

Hess, Felix K.

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US anti-suit injunctions and German anti-anti-suit injunctions in SEP disputes

Felix K. Hess

Faculty of Law, Goethe-Universität Frankfurt,
Frankfurt am Main, Germany

Correspondence

Felix Hess, Faculty of Law, Goethe-Universität Frankfurt am Main, Max-Horkheimer-Str. 2, Postfach EXC-12, D-60323 Frankfurt am Main, Germany.
Email: hess@jur.uni-frankfurt.de

Abstract

The essay argues that anti-suit injunctions granted in disputes on standard-essential patents are inconsistent with the general standards governing anti-suit injunctions. The section on anti-suit injunction demonstrates that the case law on anti-suit injunctions is not comparable to disputes over standard essential patents. In contrast, anti-anti-suit injunctions are a legitimate response to an extraterritorial assertion of jurisdiction by foreign courts. Under EU law, the courts of member states might even be required to issue anti-anti-suit injunctions to protect their exclusive jurisdiction over patents.

KEYWORDS

anti-anti-suit injunctions, anti-suit injunctions, FRAND, litigation, SEP, standards, telecommunications

1 | INTRODUCTION

Tech giants are taking their disputes over the licensing of standard essential patents ("SEPs") to courts around the world. At the heart of the disputes are the terms of global licences. The patentee must license its SEPs on fair, reasonable and nondiscriminatory ("FRAND") conditions. Courts in different jurisdictions have different opinions on which licensing terms are FRAND. Hence, both parties will fight tooth and nail to bring the dispute to the jurisdiction most favorable to them. To this end, they may try to enjoin each other from litigating in a foreign court by applying for an anti-suit injunction. Particularly noteworthy are cases in which both sides obtain anti-suit injunctions and the proceedings in both jurisdictions come to a halt. The surge of (anti-)anti-suit injunctions has left commentators wondering whether litigation on SEPs is spinning out of control. This essay aims to show why

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anti-suit injunctions granted by US courts in SEP disputes are inconsistent with the general standards governing anti-suit injunctions. Subsequently, the paper discusses German anti-anti-suit injunctions.

2 | SEP DISPUTES IN A NUTSHELL

To enable mobile phones, laptops, and other connected devices to work worldwide, telecommunications infrastructure and equipment must be interoperable. This is achieved by standards. Prominent standards, such as UMTS (3G) or LTE (4G), are set by Standard Setting Organizations ("SSOs"). For a patent to be recognized as a SEP, the patentee must commit to the respective SSO to license the SEP on FRAND terms ("FRAND Commitment"). Usually, implementers already use the standard during ongoing contract negotiations. Since SEPs are rarely licenced individually but in large portfolios, determining what is "fair and reasonable" may take several years. Possibly, the SEP owner fears that the implementer deliberately delays contract negotiations to pay less licence fees or because some patents are about to expire. It may then threaten injunctive relief to gain bargaining power. An injunction could lead to the implementer having to withdraw from the market. To avoid the injunction, the implementer would have to agree to adverse conditions.

As frequent injunctions would threaten the availability of standards, courts around the world agree that the enforcement of SEPs is subject to certain limitations. In particular, no injunction will be granted against implementers who are genuinely interested in and trying to reach an agreement on FRAND terms ("willing licensee," or in the opposite case, an "unwilling licensee").¹ Although courts agree on this point, the courts' views on what constitutes a willing licensee differ considerably. Courts in some jurisdictions regularly grant injunctions against implementers. In other jurisdictions, injunctions are generally not issued if the infringed patent is a SEP. For example, German courts are considered SEP owner friendly.² Injunctions are granted quicker and under lesser requirements than in other jurisdictions in major markets. In contrast, US courts will mostly deny the SEP owner injunctive relief, as the requirements for injunctive relief set out in *Ebay v MercExchange*³ are usually not met in SEP disputes.⁴

Since procedural and substantive law differ considerably, both parties aim to take the dispute to the jurisdiction most favorable to them. Global licences in conjunction with the territoriality of patents make up for forum shopping opportunities on both sides. SEP owners usually seek injunctive relief in jurisdictions whose courts are more inclined to grant an injunction. Implementers may try to counter the SEP owners' forum shopping. Courts in some jurisdictions accept that the FRAND Commitment constitutes a contract for the benefit of any willing licensee as third party (FRAND Obligation). This enables the implementer to bring an action for an alleged breach of the FRAND Obligation. Courts in China, England, and the United States may even determine the royalties of a worldwide licence upon request.⁵ However, the threat of an injunction on a relevant market could force the implementer to accept a global licence before the court has determined the FRAND rate. To avoid an injunction, the implementer may apply for an anti-suit injunction against the SEP owner.

3 | ANTI-SUIT INJUNCTIONS

Anti-suit injunctions enjoin the injunction defendant from initiating or pursuing proceedings abroad, or from enforcing a judgment. For lawyers with a civil law background, the need for anti-suit injunctions may be hard to understand. Civil law jurisdictions aim to prevent jurisdictional conflicts from the outset through exhaustive rules (e.g., Regulation (EU) No. 1215/2012, "Brussels Ia Regulation"). Unless a foreign court was seized first and the doctrine of *lis pendens* is applicable, a court with jurisdiction cannot stay its proceedings.⁶

Courts in common law jurisdictions generally exercise wider jurisdiction. To prevent parallel proceedings, courts are supposed to stay domestic proceedings if a foreign forum is more appropriate to hear the dispute. The common

law approach aims to ensure that the court with the closest connection to the dispute and the parties decides the case. However, it relies on the acceptance by courts of other jurisdictions.⁷ If a foreign court is less appropriate but does not stay its proceedings, courts may enjoin a party from litigating in the foreign court by granting an anti-suit injunction. Civil law jurisdictions may perceive anti-suit injunctions as a hostile intervention on their own jurisdiction. Although an anti-suit injunction may not be enforceable in a civil law jurisdiction,⁸ the defendant will usually comply with it. Otherwise, it would have to pay fines in the forum granting the injunction. Moreover, ignoring the order could expose the defendant to a default judgment on the merits.⁹

One effective way to protect a party affected by a foreign anti-suit injunction is to enjoin the other party from enforcing the order in the foreign jurisdiction or from applying for an anti-suit injunction. Such an order is called an anti-anti-suit or counter injunction. Anti-anti-suit injunctions were exclusively granted by courts in common law jurisdictions until 2019.¹⁰ Lately, courts in civil law jurisdictions started to issue anti-anti-suit injunctions in SEP disputes. So far, mainly practical concerns have been raised against (anti-)anti-suit injunctions in SEP disputes.¹¹ The main argument is as obvious as reasonable: If one party applies for an anti-suit injunction and the other party for an anti-anti-suit injunction, the case may not be heard at all.

4 | US ANTI-SUIT INJUNCTIONS

The circuits are split over the standards governing anti-suit injunctions. Most circuits argue that anti-suit injunctions potentially create political tension and should only be issued under the most compelling circumstances ("strict approach").¹² The Fifth, Seventh, and Ninth Circuits aim to protect litigants from vexatious and abusive foreign actions and will regularly restrain foreign parallel litigation ("lax approach").¹³ Both approaches name similar requirements which they interpret differently. This section provides a brief overview of the criteria courts in the United States consider and examines whether the criteria are met in SEP disputes. District courts have relied on the judgment rendered by the Courts of Appeals for the Ninth Circuit ("Court of Appeals") in *Microsoft v Motorola* in subsequent decisions.¹⁴ Hence, this essay focuses on the reasoning therein.

Before the general criteria for anti-suit injunctions are outlined, a brief summary of the facts of the case is helpful. During contract negotiations, the implementer, Microsoft, sued Motorola for an alleged violation of the FRAND Commitments which Motorola had given to two SSOs, the International Telecommunication Union (ITU) and the Institute of Electrical and Electronics Engineers (IEEE). Six months after legal action was initiated in the United States, Motorola brought an action for patent infringement in Germany against Microsoft. Subsequently, Microsoft applied for an anti-suit injunction to enjoin Motorola from enforcing a judgment obtained in Germany.

4.1 | Threshold criteria

Under both approaches, "[t]he threshold consideration for a foreign anti-suit injunction is whether or not the parties and the issues are the same [...] and whether or not the first [domestic] action is dispositive of the [foreign] action to be enjoined."¹⁵ In determining whether the parties are the same in the domestic and foreign proceedings, affiliated companies are generally considered as one party. Parties usually disagree on whether the foreign and domestic lawsuits concern the same issue. Courts applying the lax approach require both actions to be based on "the same underlying dispute."¹⁶ This neither requires both courts to apply the same substantive law, nor that domestic law provides a similar remedy or provision as available under foreign law. It may be sufficient that both proceedings arise from the same factual basis. This is supposedly the case in SEP disputes.

Other courts "choose to read 'dispositive' for what it means: to settle or finish the dispute."¹⁷ If the remedy available in the foreign forum is not available under the *lex fori*, the actions concern different issues. Under the latter definition, a foreign patent infringement action does not concern the same issue as a contractual action brought by

an implementer for an alleged breach of a SEP owner's FRAND Obligation. All circuits recognize that proceedings on different national patents regarding the same invention concern different issues.¹⁸ Put to the heart of the matter:

Foreign patents, despite covering precisely the same product as an American patent, present separate and independent rights [...]. Where patents are at issue, the subject matter is not the same.¹⁹

This does not apply to disputes which concern patents but are contractual in nature.²⁰ For instance, courts have granted anti-suit injunctions to enforce contractual agreements not to bring patent infringement actions abroad.²¹ Even courts applying the strict approach recognize that the foreign action concerns the same issue as the domestic action if the injunction defendant brought the foreign action in breach of a waiver, or an exclusive jurisdiction or arbitration agreement.²²

4.1.1 | Comparability of the FRAND Commitment and jurisdiction agreements

In *Microsoft v Motorola*, the Court of Appeals relied on case law concerning contractual agreements not to sue abroad and compared the FRAND Commitment to a jurisdiction agreement. According to the Court of Appeals, the SEP owner declares “not [to] take steps to keep would-be users from using the patented material, such as seeking an injunction” by undertaking the FRAND Commitment.²³

Similarly, a party consenting to a jurisdiction agreement “relinquishes any benefits that it might receive from statutory rights or favorable canons of contractual interpretation only available in other forums.”²⁴ In both cases, the anti-suit injunction would enforce contractual obligations. The ITU Licensing Declaration Form, which the Court of Appeals compared to a jurisdictional agreement, provides:

The Patent Holder is prepared to grant a license to an unrestricted number of applicants on a worldwide, non-discriminatory basis and on reasonable terms and conditions to make, use and sell implementations of the relevant ITU-T/ITU-R Recommendation. Negotiations are left to the parties concerned and are performed outside the ITU-T/ITU-R.²⁵

At first glance, the wording does not imply an obligation not to claim injunctive relief. However, the SEP owner shall offer a licence on FRAND terms to any implementer. An SEP owner who seeks injunctive relief at the first opportunity breaches this duty. In general, the purpose of SSOs is to develop widely available standards and to balance the interests of SEP owners and implementers. Implementers should be able to use the standard at a reasonable price, while SEP owners (or their legal successors) should be compensated and rewarded for their R&D efforts.²⁶ The Court of Appeals only took into account the implementers' interests and interpreted the licensing declaration as a unilateral waiver of the right to claim injunctive relief by the SEP owner.

Neither the wording nor the purpose of the declaration or the ITU Policy support this interpretation.²⁷ The SEP owner's obligation not to bring patent infringement actions is not unconditional. If SEP owners could not obtain injunctive relief, implementers would have little incentive to conclude a licence agreement. Hence, SEP owners are entitled to injunctive relief against unwilling licensees.²⁸

The Court of Appeals did not examine whether the injunction claimant, Microsoft, was a willing licensee. It stated that Motorola “may or may not have [...] breached its contract with the ITU.”²⁹ Thus, the Court of Appeals has neither considered the precise scope of the FRAND Obligation, nor whether Motorola had violated it by filing the German suit. To stick to the comparison of the FRAND Commitment with a choice of court agreement:

The court would have issued an anti-suit injunction to enforce a jurisdiction agreement whose scope and enforceability were uncertain.

Some courts have issued anti-suit injunctions to enforce jurisdiction agreements valid under US law and invalid under foreign law. There is no precedent in which a US court has granted an anti-suit injunction to enforce a jurisdiction agreement, of which it did not know whether it was valid and enforceable. In all cases, an obligation not to sue abroad likely existed and the injunction defendant had likely violated it.³⁰ Courts refused to grant anti-suit injunctions where it was uncertain whether the foreign claims fell inside the scope of the jurisdiction agreement.³¹

4.1.2 | Contractual umbrella

The second straw on which the court relied is a “contractual umbrella” of the Californian action.³² Even if Motorola did not breach its contract, the court would have had to determine a FRAND rate. If Microsoft had agreed to take a licence under the conditions set by the court, Motorola would not have been entitled to injunctive relief. Therefore, as in *Medtronic*,

the [injunction claimant] was not seeking to enjoin a party from litigating in a foreign court on the basis of a patent validity or infringement finding by a United States court but on the basis of a contract interpretation by a U.S. court.³³

In *Medtronic*, the agreement provided inter alia:

[Injunction defendant] agrees to and does hereby grant [injunction claimant] complete release and immunity from suit for any and all claims in law or in equity for damages, profits or any injunctive relief or relief of any kind resulting from the transfer [...].³⁴

However, the contract was ambiguous. Another paragraph suggested that the injunction defendant was entitled to injunctive relief under certain circumstances. Judge *Larson* provided a textbook example of contract interpretation. He ascertained “the intent of the parties and determine[d] the meaning of the language by looking to the circumstances surrounding the making of the contract and to the parties’ own subsequent interpretation of the agreement.”³⁵ No such interpretation of the words “non-discriminatory” and “reasonable terms and conditions” occurred in *Microsoft v Motorola* until the substantive proceedings. Besides, what Judge *Robart* did in the later FRAND trial to determine the royalties has little to do with contract interpretation in the traditional sense. He assessed the technical utility of different patent families and the extent to which Microsoft’s products utilized their respective functions.

The assessment seems closely related to that of the validity and infringement of patents. This classification would be consistent with the distinction of federal and state court jurisdiction in patent licensing disputes. Generally, as long as no rule provides for the jurisdiction of federal courts, state courts have subject-matter jurisdiction. One example for such rule is 28 USCA § 1338 (a), under which federal courts have exclusive jurisdiction for civil actions relating to patents. The purpose of the provision is to prevent conflicting decisions on patents. In some “contractual cases” federal courts had jurisdiction under 28 USCA § 1338 (a), because the contractual issues were interconnected with patent law.

However, not any breach of contract case involving patents establishes federal jurisdiction.³⁶ Patent law must be a substantial part of the claim. In *Jang v Boston Scientific Corp.*, the claimant had assigned two patents to the defendant. The defendant had agreed to pay an additional amount based on later sales of products “covered by” the assignment. Later, the claimant alleged that a product sold by the defendant fell inside the scope of the licensing agreement. The product would have been covered by the agreement if it infringed the assigned patent.³⁷ As the

complaint relied on the infringement of patents, the Court of Appeals confirmed federal jurisdiction over the contractual claim to avoid conflicting decisions.³⁸

In *Microsoft v Motorola*, Judge *Robart* examined the relevant patents and patent families in detail to determine the royalties. He concluded the technical value of six patent families to the H.264 Standard.³⁹ Invalid patents are likely not valuable or even essential. Determining the technical value of patent families, therefore, contains an implicit decision on patent validity. The court did not stop there and “examine[d] the importance of Motorola’s H.264 SEPs not only to the H.264 Standard itself, but also with respect to Microsoft’s products.”⁴⁰ As 14 out of the 16 H.264 SEPs in question contributed to a function called interlaced video, the court examined the extent to which Microsoft’s products utilized interlaced video. It found that for the most relevant products, Windows and the Xbox, there was hardly any use for interlaced video, as only minor functionalities, which most consumers did not use, supported the H.264 Standard. The Windows Phone did not support the H.264 Standard at all.⁴¹ In examining the importance and utility of the SEPs to Microsoft’s products, Judge *Robart* decided whether and to what extent Microsoft infringed Motorola’s SEPs. Under the above-mentioned principles on 28 USCA § 1338 (a), resolution of the contractual claim relied substantially on questions of patent law. Moreover, the court acknowledged that the 18 US patents on which it relied to calculate the royalty rate, have had many foreign counterparts essential to the H.264 Standard.⁴² That the assessment was limited exclusively to the US patents therefore seems hardly plausible. How can a court assess the utility of inventions protected by foreign patents without implicitly ruling on the foreign patents?⁴³

4.1.3 | Summary

Regardless of whether a national court has jurisdiction to adjudicate a global SEP portfolio, the Court of Appeals’ comparison with *Medtronic* and the case law on anti-suit injunctions enforcing jurisdiction agreements fails for two reasons. First, the court did not examine whether Motorola was more likely than not to have breached its FRAND Obligation, that is, whether Microsoft had a right not to be sued abroad.⁴⁴ Second, there is no contractual umbrella over the patent law claims, as the decision on the merits substantially concerned patent law. Therefore, the United States and German proceedings did not concern the same issue.⁴⁵

4.2 | Grounds for relief

Under the strict approach, courts will almost exclusively grant anti-suits injunctions on two grounds: (i) to protect the court’s jurisdiction and (ii) to protect important US public policies. An (anti-)anti-suit injunction to protect the court’s jurisdiction may be appropriate to protect the injunction claimant from a foreign anti-suit injunction.⁴⁶ The most important public policies, which may be protected by anti-suit injunctions, are the protection of final judgments (*res iudicata*)⁴⁷ and the protection of choice of court and arbitration agreements.⁴⁸

Courts applying the lax approach will additionally grant anti-suit injunctions to protect the injunction claimant from what the court considers “vexatious or oppressive” foreign proceedings or on other equitable grounds. As the mere inconvenience for parties and witnesses to participate in parallel proceedings in courts of different countries is considered vexatious and oppressive,⁴⁹ the lax approach will usually provide injunctive relief.

In *Microsoft v Motorola*, the anti-suit injunction was justified on the grounds of protecting the court’s jurisdiction. As Motorola had claimed injunctive relief in California and in Germany, there would have been a risk of inconsistent judgments. Moreover, it would only be clarified in the breach of contract proceedings, whether Motorola was entitled to injunctive relief. Hence, “Motorola’s actions have frustrated this court’s ability to adjudicate issues properly before it. Without the issuance of an anti-suit injunction, the integrity of the action

before this court will be lessened." Additionally, the delay in filing the German infringement claim had indicated a forum shopping, rendering the German action vexatious and oppressive.⁵⁰

4.3 | Comity

Finally, a court must consider the impact of the anti-suit injunction on comity. Comity is a self-imposed obligation to respect the courts, judgments, and laws of other nations. The Supreme Court described comity as "the recognition which one nation allows within its territory to the legislative, executive or judicial acts of another nation having due regard both to international duty and convenience, and to the rights of its own citizens or of other persons who are under the protection of its laws."⁵¹ One rationale is that foreign courts may in turn recognize and enforce the decisions of US courts.

Under the strict approach, anti-suit injunctions will only be granted under exceptional circumstances, as they interfere with a foreign court's process.⁵² This is reflected by the limited grounds for relief. The Sixth Circuit questioned whether any public policy of a state could ever justify a foreign anti-suit injunction.⁵³ If the dispute affects the national interests of other nations, courts must be particularly mindful.⁵⁴ In such cases, only the most compelling national public policies can justify an anti-suit injunction. The D.C. Circuit additionally weighs the interests of the United States against the national interests of the jurisdiction affected by the anti-suit injunction.⁵⁵

Courts applying the lax approach "decline [...] to genuflect before a vague and omnipotent notion of comity every time that [a court] must decide whether to enjoin a foreign action."⁵⁶ The Ninth Circuit's standard is whether the injunction's impact on comity is "tolerable."⁵⁷ If the anti-suit injunction serves to enforce a contract between two private parties, it would have little impact on comity, if any.⁵⁸ The Fifth and Seventh Circuits set even lower standards.⁵⁹ There would have to be concrete evidence that the specific anti-suit injunction would affect comity. As long as no foreign state complains to the US court, the impact on comity is negligible, according to Justice Posner.⁶⁰

In *Laker v Sabena*, one of the most authoritative cases on anti-anti-suit injunctions to date, Justice Wilkey emphasized the importance of comity. He criticized that US courts largely ignore comity. Back in 1984, he found, "[s]cholarly criticism has intensified."⁶¹ Over the past decades, criticism on the lax approach has further intensified.⁶²

4.3.1 | Reasoning in *Microsoft v Motorola*

In *Microsoft v Motorola*, a negligible impact on comity was mainly explained by the contractual nature of the dispute. It served to enforce a contract between two US companies.⁶³ The Court of Appeals considered the fact that German courts do not recognize contractual obligations of the SEP owner towards the implementer to be irrelevant. Would the impact on comity be intolerable if courts in the other jurisdiction answer legal issues differently, "there could virtually never be a foreign anti-suit injunction."⁶⁴ Both courts also relied on the sequence, in which the claims were filed. Comity concerns would be mitigated because the German action was initiated even though the dispute was pending in the United States.⁶⁵

4.3.2 | Discussion

The Court of Appeals relied on its assumption that the anti-suit injunction serves to enforce a contract. As seen, the court has neither explained, when an obligation not to claim injunctive relief arises from the FRAND Commitment, nor if the obligation existed because Microsoft was likely to be a willing licensee. The second assumption, that SEP disputes are purely commercial disputes, is also questionable. With an unsubstantiated classification as a contractual dispute, the Court of Appeals attempts to undermine the principle of territoriality in patent law.

US courts consider the technical importance of the patents and the extent to which the implementer utilizes the relevant functions in determining the royalty rate. This assessment is interconnected with patent law. The court did not consider that patent law only operates domestically and that courts must pay particular caution if their judgment on patents affects other jurisdictions. In *Microsoft v AT & T*, the Supreme Court warned, "[t]he presumption that United States law governs domestically but does not rule the world applies with particular force in patent law."⁶⁶ US courts shall take into account the interest of foreign jurisdictions in the protection of their national patents. This is what a district court did in *Optis v Apple* in declining jurisdiction to assess whether the SEP owner (*Optis*) was FRAND compliant and whether the implementer (*Apple*) was an unwilling licensee and therefore not entitled to raise the FRAND defence in the United States. The district court declined jurisdiction, as, "[l]ike claims for foreign patent infringement, claims asking the Court to pass upon foreign obligations under foreign laws related to foreign patents [the FRAND Obligation] are best left to the courts of those foreign countries."⁶⁷

In granting an anti-suit injunction, the Court of Appeals ignored Germany's national interest in the effective protection of German and European patents.⁶⁸ Moreover, German courts assess the SEP owner's licensing obligation under antitrust law. US case law recognizes that courts in any country whose markets are affected by abuse of dominance or by a conspiracy should be able to decide on the legal consequences.⁶⁹ As a district court has recognized, a "breach of contract judgment that relies on private law will not affect a GWB⁷⁰—or EC Treaty-based antitrust analysis that relies on public law."⁷¹

Even if one were to stick to the classification as a contractual dispute, SEP disputes involve national interests.⁷² For example, Chinese courts allegedly determine low FRAND royalties to strengthen the domestic industry.⁷³ The political significance is illustrated by former US President Trump's veto on the acquisition of Qualcomm by Broadcom. Qualcomm is one of the most important SEP owners. The Treasury Department stated that the acquisition of Qualcomm through (formerly) Singapore-based Broadcom could reduce US influence on telecommunications infrastructure and thus harm national security:

Given well-known national security concerns about Huawei and other Chinese telecommunication companies, a shift to Chinese dominance in 5G would have substantial negative national security consequences for the United States.⁷⁴

National security concerns had little significance in *Microsoft v Motorola*, as both parties were US companies. However, the District Court paid no attention to the national interests at stake in *Huawei v Samsung*⁷⁵ which ignored the political dimension of the SEP dispute between two foreign companies.⁷⁶

It is also questionable to attach any significance to the chronological order in which the domestic and foreign actions were filed. Although some authority supports this criterion,⁷⁷ it cannot be relevant in SEP disputes. The SEP owner is obligated by its FRAND Obligation to claim injunctive relief as late as possible. If Motorola had filed the German action six months earlier, before Microsoft initiated the contractual action in California, filing of the German action would likelier have violated the FRAND Obligation. In this case, the court would have been less reluctant to grant an anti-suit injunction. Furthermore, Motorola would have jeopardized its chances to obtain injunctive relief in Germany, as Microsoft was more likely to be considered a willing licensee at an earlier point. At least where the SEP dispute involves a foreign party, the anti-suit injunction's impact on comity is not tolerable. Even under the Ninth Circuit's standard, the issuance of an anti-suit injunction in such cases appears as an abuse of discretion.

4.4 | Summary

Until 2019, foreign courts and governments have tolerated anti-suit injunctions. This may be because they were mostly issued in disputes which were simply too unimportant to risk a clash of jurisdictions. Because of the

significant national and economic interests at stake in SEP disputes, the lax approach is now facing resistance of foreign courts. Anti-anti-suit injunctions granted by English, French, and German courts to prevent US anti-suit injunctions⁷⁸ indicate that the impact on comity might not have been “tolerable.” Interestingly, the District Court for the Eastern District of Texas seems to share this view if a foreign anti-suit injunction deprives a SEP owner of its right to bring patent infringement actions in the United States.⁷⁹

The lax approach construes the grounds for relief so broadly and attaches so little importance to comity that the only requirement for an anti-suit injunction are the “threshold criteria.”⁸⁰ In most SEP disputes not even the threshold criteria are satisfied, as there is no “contractual umbrella” and the FRAND Commitment is not comparable to a jurisdiction agreement. Foreign anti-suit injunctions should not be granted, unless the SEP owner has obviously breached its FRAND Obligation and both parties are US companies. The numerous anti-anti-suit injunctions triggered by the Ninth Circuit's anti-suit injunctions may also give cause to reconsider the lax approach in general. The premise that comity is negligible in contractual actions between private parties is incorrect.

5 | CHINESE ANTI-SUIT INJUNCTIONS

In 2020, Chinese courts followed suit and started to grant anti-suit injunctions in SEP disputes. A press release by the Supreme People's Court of China states:

[T]he anti-suit injunction is an unavoidable issue confronting the Chinese intellectual property judicial system. Many Chinese lawsuits have encountered [foreign] anti-suit injunctions. The trend of anti-suit injunctions deeply reflects the competitive situation among major powers for jurisdiction and dominance in rulemaking. Anti-suit injunctions are an important tool to prevent parallel litigation and safeguard the country's judicial sovereignty. Without anti-suit injunctions, Chinese courts will be in a passive position in international judicial competition.⁸¹

Chinese courts take a similar approach as the Ninth Circuit in granting anti-suit injunctions.⁸² However, Chinese courts do not require the domestic action to be dispositive of the foreign action. The approach is broader in that it only requires a substantial negative impact of the foreign proceedings on the Chinese proceedings.⁸³ Notably, Chinese courts may grant anti-suit injunctions without hearing the injunction defendant (ex parte) and may not only enjoin the party from litigating in a certain jurisdiction, but in any jurisdiction other than China.⁸⁴ The reasons for which US anti-suit injunctions granted in SEP disputes appear unlawful apply a fortiori to the even broader Chinese anti-suit injunctions.⁸⁵

6 | GERMAN ANTI-ANTI-SUIT INJUNCTIONS

Until January 2022, German courts have issued anti-anti-suit injunctions in five cases. Four anti-anti-suit injunctions were granted to protect SEP owners affected by Chinese anti-suit injunctions,⁸⁶ one against a US anti-suit injunction.⁸⁷ For the following part, “Injunction Claimant” and “Injunction Defendant,” respectively refer to the anti-anti-suit injunction.

6.1 | Legal basis

Foreign anti-suit injunctions could be granted within days. Therefore, a decision on the anti-anti-suit injunction would come too late in ordinary proceedings. Sec. 935 ff. of the German Code of Civil Procedure (ZPO) provide the

possibility of preliminary injunctions. Under Sec. 935 ZPO the Injunction Claimant must show that it is *prima facie* entitled to a claim under substantive law (Verfügungsanspruch) and that the realization of its right could be frustrated if it had to wait until an ordinary judgment is rendered (Verfügungsgrund).

6.2 | Substantive claim

The substantive claim for an (anti-)anti-suit injunction is based on Sec. 823 para. 1 of the German Civil Code (BGB) in conjunction with Sec. 1004 para. 1 BGB. According to these provisions, the Injunction Claimant is entitled to injunctive relief if the Injunction Defendant unlawfully violates a certain right of the Injunction Claimant. Such rights are life, health, freedom, property, and “other” rights. All protected rights are effective against anyone and not only against certain individuals, as for example, contractual rights. German jurisprudence refers to such rights as “absolute rights.”⁸⁸ Patents are absolute rights and protected by Sec. 823 para. 1 BGB.⁸⁹ German courts regard anti-suit injunctions which enjoin the Injunction Claimant from initiating or continuing patent infringement proceedings, as an interference with the patent. The patent would be meaningless if injunctive relief was unenforceable.⁹⁰

Generally, the violation of an absolute right indicates the unlawfulness of the infringing act.⁹¹ This does not apply if a procedural act violates the right. According to the case-law of the German Federal Court of Justice (“FCJ”), procedural acts are generally considered lawful.⁹² This general rule also applies to procedural acts in foreign countries.⁹³ Therefore, a court must establish the unlawfulness of the foreign anti-suit injunction. Although the infringing act, the application for an anti-suit injunction, happens abroad, German courts will apply German law.⁹⁴ This is consistent with Art. 4 para. 1 Rome II Regulation as the patentee is deprived of its right to enforce its patent in Germany. However, it raises the question of how to establish the legality of a remedy alien to German law.

6.2.1 | Approach of the RC Munich

In its first ruling on anti-suit injunctions, the Regional Court (RC) Munich assumed that any anti-suit injunction was incompatible with the German legal system and thus unlawful.⁹⁵ As the German court issued an (anti-)anti-suit injunction itself, this argument is not convincing. However, the anti-suit injunction prevented the Injunction Claimant from enforcing its patents. The court viewed this as contradictory to the proprietary nature of the patent according to Sec. 9, 10, and Sec. 139 ff. of the German Patent Act (PatG).⁹⁶ On appeal, the Higher Regional Court (HRC) Munich agreed.⁹⁷ In two subsequent judgments, the court relied on the same reasoning.⁹⁸

The reasoning merely describes how an anti-suit injunction operates. Its purpose is precisely to enjoin the Injunction Claimant from enforcing its rights in the foreign forum. This could lead to the conclusion that the court will always grant an anti-anti-suit injunction in case of a foreign anti-suit injunction in the face of German proceedings. However, the RC Munich referred to the patent and its proprietary nature. If the foreign anti-suit injunction only threatens the Injunction Claimant's assets and does not limit the enforcement of patents or other absolute rights, no anti-anti-suit injunction will be granted.

6.2.2 | Approach of the RC Düsseldorf

The RC Düsseldorf focusses on whether the foreign anti-suit injunction can be recognized and enforced in Germany.⁹⁹ Referring to an older decision of the HRC Düsseldorf,¹⁰⁰ the court stated that anti-suit injunctions are generally not recognizable, as they indirectly deprive a German court of its competence to decide on its own jurisdiction (competence-competence). Anti-suit injunctions are considered unlawful unless the German court is

required to recognize the foreign anti-suit injunction, for example, by an international treaty.¹⁰¹ As no such treaty exists, the Chinese anti-suit injunction was unlawful, according to the RC Düsseldorf.

Furthermore, the Injunction Claimant's constitutional right of access to justice required protection by means of an anti-anti-suit injunction.¹⁰² The RC Düsseldorf considered whether the SEP owner is entitled to injunctive relief against the implementer, or whether its right of access to justice is restricted by the SEP owner's obligations under antitrust law.¹⁰³ It concluded that an implementer who impairs the licensing negotiations by applying for an anti-suit injunction, is an unwilling licensee.¹⁰⁴ Therefore, the Injunction Claimant's constitutional right of access to justice was not restricted by its obligation to license the SEP on FRAND terms.

6.2.3 | Approach of the HRC Düsseldorf

On appeal, the HRC Düsseldorf vacated the judgment and the anti-anti-suit injunction. The HRC Düsseldorf generally regards an application for an anti-suit injunction, which would prevent the patentee from enforcing its rights in Germany, as unlawful.¹⁰⁵ In this regard it sided with the Munich courts.¹⁰⁶ Nevertheless, an application for an anti-anti-suit injunction similarly aims to enjoin the Injunction Defendant from asserting its right in a foreign jurisdiction. The court found that claims which seek to enjoin procedural conduct are generally impermissible under German law as the outcome of a case should not be prejudiced by preventing a party from filing applications in court proceedings (*prozessuales Privileg*).¹⁰⁷ Accordingly, an application for an anti-anti-suit injunction is generally impermissible. Exceptionally, such an order may be issued if it is strictly necessary (*objektiv notwendig*) to protect the Injunction Claimant's constitutional rights.¹⁰⁸ An anti-anti-suit injunction may be necessary if the Injunction Defendant has already applied for an anti-suit injunction or if sufficient proof indicates that it will do so. Otherwise, the claimant does not require legal protection by means of an anti-anti-suit injunction, as the injunction may still be granted shortly after the foreign anti-suit injunction has been issued.¹⁰⁹

6.2.4 | Imminent threat of interference

The HRC Düsseldorf addresses the question of whether there is an imminent threat of a foreign anti-suit injunction being granted in the context of admissibility. An imminent threat of an unlawful violation of a protected right is also a requirement under Sec. 1004 para. 1 BGB.¹¹⁰ Whether this requirement is a question of admissibility (HRC Düsseldorf), or of merit (RC Düsseldorf and RC Munich), is outside the scope of this essay. However, German courts will assume an imminent threat of an unlawful violation of a German patent if the Injunction Defendant has applied for an anti-suit injunction abroad.¹¹¹ In *Nokia v Daimler/Continental*, the RC Munich did not examine whether the claim filed in the United States was likely to be successful. It was sufficient that a Californian court had already granted an anti-suit injunction in another SEP dispute.

If the Injunction Defendant has not applied for a foreign anti-suit injunction, it is harder to establish an imminent threat. The burden of proof lies with the Injunction Claimant. It must provide factual evidence for a substantial risk that the Injunction Defendant will act unlawful. The specific act of infringement must be imminent so that it can be reliably assessed for all other requirements of the substantial claim whether they will be met.¹¹² It is not sufficient that a certain right or remedy exists in a foreign forum, as it is unknown if the Injunction Defendant will assert it.

According to the RC Munich, these general principles cannot be applied to cases involving anti-suit injunctions. Otherwise, the Injunction Claimant would have to prepare claims for anti-anti-suit injunctions against multiple implementers without knowing if they will apply for an anti-suit injunction.¹¹³ Therefore, the RC Munich has listed five groups of cases in which it will assume an imminent threat of a foreign anti-suit injunction. An imminent threat will be assumed if (i) the Injunction Defendant has threatened the Injunction Claimant to apply for an anti-suit

injunction; (ii) the Injunction Defendant has already applied for an anti-suit injunction against the Injunction Claimant; (iii) the Injunction Defendant has applied for the determination of global licensing fees in a jurisdiction which provides anti-suit injunctions, or threatened to do so; (iv) the Injunction Defendant had previously applied for, or threatened an anti-suit injunction against other SEP owners and has not yet signaled that he won't do so again; or (v) the Injunction Defendant did not confirm in writing within a short period of time, after a request by the Injunction Claimant, not to apply for an anti-suit injunction.¹¹⁴

The RC Düsseldorf rejected the RC Munich's broad approach¹¹⁵ and examined whether an imminent threat existed under the general principles set out by the FCJ. The Düsseldorf court noted that the Injunction Defendant was generally willing to apply for further anti-suit injunctions, as its affiliated companies had recently applied for multiple anti-suit injunctions in China and had not stated that they will not apply for further anti-suit injunctions.¹¹⁶ The Düsseldorf court also examined whether the requirements for a Chinese anti-suit injunctions were met. It concluded that a Chinese court may grant an anti-suit injunction which the RC Düsseldorf found sufficient to affirm an imminent threat.¹¹⁷

In case of an imminent threat of a foreign anti-suit injunction, urgent relief is usually required. The Injunction Claimant may lose its right to obtain injunctive relief if it waits too long before filing the claim. In this case, courts assume that the matter is not urgent.¹¹⁸ For foreign anti-suit injunctions, the time limit is at least 1 month. It begins at the earliest when the Injunction Claimant is informed about the foreign anti-suit injunction or would have become aware of it if it had exercised due diligence.¹¹⁹

6.3 | Suggested approach

Under the framework of the RC Munich, every foreign anti-suit injunction, which interferes with an absolute right, would justify a German anti-anti-suit injunction. The approach goes further than necessary.¹²⁰ If the foreign anti-suit injunction serves to enforce a waiver or jurisdiction agreement that is valid and enforceable under the applicable law, an anti-anti-suit injunction would indeed lead to duplicative and vexatious parallel proceedings. The same applies to the approach set out by the RC Düsseldorf. Since no international treaty allows anti-suit injunctions, any anti-suit injunction is unlawful in the view of the court. Both approaches reflect a general mistrust towards a remedy which is considered lawful in major jurisdictions.¹²¹ This harms comity and could lead to further counter injunctions. More importantly, the general mistrust reflected in both approaches seems contrary to German case law which generally considers foreign procedural acts as lawful.¹²²

It would be preferable to adopt the standards developed in common law jurisdictions to assess the lawfulness of a foreign anti-suit injunction. Establishing the unlawfulness of the foreign anti-suit injunction, as Justice Wilkey did in *Laker v Sabena*,¹²³ enables the foreign court to grasp the reasoning of the anti-anti-suit injunction. Courts in the United Kingdom and in the United States will restrain foreign proceedings if they threaten the courts' jurisdiction or proceedings or would lead to the evasion of important public policies. In turn, foreign anti-suit injunctions should be considered unlawful under German law if they threaten the exclusive jurisdiction of German courts or important public policies. In such cases, the foreign court has misjudged the anti-suit injunction's impact on comity. As German courts are the only forum available to enforce German patents, anti-suit injunctions granted in SEP disputes threaten the German courts' exclusive jurisdiction.

6.3.1 | Anti-anti-suit injunctions under EU Law

It may be argued that the European Brussels Ia/Lugano regime *requires* courts to grant an anti-anti-suit injunction if a foreign anti-suit injunction deprives them of their exclusive jurisdiction under Art. 24 of the Brussels Ia Regulation. The Brussels Ia Regulation is supposed to provide legal certainty as to where one might be sued and to strengthen

the legal protection of citizens domiciled in the EU.¹²⁴ Under the *forum non conveniens* doctrine, a court has a wide discretion as to which forum is the most appropriate for the “trial of the action.” This discretionary power could undermine the objective of legal certainty. Therefore, courts in member states cannot stay proceedings on *forum non conveniens* grounds if they have exclusive jurisdiction.¹²⁵

In *Samengo-Turner*¹²⁶ an anti-suit injunction was granted to enforce the defendant's right to be sued only in England under Sec. 5 of the Regulation (EC) No 44/2001 (“Brussels I Regulation”). An employer was suing its employees in New York on the basis of a choice-of-court agreement. Under Sec. 5 of the Brussels I Regulation, employees can only be sued at their domicile. This cannot be changed by a choice-of-court agreement. It follows from the ruling in *Samengo-Turner* that an anti-suit injunction could also be granted if an EU domiciled defendant is sued the court of a non-member state even though a court in a member state has exclusive jurisdiction under Art. 24 of the Brussels Ia Regulation.¹²⁷ As the Court of Justice of the European Union (“CJEU”) appears to take a rather critical stance toward anti-suit injunctions,¹²⁸ it likely would not approve an anti-suit injunction to enforce an EU domiciled defendant's right not to be sued abroad.

However, to the court of a member state, a foreign anti-suit injunction has the same effect as a stay of proceedings. If it remains idle, the proceedings will in fact be stayed.¹²⁹ As a court may not actively stay its proceedings under *Owusu v Jackson*, it should prevent the same result from happening. This explains why courts in civil law jurisdictions are not acting inconsistent if they deem anti-suit injunctions as generally unlawful but grant anti-anti-suit injunctions themselves. The anti-anti-suit injunction is a defensive remedy and serves to protect the courts' exclusive jurisdiction under Art. 24 No. 4 of the Brussels Ia Regulation.

6.3.2 | Anti-suit injunctions and TRIPS

An anti-anti-suit injunction also prevents the evasion of an important public policy. If German courts cannot enforce patents, confidence in Germany as a business location will be impaired. More importantly, under Art. 41 para. 1 of the TRIPS Agreement, members must ensure that remedies for patent infringement are “available” and permit effective action. According to the correct view, remedies must not only be effective in theory, but also in a real-world setting.¹³⁰ Remedies are only available if they are obtainable.¹³¹ Damages are often an insufficient remedy to prevent patent infringement. Hence, the member's judicial authority should be able to grant injunctive relief under Art. 44 para. 1 TRIPS. If German courts were unable to protect patentees affected by foreign anti-suit injunctions, remedies would not be obtainable. For remedies to be available, German courts must be able to grant anti-anti-suit injunctions.

7 | CONCLUSION

US Courts applying the lax approach will usually grant anti-suit injunctions to enjoin parallel litigation in foreign jurisdictions. This neglects comity, as commentators¹³² and most circuits¹³³ have already pointed out. Since anti-suit injunctions are particularly problematic in SEP disputes due to the principle of territoriality and the economic and political importance of SEPs, the backlash through anti-anti-suit injunctions was only a matter of time. Besides, if one jurisdiction provides anti-suit injunctions, others are encouraged to follow suit to provide a comparable level of protection. This is reflected by recent Chinese anti-suit injunctions.

This essay does not seek to blame any jurisdiction for the rise of anti-suit injunctions and counter injunctions in SEP disputes. Although the anti-suit injunctions granted by courts in the United States and China appear unlawful, it is important to consider why anti-suit injunctions often target German proceedings. In Germany, a final injunction will generally be granted if the court finds the patent to be infringed. Validity matters are tried separately. Hence, a

final injunction can be granted relatively fast.¹³⁴ Courts rarely exercise their discretionary power to stay infringement proceedings until the ruling on the validity of the patent.¹³⁵

The legal basis for injunctive relief, Sec. 139 PatG, was revised in 2021. It now states that an injunction should not be granted if this would lead to a disproportionate hardship. However, the amendment does not seem to have any significant impact. According to the prevailing opinion, the amendment of Sec. 139 PatG is purely declaratory and a codification of the FCJ's ruling in *Wärmetauscher (Heat Exchanger)*.¹³⁶ The FCJ ruled that an injunction is only disproportionate in very exceptional cases.¹³⁷ There has not been a single case in which an injunction was refused as it would lead to a disproportionate hardship.¹³⁸

This leaves implementers with the FRAND defence under Art. 102 TFEU. The FRAND defence usually fails.¹³⁹ The way some German courts interpret the CJEU's ruling in *Huawei v ZTE* tends to favor the SEP owner. This is because their inquiry mainly focusses on the conduct of the implementer during the licensing negotiations. The FRAND compliance of the SEP owner's licence offers is only examined to a limited extent.¹⁴⁰ Even if the implementer has made a FRAND compliant counteroffer it may be deemed an unwilling licensee if the SEP owner's offer is not an obvious violation of its obligation to offer a licence on FRAND terms.¹⁴¹

Again, *Microsoft v Motorola* provides a good example. The US court set a royalty rate of 0.555 cents per unit sold for Motorola's H.264 portfolio. Motorola had demanded 2.25% of the retail price of any product sold by Microsoft. If one applied an average retail price of USD 100 per product, the licence offered by Motorola exceeded the FRAND royalties determined by the US court by an astonishing 40541%. According to the RC Mannheim, however, Motorola's offer did not obviously exceed the FRAND range.¹⁴² Hence, the implementer's FRAND defence was unsuccessful.

Although the question of which court (if any)¹⁴³ should ultimately determine the global FRAND royalties remains unanswered, SEP disputes require legal restraint among jurisdictions. In this essay, it is not argued that the patent enforcement by German courts constitutes an excessive enforcement inconsistent with Art. 3 para. 2 Directive 2004/48/EC (Enforcement Directive) or with the TRIPS Agreement.¹⁴⁴ However, global problems require global solutions. A first step "toward a global consensus" could be a harmonization of the requirements under which an injunction will be granted if the infringed patent is a SEP.¹⁴⁵

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DATA AVAILABILITY STATEMENT

All sources are listed as references.

ENDNOTES

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⁵⁶ *Kaepa v Achilles*, 76 F.3d 624, 627 (5th Cir. 1996).

⁵⁷ *Microsoft v Motorola*, 696 F.3d 872, 886 (9th Cir. 2012); *Gallo Winery v Andina Licores*, 446 F.3d 984, 996 (9th Cir. 2006).

⁵⁸ *Microsoft v Motorola*, 696 F.3d 872, 888 (9th Cir. 2012); *Applied Medical v Surgical*, 587 F.3d 909, 921 (9th Cir. 2009); *Gallo Winery v Andina Licores*, 446 F.3d 984, 994 (9th Cir. 2006).

⁵⁹ *Kaepa v Achilles*, 76 F.3d 624, 630-633 (5th Cir. 1996); *Allendale v Bull Data Systems*, 10 F.3d 425, 431 (7th Cir. 1993).

⁶⁰ *Allendale v Bull Data Systems*, 10 F.3d 425, 431 (7th Cir. 1993).

⁶¹ *Laker v Sabena*, 731 F.2d 901, 950 (DC Cir. 1984).

⁶² Teresa D. Baer, 'Injunctions Against the Prosecution of Litigation Abroad: Towards a Transnational Approach', (1984) 37 SLR 155, 173; Trevor C. Hartley, 'Comity and the Use of Antisuit Injunctions in International Litigation', (1987) 35 AJL 487, 509; George A. Bermann, 'The Use of Antisuit Injunctions in International Litigation', (1990) 28 CJL 589, 630-631; Thomas E. Burck, (n 52), 475, 488-489; Michael D. Schimeck, (n 52), 520-522; Haig Najarian, 'Granting Comity its Due: A Proposal to Revive the Comity-Based Approach to Transnational Antisuit Injunctions', (1994) 68 SJLR 961, 983-985; Laura M. Salava, 'Balancing Comity with Antisuit Injunctions: Considerations Beyond Jurisdiction', (1994) 20 JL 267, 269-270; Steven R. Swanson, 'The Vexatiousness of a Vexation Rule: International Comity and Antisuit Injunctions', (1996) 30 GWJILE 1, 33, 36-37; Eric Roberson, 'Comity be Damned: The Use of Antisuit Injunctions Against the Courts of a Foreign Nation', (1998) 147 UPLR 409, 433; John Ray Phillips III., 'A Proposed Solution to the Puzzle of Antisuit Injunctions', (2002) 69 UCLR 2007, 2023-2024; N. Jansen Calamita, 'Rethinking Comity: Towards a Coherent Treatment of International Parallel Proceedings', (2006) 27 UPJIEL 601, 680; Kathryn E. Vertigan, 'Foreign Antisuit Injunctions: Taking a Lesson From the Act of State Doctrine', (2007) 76 GWLR 155, 180; Samantha Koeniger and Richard Bales, 'When a U.S. Domestic Court can Enjoin a Foreign Court Proceeding', (2014) 22 CJICL 473, 491-495; Trevor C. Hartley, *International Commercial Litigation*, 3rd ed. 2020, p. 280; cf. Eli Greenbaum, 'No Forum to Rule Them All: Comity and the Conflict in Transnational FRAND Disputes', (2019) 94 WLR 1085, 1100; Haris Tsilikas, (n 11), 736 (both referring to SEP disputes).

⁶³ *Microsoft v Motorola*, 696 F.3d 872, 888 (9th Cir. 2012).

⁶⁴ *Id.*

⁶⁵ *Microsoft v Motorola*, 871 F.Supp.2d 1089, 1101 (W.D. Wash. 2012), *aff'd* 696 F.3d 872, 887-888 (9th Cir. 2012).

⁶⁶ *Microsoft v AT & T*, 550 U.S. 437, 454-455 (2007).

⁶⁷ *Optis v Apple*, 2020 U.S. Dist. LEXIS 36104, *9 (E.D. Tex. 2020).

⁶⁸ HRC Munich, GRUR 2020, 379, para. 57; RC Munich, BeckRS 2019, 25536, paras. 58-61; cf. Dicky King Fung Tsang and Jyh-An Lee, *The Ping-Pong Olympics in Antisuit Injunction in FRAND* (2021), pp. 28-29, (available via SSRN <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3968645> accessed June 13, 2022) forthcoming in (2022) 28 MTLR.

⁶⁹ *Laker v Sabena*, 731 F.2d 901, 932-933 (DC Cir. 1984).

⁷⁰ Gesetz gegen Wettbewerbsbeschränkungen (German Competition Act).

⁷¹ *SynCardia Systems v MEDOS Medizintechnik*, 2008 WL 11339957, *3 (D. Az. 2008).

⁷² *Apple v Qualcomm*, 2017 U.S. Dist. LEXIS 145835, *53-54. (S.D. Cal. 2017); Greenbaum, (n 62), 1100-1103; Tsang and Lee, (n 68), pp. 16-17.

⁷³ Adam Mossoff, Brief as Amicus Curiae in Support of Claimant in *Ericsson v Samsung*, Case-No. 2:20-cv-380-JRG (E.D. Tex. 2021), pp. 7-9; D. Daniel Sokol and Wentong Zheng in Jorge L. Contreras (ed), *Cambridge Handbook of Tech. Standard. Law Vol. 1* (2017), pp. 306, 316-318; Tsang and Lee, (n 68), p. 35.

⁷⁴ Department of the Treasury, Public Letter dated 5 March 2018 <https://www.sec.gov/Archives/edgar/data/804328/000110465918015036/a18-7296_7ex99d1.htm> accessed June 11, 2022

⁷⁵ *Huawei v Samsung*, 2018 WL 1784065, *11-12 (N.D. Cal. 2018).

⁷⁶ Tsang and Lee, (n 68), pp. 22-23.

⁷⁷ *Applied Medical v Surgical*, 587 F.3d 909, 920 (9th Cir. 2009); *Kaepa v Achilles*, 76 F.3d 624, 627 (5th Cir. 1996). In *Huawei v Samsung*, 2018 WL 1784065, *12 (N.D. Cal. 2018), the court found that the anti-suit injunction "would not intolerably impact comity," as the US action was filed minutes or hours earlier.

- ⁷⁸ *IPCom v Lenovo* [2019] EWHC 3030 (Pat); Cour d'appel de Paris, 3 Mars 2020, RG 19/21426 (*Lenovo v IPCom*); RC Munich, BeckRS 2019, 25536 (*Nokia v Daimler/Continental*).
- ⁷⁹ *Ericsson v Samsung*, 2021 WL 89980, *5 (E.D. Tex. 2021).
- ⁸⁰ Contreras, (n 11), 278–279; cf. Geradin and Katsifis, (n 11), p. 12.
- ⁸¹ Press Release of the Supreme People's Court <<http://ipc.court.gov.cn/zh-cn/news/view-1056.html>> accessed December 23, 2021; cf. Jorge L. Contreras, Peter K. Yu, and Yu Yang, *Transplanting Anti-Suit Injunctions* (Draft of 6 November 2021, available via SSRN <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3937716> accessed January 4, 2022, forthcoming (2022) 71 AULR, pp. 41–42.
- ⁸² Geradin and Katsifis, (n 11), pp. 9–10; Brief of IP Law professors as amici curiae, March 1, 2021, *Ericsson v Samsung*, Case-No. 21-1565, p. 16 (available via SSRN <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3802235> accessed December 24, 2021); for a discussion of Chinese anti-suit injunctions cf. Tsang and Lee, (n 68), pp. 27–37.
- ⁸³ *Huawei v Conversant*, (2019) Zui Gao Fa Zhi Min Zhong 732, 733 and 734 No 1 (Supreme People's Court of the People's Republic of China, 2020). An unofficial English translation is available at <<https://patentlyo.com/media/2020/10/Huawei-V.-Conversant-judgment-translated-10-17-2020.pdf>> accessed June 11, 2022); Tsang and Lee, (n 68), pp. 28–29, 35–37.
- ⁸⁴ *Xiaomi v InterDigital*, (2020) E 01 Zhi Min Chu No. 169 (Wuhan Intermediate People's Court, 2020); Tsang and Lee, (n 68), p. 32.
- ⁸⁵ Cf. the anti-anti-suit injunctions granted in *InterDigital v Xiaomi*, I.A. 8772/2020 in CS (COMM) 295/2020 (Delhi High Court, 2021), and RC Munich, GRUR-RS 2021, 3995.
- ⁸⁶ RC Düsseldorf, BeckRS 2021, 36218 (*HEVC Advance v Xiaomi*), vacated on appeal, cf. HRC Düsseldorf, GRUR 2022, 318; RC Munich, GRUR-RS 2021, 17662 (*IP Bridge v Huawei*); RC Munich, GRUR-RS 2021, 3995 (*InterDigital v Xiaomi*); a fourth one was granted by the RC Munich in *Sharp v Oppo*, but was not enforced, cf. Contreras, Yu, and Yu, (n 81), p. 32.
- ⁸⁷ HRC Munich, GRUR 2020, 379; RC Munich, BeckRS 2019, 25536.
- ⁸⁸ Ulrich Magnus in Gerhard Dannemann and Reiner Schulze (eds), *German Civil Code—Commentary* (2020), Sec. 823, para. 3.
- ⁸⁹ Cf. FCJ, GRUR 2016, 1257, para. 24; NJW 2004, 3102, 3105.
- ⁹⁰ HRC Munich, GRUR 2020, 379, para. 55; RC Munich, BeckRS 2019, 25536, paras. 56–58; RC Düsseldorf, BeckRS 2021, 36218, paras. 23–26.
- ⁹¹ Ulrich Magnus, (n 88), paras. 39–40.
- ⁹² FCJ, NJW 2020, 399, para. 44; GRUR 2018, 832, para. 76; NJW 2009, 1262, paras. 12–13.
- ⁹³ FCJ, NJW 2020, 399, paras. 44–45; HRC Nuremberg, RIW 1993, 412, 413; RC Konstanz, Beck RS 2011, 11373; the RC Munich seems to disagree, RC Munich, BeckRS 2019, 25536, paras. 62–65. The applicability to foreign proceedings is also controversial in German literature. For further references, cf. Michael Stürner, 'Domestic Legal Protection Against Foreign Judgements/Inländischer Rechtsschutz gegen ausländische Urteile, Funktion und Reichweite von § 826 BGB als Abwehrinstrument gegen rechtskräftige Entscheidungen insbesondere aus dem außereuropäischen Ausland', (2007) 71 *RabelsZ* 597, 602.
- ⁹⁴ RC Düsseldorf, BeckRS 2021, 36218, para. 30; RC Munich, BeckRS 2019, 25536, para. 62.
- ⁹⁵ RC Munich, BeckRS 2019, 25536, para. 62.
- ⁹⁶ *Id.*, para. 61.
- ⁹⁷ HRC Munich, GRUR 2020, 379, para. 55.
- ⁹⁸ RC Munich, GRUR-RS 2021, 17662, para. 29; GRUR-RS 2021, 3995, para. 55.
- ⁹⁹ RC Düsseldorf, BeckRS 2021, 36218, para. 30.
- ¹⁰⁰ HRC Düsseldorf, IPRax 1997, 260, 261.
- ¹⁰¹ RC Düsseldorf, BeckRS 2021, 36218, para. 32.
- ¹⁰² *Id.*, paras. 34–36.
- ¹⁰³ *Id.*, para. 36.
- ¹⁰⁴ *Id.*
- ¹⁰⁵ HRC Düsseldorf, GRUR 2022, 318, paras. 16, 21.

- ¹⁰⁶ *Id.*, paras. 11–13, 16.
- ¹⁰⁷ *Id.*, paras. 21–22; cf. FCJ GRUR 2010, 253; GRUR 1998, 587, 589.
- ¹⁰⁸ HRC Düsseldorf, GRUR 2022, 318, paras. 25–26.
- ¹⁰⁹ *Id.*, paras. 32–42.
- ¹¹⁰ According to its wording, Sec. 1004 BGB only protects property. Other absolute rights are protected by analogy, cf. Ulrich Magnus, (n 88), Sec. 1004, para. 2.
- ¹¹¹ HRC Munich, GRUR 2020, 379, para. 56; RC Munich, GRUR-RS 2021, 3995, para. 86.
- ¹¹² FCJ, GRUR 2021, 607, para. 50; GRUR 2015, 603, para. 17.
- ¹¹³ RC Munich, GRUR-RS 2021, 17662, para. 37.
- ¹¹⁴ RC Munich, GRUR-RS 2021, 3995, para. 90; GRUR-RS 2021, 17662, paras. 34, 37.
- ¹¹⁵ RC Düsseldorf, BeckRS 2021, 36218, para. 40.
- ¹¹⁶ *Id.*, paras. 47–51; The appeal on this finding was successful. The Injunction Defendant and its affiliates had applied for an anti-suit injunction only once, cf. HRC Düsseldorf, GRUR 2022, 318, paras. 37–39.
- ¹¹⁷ RC Düsseldorf, BeckRS 2021, 36218, paras. 42–46.
- ¹¹⁸ Cf. FCJ, GRUR 2000, 151, 152; Klaus Grabinski and Carsten Zülch in *Benkard PatG*, 11th ed. 2015, Sec. 139, para. 153c.
- ¹¹⁹ RC Munich, GRUR-RS 2021, 3995, paras. 84, 86; GRUR-RS 2021, 17662, paras. 65–66; Beck RS 2019, 25536, para. 90; RC Düsseldorf, Beck RS 2021, 36218, para. 56.
- ¹²⁰ Maximilian Haedicke, 'Anti-Suit Injunctions, FRAND Policies and the Conflict Between Overlapping Jurisdictions', *GRUR Int.* 2022, 101, 110.
- ¹²¹ *Id.*
- ¹²² *Supra* note 93.
- ¹²³ *Laker v Sabena*, 731 F.2d 901, 939 (DC Cir. 1984).
- ¹²⁴ *Besix* [2002] CJEU, Case C-256/00, ECLI:EU:C:2002, at [24–26]; *Roche Nederland BV v Primus* [2006] CJEU, Case C-539/03, ECLI:EU:C:2006:458, at [37].
- ¹²⁵ *Owusu v Jackson* [2005] CJEU, Case C-281/02, ECLI:EU:C:2005:120, at [41]–[46]. This applies at least where a non-member state is the *natural forum* or the "*forum conveniens*," cf. *Cheshire, North & Fawcett, Private Int'l Law*, 15th ed. 2017, p. 460.
- ¹²⁶ *Samengo-Turner v J & H Marsh & McLennan (Services) Ltd* [2007] EWCA Civ 723, [2007] IL Pr 52.
- ¹²⁷ *Cheshire, North & Fawcett, Private Int'l Law*, 15th ed. 2017, p. 482.
- ¹²⁸ Cf. *Turner v Grovit* [2004] CJEU, Case C-159/02, ECLI:EU:C:2004:228; *Allianz SpA v West Tankers* [2009] CJEU, Case C-185/07, ECLI:EU:C:2009:69; Christopher Knight, 'Owusu and Turner: The Shark in the Water', (2007) 66 *Cambridge LJ*, 288, 301.
- ¹²⁹ Cf. *General Star International Indemnity v Stirling Cooke Brown Reinsurance* [2003] EWHC 3 (Comm), [2003] IL Pr 19, at [8]; Gita F. Rothschild, 'Forum Shopping', (1998) 24 *Litigation*, 40, 74.
- ¹³⁰ Sascha Vander and Christian Steigüber in Jan Busche et al. (eds), *TRIPS–Kommentar*, 2d ed. 2013, Art. 41, para. 3; Justin Malbon, Charles Lawson, and Mark Davison, *The WTO Agreement on Trade-Related Aspects of Intellectual Property—A Commentary* (2014), para. 41.08.
- ¹³¹ US—Sec. 211 Appropriations Act, WT/DS176/AB/R, para. 215.
- ¹³² *Supra* note 62.
- ¹³³ *Supra* note 12.
- ¹³⁴ Cf. Katrin Cremers et al., 'Patent Litigation in Europe', (2017) 44 *EJLE*, 1, 13; Julia Schönbohm and Natalie Ackermann-Blome, 'Products, Patents, Proportionality - How German Patent Law Responds to 21st Century Challenges', *GRUR Int.* 2020, 578.
- ¹³⁵ Léon E. Dijkman, 'Does the Injunction Gap Violate Implementers' Fair Trial Rights Under the ECHR?', *GRUR Int.* 2021, 215, 220; Peter Georg Picht and Anna-Lena Karczewski in Jorge L. Contreras and Martin Husovec (eds), *Injunctions in Patent Law*, 2022, p. 142, 148; Arno Riße, in Sikorski (ed) *Patent Law Injunctions*, 2019, p. 63, 80; according to Peter

Tochtermann's presentation at the Event "Patents in Telecoms," London (UCL), 27.5.2022, the RC Mannheim has stayed some infringement actions regarding SEPs.

- ¹³⁶ Fabian Hoffmann, *Stellungnahme zum Gesetzentwurf eines zweiten Patentrechtsmodernisierungsgesetzes* (2021) <<https://www.bundestag.de/resource/blob/823364/097add0b3fbce63e24c8aa37b2807a84/stellungnahme-hoffmann-data.pdf>> accessed May 18, 2022; Mary-Rose McGuire, 'Stellungnahme zum 2. PatModG: Ergänzung des § 139 I PatG durch einen Verhältnismäßigkeitsvorbehalt?', GRUR 2021, 775; views expressed at the CIPLITEC Conference "Patentrecht: Der Anspruch auf Unterlassen nach dem 2. PatMoG," October 21–22, 2021, cf. Peter Georg Picht and Anna-Lena Karczewski in Jorge L. Contreras and Martin Husovec (eds), *Injunctions in Patent Law*, 2022, p. 142, 162.
- ¹³⁷ Cf. FCJ GRUR 2016, 1031, para. 45.
- ¹³⁸ Schönbohm and Ackermann-Blome, (n 134), 580.
- ¹³⁹ JRC, *Licensing Terms of Standard Essential Patents: A Comprehensive Analysis of Cases* (2017), p. 71, <<https://publications.jrc.ec.europa.eu/repository/handle/JRC104068>> accessed June 12, 2022; cf. Peter Georg Picht, *Wirtschaft und Wettbewerb* 2018, 300, 308.
- ¹⁴⁰ The FCJ and the Munich and Mannheim courts mostly determine the FRAND compliance of licence offers in a formal sense (e.g., scope of the licence, calculation methods used). The Düsseldorf courts examine the FRAND compliance of the SEP owner's offer if the implementer shows a general willingness to take a licence on FRAND terms, HRC Düsseldorf, GRUR-RS 2022, 11779, paras. 181–182. In HRC Düsseldorf, GRUR 2017, 1219, paras. 170–178 a licence offer was deemed discriminatory. In RC Düsseldorf, GRUR-RS 2021, 50360, paras. 169–217, the court found that the licence offer was unreasonable.
- ¹⁴¹ RC Munich, GRUR-RS 2020, 50638, para. 203.
- ¹⁴² RC Mannheim, BeckRS 2012, 11804.
- ¹⁴³ Cf. Renato Nazzini, *Global Licences under Threat of Injunctions: FRAND Commitments, Competition Law and Jurisdictional Battles*, 2022 (working paper, available via SSRN <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4101176> accessed May 18, 2022).
- ¹⁴⁴ Cf. Torsten Körber, 'Machtmissbrauch durch Erhebung patentrechtlicher Unterlassungsklagen?', *Wettbewerb in Recht und Praxis* (WRP) 2013, 734, 737.
- ¹⁴⁵ Cf. Norman V. Siebrasse et al. in Bradford Biddle et al. (ed), *Patent Remedies and Complex Products: Toward a global consensus*, 2019, p. 115, 146.

AUTHOR BIOGRAPHY



Felix K. Hess is a Doctoral Candidate (Dr. iur.) and Research Associate at Goethe University Frankfurt (Chair of Civil Law and Commercial Law, Prof. Dr. Alexander Peukert). The paper is a part of his doctoral thesis and was awarded third place in the 2021 ATRIP Essay Competition.

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