction (anti-anti-suit injunction). The starting point underlying this decision was, among other things, the anti-suit injunction of 23 October 2020 in favor of Xiaomi against InterDigital, and it was concluded from this that Xiaomi had the potential inclination to file such a request in the (British) proceedings there as well.

Despite the difference in the date of the addressed decision Xiaomi ./ InterDigital (23.10.2020 instead of 23.09.2020), the British judgment clearly addresses one and the same request of Xiaomi group companies, which has already been discussed and which is also evaluated by the Regional Court as the first recourse of the Xiaomi group to the legal institution of the anti-suit injunction. Contrary to the Regional Court's opinion, the multiple use of this remedy by group-affiliated companies of the defendant cannot be concluded on this basis.

bb)



In view of this, it can remain unanswered whether motion for the order of an anti-suit injunction could be filed successfully at all without prior proceedings on the merits in China, or whether it would be possible to establish this sufficiently with the knowledge available in the proceedings for preliminary injunctions.

It is nevertheless certain that in the decisions of Chinese courts discussed by the parties, there was a main action for the protection of which the anti-suit injunction (Xiaomi v. InterDigital, Samsung v. Ericsson, Oppo v. Sharp) or anti-enforcement injunction (Huawei v. Conversant) was issued. The fact that this was not already pending before but was filed at the same time as the request for the issuance of an anti-suit injunction, is only alleged by the plaintiff in the Oppo ./ Sharp case (see the opinion of the Supreme People's Court dated 23 April 2021, Exhibit ES 19a). The exact chronological sequence, for example the question of whether the main action had been served before the anti-suit injunction was issued, cannot be ascertained from the submissions of the plaintiff. This is likewise not apparent from the submitted opinion of the Supreme People's Court, which, incidentally, contains only a brief summary of the case.

cc)

The plaintiff does not claim that the defendants threatened to file an anti-suit injunction or otherwise held out the prospect of doing so. Such cannot be inferred from the procedural conduct of the defendants, which is limited to a defense against the plaintiff's request and the representation of the legal opinion that they are not obligated to submit declarations. It is true that the defendants did not state clearly that they would not make use of the means of anti-suit injunction. However, this does not provide any evidence for the objective necessity of the



issuance of an anti-anti-suit injunction, because the defendants did not have to explain themselves without any reason in response to an - in any case non-existent - explicit request of the plaintiff for an injunction under the setting of a deadline or in response to the Regional Court's inquiry during the oral proceedings.

d)

The above statements apply mutatis mutandis to the order sought by the plaintiff prohibiting a request for the issuance of an anti-enforcement injunction. Moreover, such a prohibition is not objectively necessary a fortiori because, on the basis of the submissions of the injunction-plaintiff, it cannot be established that a judgment has already been issued in the main proceedings pending before the Regional Court of Düsseldorf (docket no.: 4c O 49/20 and 4c O 57/20), the enforcement of which could be prohibited by way of an anti-enforcement injunction.

2.

In view of the lack of an interest in legal protection, it can be left open whether the admissibility of the request is already precluded by the fact that the defendants are (only) to be prohibited from requesting an anti-suit injunction or anti-enforcement injunction "insofar as it is not ensured that the plaintiff is given the opportunity to be heard in such proceedings before a decision is made".

a)

It is entirely unclear whether the defendants can exert any significant influence at all on the Chinese court granting the plaintiff a hearing prior to an anti-suit injunction, or whether, if this is not the case, they are not being unreasonably



imposed by the court to do something that lies outside their sphere of influence. The plaintiff does also not explain in what way exactly the defendants could guarantee the granting of a hearing in anti-suit injunction proceedings. A mere right to file a motion would only be relevant in this context if the Chinese court had to comply with the motion by operation of law or if it could be expected, at least as a rule, that the Chinese court would regularly exercise its discretion in the conduct of the proceedings to the effect that it would follow the motion of the plaintiff. The submissions of the applicant do not relate to either of these.

b)

Insofar as the plaintiff emphasized at the hearing that its aim with the request for an injunction was to obtain knowledge of a pending anti-suit injunction request through the required time limit for taking a position and thereby to, in turn, be given the opportunity to apply for an anti-anti-suit injunction in advance, which they would be prevented from doing if and as soon as the foreign ban on litigation was in place, because the anti-suit injunction in China is or may be combined with a threat of punishment in case of defending oneself against the ban. This demand is not properly reflected in the request for the injunction in question. The correct wording of the request should have been that the defendants are prohibited from filing an anti-suit injunction request in China without first notifying the plaintiff in writing (if necessary, by observing a certain deadline). Ultimately, however, the inadequacies in the wording of the request are irrelevant, because a request to this effect cannot lead to success.

aa)



It is true that without the issuance of an anticipatory anti-suit injunction, a then necessarily subsequent request for the issuance of a protective order against the foreign litigation prohibition is required and that the prohibition to defend against the anti-suit injunction is violated in a sanctionable manner. However, the economic situation for the patent proprietor is not fundamentally different due to the fact that they obtain a protective order prior to the issuance of a litigation prohibition. There is no evidence whatsoever that a Chinese court will be deterred in any way from ordering and enforcing a litigation ban against the SEP proprietor by the anticipatory issuance of an anti-anti-suit injunction. On the contrary, life experience speaks in favor of the opposite. The SEP holder is therefore in no way protected by the anticipatory protective order of a German court from being subject to a litigation ban. If an anti-suit injunction - as claimed - is coupled with the prohibition to defend against it, it is inherent to the logic and consequence of such a measure that the sanction provided for an infringement in case of an anticipatory anti-anti-suit injunction is not simply dropped, but is linked to the obligation imposed on the patent proprietor by the subsequent anti-suit injunction to withdraw the anti-anti-suit injunction request. In the one case as well as in the other, the owner of the property right has to face the same disadvantages (sanctions) if they legally oppose a Chinese prohibition of litigation in Germany. In view of this economically completely identical sanctioning situation, the SEP holder has no advantage from an anticipated protective order and can therefore be expected to wait with the request for an anti-suit injunction until a litigation ban against them is actually in effect (or, as the case may be, is imminent).

bb)



Assuming that, despite the anticipatory protective injunction, a ban on litigation with the sanctioning consequences described above can only arise if the defendants file a request to that effect with the court, they are not subject to any restrictions (in particular those threatened with the imposition of disciplinary measures). For if the defendants have complied with their duty to notify, the preliminary protective order sought by the plaintiff does not prevent them from subsequently seeking a sanctionable anti-suit injunction.

As a result of the notification, however, the plaintiff is given the opportunity to apply for a protective order prohibiting the request for an anti-suit injunction before such injunction is issued. Even if the plaintiff succeeds in obtaining the anti-suit injunction in good time, so that the illegal operation of the litigation ban constitutes a punishable infringement, and even if the associated prospect of enforcement prevents the defendant from filing an anti-suit injunction request, the aspect already discussed above must be taken into account that the prohibition on filing a request, which is made subject to the condition of a duty to report, also represents an encroachment on the legal sphere of the defendants, which requires sufficient justification. This encroachment must not be indiscriminate and arbitrary either, but requires tangible indications that the defendant in the injunction poses a serious risk of a ban on conducting legal proceedings at the relevant time of the decision. Whether such indications can be of lesser weight than those circumstances which permit an immediate unconditional prohibition of the request can remain unanswered. In any case, the indications must not be exhausted by the consideration that the defendant has the fundamental possibility to file an anti-suit injunction request if - as it was the case in this case - there are



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no substantial further indications that the defendant will actually avail themselves of this possibility in the foreseeable future.

(...)

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