

Local Division Mannheim of the Unified Patent Court

UPC_CFI_445/2025

Order dated 27 May 2025

Applicants:

1. InterDigital VC Holdings, Inc, 200 Bellevue

Parkway, Suite 300, Wilmington, Delaware 19809, USA, legally represented by the Management Board, *ibid*,

2. Interdigital CE Patent Holdings SAS, 20 rue Rouget de Lisle, 92130 Issy-les-Moulineaux, France, legally represented by Richard

J. Brezski, *ibid*,

Represented by

Cordula Schumacher

Respondents:

1. The Walt Disney Company, 500 S

Buena Vista St, Burbank, CA 91521, USA, represented by its legal representatives, *ibid*,

2. Disney Platform Distribution, Inc., also operating under the name of Disney DTC LLC, 500 S Buena Vista St, Burbank, CA 91521, USA, represented by its legal representatives, *ibid*,

3. Disney Streaming Services LLC, 500 S Buena Vista St, Burbank, CA, 91521, USA, represented by its legal representatives, *ibid*,

4. Disney Media & Entertainment Distribution LLC, also operating under the name of Disney Entertainment Operations LLC,

500 S Buena Vista St, Burbank, CA,

91521, USA, represented by its legal representatives, *ibid*,



5. Disney Entertainment & Sports LLC, also operating under the name of Disney Streaming Technology LLC or Disney Technology LLC, 500 S Buena Vista St, Burbank, CA, 91521, USA, represented by its legal representatives, *ibid*,

6. BAMTech LLC, also operating under the name of BAMTech Media or Disney Streaming Services (LLC) or Disney Streaming, 1211 Avenue of the Americas, New York, New York 10036, USA, represented by its legal representatives, *ibid*,

Represented by

Taylor Wessing Partnerschaft von Rechtsanwälten und Steuerberatern mbB,
Isartorplatz 8, 80331 Munich

(...)

A. Brief description of the facts

The applicants apply for an anti-anti-suit injunction (AASI) against the respondents, which is to be issued *ex parte*.

The corporate groups of the applicants and the respondents are involved in global patent infringement disputes concerning the infringement of various patents of the applicants, which they are asserting against the corporate group of the respondents. The disputes are being conducted before the Court of First instance of the Unified Patent Court, in this case the local divisions in Mannheim and Düsseldorf. In addition, the parties are involved in disputes in the USA and in Brazil as well as before the Regional Court Munich I. The latter issued an AASI in a preliminary injunction dated May 19, 2025, which can be seen in Exhibit AR 1.

The respondents' group of companies has applied for an anti-suit injunction in the US state of California with regard to the proceedings conducted by the applicants' group of companies in Brazil. The motion filed with the US District Court for the Central District of California on 24 April 2025 seeks an order enjoining the applicants from enforcing any judgment issued by the Brazilian court in favor of the applicants and thereby shielding a RAND counterclaim filed in the US. The requested order reads as follows:



18 The Court, having considered Defendants' Motion and finding Defendants
19 satisfy the prongs of the relevant tests, hereby GRANTS the Motion and ORDERS
20 as follows:

21 In order to maintain the status quo during the pendency of this action,
22 InterDigital is preliminarily enjoined from enforcing any injunction awarded to it in
23 the Brazilian action until this Court resolves Defendants' RAND licensing
24 counterclaims and the parties exhaust all appeals of that resolution.

25 **IT IS SO ORDERED.**

26 Dated: _____
27 HON. WESLEY L. HSU
UNITED STATES DISTRICT JUDGE

A decision could be made in Brazil as early as June of this year. Furthermore, on 9 May 2025, the applicants applied for an AASI in the Brazilian proceedings, which is directed against this ASI. No decision has yet been made on this application for an AASI.

In the submitted (see AR 4) email correspondence dated 29 April 2025, the US counsel for the applicants requested the respondents to declare that they do not request an ASI against the proceedings before the UPC. The respondents responded to this after follow-up on 4 May 2025 by email and accused the applicants of violating their RAND obligations under the ITU Common Patent Policy by initiating proceedings before the UPC. The respondents were represented by a lawyer and respected the applicable rules. The applicants then contacted the respondents again by email on 7 May 2025, accusing them of giving evasive answers and demanding a clear response. There was no response by the time the application was filed. According to the applicants, a decision on the RAND counterclaim is not expected before September 2026.

The applicants argue that there is an immediate fear that the respondents will also apply for an ASI against the proceedings conducted before the UPC. This fear is claimed to be well-founded on the basis of the conduct described above. The conduct were to constitute an interference with the applicants' patent rights to be defended against by the AASI. Under US law, an ASI were accompanied by drastic measures, for example in the form of penalty payments, so that from then on it would be at least de facto impossible to pursue the proceedings before the UPC. The scope of protection of an assigned patent also were to



include its procedural enforceability in the local forum, which is to be secured by the requested injunction. Moreover, the application is claimed to be urgent and the balancing of interests were to end in favor of the applicants because the application would not entail any encroachment into foreign forums, but would only secure the conduct of proceedings in the local forum. The Local Division Mannheim is claimed to have international, factual and local jurisdiction. A prior hearing were not necessary because otherwise there would be a risk of legal protection being thwarted. The provision of security were not necessary in the present context.

Reference is made to the application and exhibits for further factual and legal substantiation.

B. Motions by the parties

The applicants request that the following interim measures be ordered:

- I. The respondents are each prohibited by way of interim measures, subject to a penalty payment for each violation, from

initiating and / or pursuing anti-suit injunction proceedings or seeking any other equivalent judicial or administrative measure, such as a temporary restraining order, to prevent and / or seeking to prevent the applicants from enforcing decisions of the UPC in patent infringement proceedings arising from patents under the jurisdiction of the UPC, in particular also if and to the extent that the applicants are and/o rare to be prevented from
 - enforcing judgments or measures issued against the respondents or the other defendants or affiliated group companies or other companies of the Disney Group in the patent infringement proceedings before the Local Division Mannheim relating to patents EP 2 465 265 and EP 3 259 902 and before the Local Division Düsseldorf relating to patents EP 2 080 349 and EP 2 449 782 ("anti-suit injunction");
 - the requirement to immediately withdraw any applications for an anti-suit injunction or to take other procedurally appropriate means to finally revoke such an anti-suit injunction with effect for the scope of the UPCA;
 - the immediate prohibition to continue any anti-suit injunction proceedings with effect for the scope of the UPCA other than for the purpose of withdrawing the application or making any other declaration for the purpose of final revocation with effect for the scope of the UPCA;
 - the prohibition to prohibit the applicants from enforcing decisions from patent infringement proceedings arising from their patents subject to the jurisdiction of the UPC



by means of a court or administrative order aimed at prohibiting the present proceedings, whereby the above prohibitions and restrictions also include exerting a corresponding influence on affiliated companies in whose name an application for an anti-suit injunction has been or could be filed, making full use of the options available under group law.

- II. In the event of any infringement of the order under item I., the respondents shall each pay to the court a (possibly repeated) penalty payment of up to € 250,000.00 for each day of infringement.
- III. The order is immediately enforceable without the provision of security.

C. Reasons for the order

The Local Division Mannheim of the Unified Patent Court has jurisdiction for the application for interim measures (see I.). The application is also well-founded (II.) and justifies the requested decision (see III.). This justifies the interim measures to the extent ordered.

I. Jurisdiction

The jurisdiction of the Local Division Mannheim of the Unified Patent Court for the request for interim measures against the respondents arises from Art. 31, 32(1)(c) UPCA in conjunction with Art. 7(2), Art. 71b No. 2 Regulation (EU) 1215/2012 and Art. 33(1)(a) UPCA. The place of success of the threatened interference with the applicants' patent rights lies within the jurisdiction of the UPC. The applicants would be prevented from enforcing their patents, which are subject to the exclusive jurisdiction of the UPC, before the Local Divisions of Mannheim and Düsseldorf in the infringement proceedings initiated, for which the Court has jurisdiction under Art. 32(1)(a) UPCA. An (imminent) infringement of a patent within the meaning of Art. 32(1)(a) UPCA is not only its unlawful use, but also the interference with the patent proprietor's property right by requesting a prohibition order to assert the patent right in the present common forum of the UPCA contracting states, which may also be the subject of urgent legal protection under Art. 32(1)(c) UPCA (see Local Division Munich, CFI_112/2025 (Nokia/Sunmi), esp. headnotes 2 and 3, CFI_755/2024 (Avago/Realtek), para. 30 and CFI_791/2024 (Huawei/Netgear), p. 10; Grabinski/W.Tilmann, in Tilmann/Plassmann, Unitary Patent, Unified Patent Court, 2nd ed., Art. 32 para. 61a). Therefore, jurisdiction arises from the point of view of ancillary jurisdiction in order to secure the claim for judicial protection with



regard to the infringement action falling under Art. 32(1)(a) UPCA. The devaluation of the applicants' patent rights is imminent in this district and also insofar as the proceedings before the Local Division Düsseldorf (CFI_297/2025 on EP 2 080 349 and CFI_87/2025 on EP 2 449 782) are concerned. Art. 33(1)(a) UPCA only requires an actual or threatened infringement in the Contracting Member State in order to establish the local jurisdiction of one of the local divisions established in that state (see Local Division Munich, CFI_112/2025 (Nokia/Sunmi), para. 24).

Lastly, the pursuit of a parallel application before the national courts at the Regional Court Munich I does not establish any other pendency of the same case, because the issue there is the assertion of other property rights in the national forum, which are to be shielded by an AASI.

II. On the merits

The application is also well-founded. The applicants are entitled to assert their patent rights in court proceedings in the forum here. This claim is inherent in the asserted patent because, in addition to its substantive assignment function, the patent also has inherent procedural enforceability (Mannheim Local Division, judgment of November 22, 2024, UPC_CFI_210/2023 para. 172 (Panasonic/Oppo)). The claim follows from the powers laid down in the Agreement and granted to the court to enforce patent law pursuant to Art. 62 et seqq. UPCA and thus from the Agreement itself, without recourse to national law being necessary (deviating in the dogmatic derivation Local Division Munich – German law: Local Division Munich, CFI_112/2025 (Nokia/Sunmi), para. 29 and Local Division Munich, CFI_791/2024 (Huawei/Netgear), page 11 on the bottom, or national law with regard to further bundle patent parts or as a common legal principle with regard to unitary patents) in conjunction with Art 47 EU Charter and Art 6 ECHR. The fact that the procedural enforceability of intellectual property rights is a central aspect of intellectual property rights is confirmed not least by Directive 2004/48/EC of the European Parliament and of the Council of April 29, 2004 on the enforcement of intellectual property rights (Enforcement Directive) in recitals 3 et seqq. and its Art. 3, 4(a), 9(1)(a), 11. The procedural enforceability of substantive patent law is thus also secured under European law. The powers to issue injunctions in Art. 62 et seq. UPCA serve to enable such enforceability.



The request is therefore admissible under Art. 62(1), (2) UPCA in conjunction with Rule 211(1), (2), (3) RoP.

Article 47(1) of the EU Charter also provides that any person whose rights or freedoms guaranteed by Union law have been violated has the right to an effective remedy before a court. Article 47(2) of the EU Charter gives everyone the right to have their case heard by an independent and impartial court previously established by law, in a fair hearing, in public and within a reasonable time. Art. 47 of the EU Charter therefore guarantees a general right to justice at European level, which also applies to the UPC in accordance with Art. 20 UPCA. According to Art. 17 (2) of the EU Charter, intellectual property constitutes in any case property-like rights, which are to be protected under the Charter. Consequently, Art. 47(1) and (2) EU Charter also protect a person's access to the UPC for the purpose of asserting an (alleged) unlawful use of a patent (also Local Division Munich (CFI_112/2025 (Nokia/Sunmi) (Panel 2); CFI_755/2024 (Avago/Realtek) (Panel 2); CFI_791/2024 (Huawei/Netgear) (Panel 1)).

This fundamental right to access to judicial proceedings and a final decision also follows from Art. 6 ECHR (ECtHR of February 18, 1999, NJW 1999, 1173 No. 50 – Waite and Kennedy v. Germany; ECtHR of March 19, 1997, ECR 97-II, p. 510 No. II40 = ÖJZ 1998, 236 – Hornsby v. Greece; ECtHR of March 1, 2002, 48778/99 No. 25, ECR 02-II – Kutiá v. Croatia).

These principles also form part of the *acquis communautaire* and are recognized by the European Court of Justice (ECJ, judgment of April 27, 2004 – C-159/02 Turner/Grovit and others, EuZW 2004, 468, 469; see also ECJ (Grand Chamber), judgment of February 10, 2009 – Case C-185/07 Allianz SpA v West Tankers Inc, SchiedsVZ 2009, 120, 121 et seq.) and thus bind the UPC as a common court of the Member States.

It is highly probable that the applicants entered in the register as proprietors are entitled to initiate the proceedings and that their rights under their patents are being infringed.

The applicants have also demonstrated with sufficient substance that there is a serious threat of infringement of their patent rights in the sense described above. The RAND counterclaim in the USA, the application for an ASI for Brazil for the purpose of shielding the RAND counterclaim and the present lack of a clear declaration to refrain from taking similar measures



with regard to the proceedings before the UPC, which are also considered to be contrary to RAND, provide concrete indications that the act of infringement in the form of an ASI application is imminent for the scope of the UPCA. This is because the specific response of the US legal representative of the respondents is too unclear in terms of its content to be interpreted as a clear declaration that they will refrain from taking actions. Moreover, the assessment must take into account the fact that the applicants criticized this lack of clarity and that the respondents nevertheless failed to provide clarification.

Urgency and weighing of interests

The issuance of the interim measure is objectively urgent. The application for an ASI, which is imminent according to the above, could be decided within a short period of time, so that the applicants cannot be referred to main proceedings on the merits.

The applicants did not wait with the request for interim measures in a manner prejudicial to urgency within the meaning of R. 211.4 RoP. Neither did they remain inactive for too long after becoming aware of the filing of the application with regard to the Brazilian proceedings, but instead immediately requested the opponents to submit a statement with regard to the proceedings conducted before the UPC, nor did they wait too long to file the application after their request for clarification after the unclear response from the respondents.

Furthermore, the weighing of interests to be carried out in accordance with Art. 62(2) UPCA, R. 211.3 RoP ends also in favour of the applicants. When weighing up the interests, the interests of the parties must be weighed against each other, taking into account the circumstances of the individual case. In particular, the damage that one of the parties could suffer from the issuance of the injunction or the rejection of the application must be taken into account (see Court of Appeal, order of September 25, 2024, UPC_CoA_182/2024, GRUR-RS 2024, 25707 para. 225). Against the background of the circumstances already discussed and the other circumstances of the dispute, this weighing of interests results in favour of the applicants. In this context, it must be taken into account that the present application is solely intended to secure in the international context of multinational disputes what – in the absence of relevant legal provisions on procedural coordination – corresponds to a requirement under international law: respect for the foreign forum to be able to exercise its judicial powers undisturbed within



the framework of the jurisdiction conferred on it, uninfluenced by foreign courts that have no jurisdiction in the matter.

It is also relevant in the present case that the UPC must help to enforce the primacy of European law in accordance with Art. 20 UPCA. This is only possible if the proceedings relating to a standard-essential patent are conducted in compliance with the EU antitrust law relevant to the present dispute within the meaning of Art. Art. 101, 102 TFEU and any questions requiring clarification can be referred to the European Court of Justice pursuant to Art. 267 TFEU. These questions also include whether the enforcement of the prohibition rights under the patent complies with EU antitrust law and whether parameters compatible with antitrust law were applied in the negotiations for a FRAND license – including in the calculation of its amount – and whether the conduct complies with the relevant requirements. If the court were prevented from conducting this review, this could result in courts that are not bound by EU law making determinations on (F)RAND licenses that cannot be legally valid in the legal area of the European Single Market and may be contrary to public policy.

Finally, the fact that the present injunction is of a purely defensive nature and is intended to shield the proceedings conducted before the UPC was a decisive factor in the weighing of interests. The respondents themselves are not prohibited from pursuing their patent rights in foreign forums, nor does it interfere with the jurisdiction of foreign courts.

This weighing of interests also justifies an order without prior hearing of the opposing party (R. 206.3, 209.(c), 212.1 RoP), since it has been credibly demonstrated that, without the issuance of an ex parte order, the applicants are under risk of irreparable harm due to the delay associated with the involvement of the opposing party, in that the latter will apply for an ASI or a similar measure in the foreign forum.

III. Legal consequences

The circumstances justify the interim measures to the extent ordered.

Injunction

The injunction is justified to the extent requested.



Against the background of the entirety of the application, the version of the application was to be understood to the effect that the application was not directed solely against an ASI that only and solely seeks to prevent the enforcement of a decision by the UPC. Rather, it follows from a reasonable overall view that the undisturbed conduct of proceedings before the UPC should be secured as a whole. This view is justified against the background of the ASI against the Brazilian proceedings cited to justify the risk of a first infringement, which is directed towards the prevention of the “enforcement” of any “injunction”. The adjudicating body is aware that corresponding injunctions in the Brazilian proceedings can also be issued during the ongoing main proceedings. This means that the facts cited to justify the risk of first infringement also relate to the conduct of the proceedings themselves and are not limited to the enforcement level.

Furthermore, there are no objections to the version of the application insofar as it extends to equivalent judicial or official measures, since in this respect it is not the formal designation of the judicial or official order as an "anti-suit injunction" that matters, but whether it has the same legal effect, even if the order has a different designation or is issued in a different procedural form.

Finally, the requirement to immediately withdraw any applications for an anti-suit injunction or to take other procedurally appropriate means to finally revoke such an anti-suit injunction with effect for the scope of the UPCA also constitutes a provisional and protective measure within the meaning of Art. 32(1)(c) UPCA, because this is to be issued for reasons of urgency in order to provisionally maintain the existing factual and legal situation until the conclusion of the main proceedings, the recognition of which can also be requested from the UPC in the main proceedings (cf. on the corresponding determination of the nature of provisional measures within the meaning of Art. 35 Brussels Ia Regulation: ECJ EuZW 1992, 447 para. 34 – Reichert II; EuZW 1999, 413 para. 37 – van Uden; EuZW 2005, 401 para. 13 – St. Paul Dairy).

Threat of a penalty payment

The threat of penalty payments has its basis in R. 354.3 RoP. This amount alone appears appropriate and sufficient as a deterrent against the background of the financially very extensive dispute at hand.



Provision of security

In the present case, the court does not refrain from ordering the provision of security, which is generally at its discretion.

Pursuant to Art. 62(5) in conjunction with Art. 60(7) UPCA, R. 211.5 RoP, the court may order the applicant to provide appropriate security for any appropriate compensation to be paid to the respondent for the damage likely to be suffered by the respondent in the event of the revocation of provisional measures by the court. In the case of an ex parte order, provision of security should generally be ordered, unless special circumstances indicate otherwise, R. 211.5 sentence 2 RoP. The effectiveness of the order for interim measures depends on the proper provision of security (R. 211.5 sentence 4 RoP). The provision of security takes into account the fact that, in the typical case of an asserted patent infringement, only a preliminary assessment of the patent infringement in particular in the sense of use of the protected inventive teaching takes place when the provisional measures are ordered, and it compensates for the fact that the respondent's legal position is already being affected on the basis of a provisional assessment, which is regularly reduced in terms of its substantive accuracy (see Local Division Düsseldorf, Order of October 31, 2024, UPC_CFI_368/2024, V.4 (p. 38)).

In the present case – unlike the case before the Local Division Munich in UPC_CFI_112/2025 (para. 64), which concerned a delivery during an ongoing trade fair – there are no special circumstances that would make the ordering of provision of security unnecessary. However, the respondents cannot suffer any significant damage as a result of the order for interim measures in the present context (see also Local Division Munich, order of February 19, 2025, CFI_112/2025, para. 64), which would exceed the legal costs of the present case, which are not significant in relation to the economic content of the overall dispute, which is why a low security deposit, which certainly covers the cost risk at the stated amount in dispute of € 2 million, is sufficient. The security amount must initially only cover the costs of the present proceedings, but not those of the main proceedings or an appeal, as further orders can then be made if necessary. After weighing up the interests involved, the applicants were granted immediate enforceability due to the particular urgency of preventing an ASI against them abroad, which, however, lapses if security is not provided within 20 days (see also Local Division Munich, order dated December 11, 2024, UPC_CFI_791/2024, p. 15).



Basic cost decision

A basic decision on the costs of the proceedings will not be made if the application for interim measures is successful. In this respect, the panel agrees with the opinion of the Local Division Düsseldorf (Order of October 31, 2024, UPC_CFI_368/2024, V.5 (p. 39)).

Subsequent main proceedings

Furthermore, pursuant to Rule 213.1 RoP, a deadline for initiating main proceedings on the merits had to be set. This is not at the discretion of the court (Local Division Munich, order of December 9, 2024, CFI_755/2024, para. 73 – Avago/Realtek; Local Division Munich, order of February 19, 2025, CFI_112/2025, para. 66). In this respect, a period of 31 calendar days or 20 working days, whichever is longer, from service of the order on the respondent appears appropriate. The applicants have not commented on such a deadline and have not included it in their applications.

D. Order

I. The respondents by way of an interim injunction are prohibited from

initiating and / or pursuing anti-suit injunction proceedings or seeking any other equivalent judicial or administrative measure, such as a temporary restraining order, to prevent and / or seeking to prevent the applicants from enforcing decisions of the UPC in patent infringement proceedings arising from patents under the jurisdiction of the UPC,

in particular also if and to the extent that the applicants are and/or are to be prevented from

- enforcing judgments or measures issued against the respondents or the other defendants or affiliated group companies or other companies of the Disney Group in the patent infringement proceedings before the Local Division in Mannheim relating to patents EP 2 465 265 and EP 3 259 902
- and before the Local Division in Düsseldorf relating to patents EP 2 080 349 and EP 2 449 782 ("anti-suit injunction");
- whereby this obligation to cease and desist also includes in particular



- the requirement to immediately withdraw any applications for an anti-suit injunction or to take other procedurally appropriate means to finally revoke such an anti-suit injunction with effect for the scope of the UPCA;
 - the immediate prohibition to continue any anti-suit injunction proceedings with effect for the scope of the UPCA other than for the purpose of withdrawing the application or making any other declaration for the purpose of final revocation with effect for the scope of the UPCA;
 - the prohibition to prohibit the applicants from enforcing decisions from patent infringement proceedings arising from their patents subject to the jurisdiction of the UPC by means of a court or administrative order aimed at prohibiting the present proceedings, whereby the above prohibitions and restrictions also include exerting a corresponding influence on affiliated companies in whose name an application for an anti-suit injunction has been or could be filed, making full use of the options available under group law.
- II. In the event of any infringement of the order under item I., the respondents shall each pay to the court a (possibly repeated) penalty payment of up to € 250,000.00 for each day of infringement.
- III. The order is initially enforceable without the provision of security. However, enforceability will end if the applicants have not provided security in the form of a deposit or bank guarantee in the amount € 400,000 in favour of the respondents within 20 days.
- IV. The interim measures ordered shall be revoked or otherwise suspended at the request of the respondents, without prejudice to any claims for damages, if the applicants do not initiate main proceedings on the merits before the Unified Patent Court within a period of 31 calendar days or 20 working days, whichever is longer, from the date of issue of the present order.
- V. In all other respects, the application is rejected.